# GUIDELINES FOR PATENT EXAMINATION

2010

STATE INTELLECTUAL PROPERTY OFFICE
OF THE PEOPLE'S REPUBLIC OF CHINA

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**GUIDELINES FOR PATENT EXAMINATION 2010**

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BY STATE INTELLECTUAL PROPERTY OFFICE OF THE PEOPLE'S REPUBLIC OF CHINA

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# ORDINANCE

# OF

# THE STATE INTELLECTUAL PROPERTY OFFICE

# No. 55

In accordance with the provisions of Rule 122 of the Implementing Regulations of the Patent Law of the People's Republic of China, the previous Guidelines for Examination, which were promulgated on May 24, 2006 and entered into force on July 1, 2006, are revised. The revised Guidelines for Patent Examination are hereby promulgated and shall enter into force on February 1, 2010.

田力普

the Commissioner

January 21, 2010

# Foreword

The State Intellectual Property Office of the People's Republic of China, as the patent administration department under the State Council, commissions the Patent Office of the State Intellectual Property Office (hereinafter the "Patent Office") to accept, examine and grant patent for patent applications. The Patent Office makes decisions on behalf and in the name of the State Intellectual Property Office. The Patent Reexamination Board, set up by the State Intellectual Property Office, is responsible for examining requests for reexamination and requests for invalidation and making decisions accordingly.

In order to ensure objective, impartial, appropriate and timely handling of patent-related applications and requests in compliance with the laws, as pursuant to Rule 122 of the Implementing Regulations of the Patent Law, the State Intellectual Property Office enacts these Guidelines for Patent Examination (hereinafter the "Guidelines"). These Guidelines detail and supplement the provisions of the Patent Law and its Implementing Regulations, and thus serve as bases and standards for the Patent Office and Patent Reexamination Board to refer to and follow in enforcing the relevant laws and regulations. They are also regulations which the related parties shall abide by at each of the aforesaid stages.

These Guidelines are made by revision of the previous version of 2006 in light of practice, in accordance with the Patent Law of the People's Republic of China promulgated on December 27, 2008 and the Implementing Regulations of the Patent Law of the People's Republic of China promulgated on January 9, 2010, and are hereby promulgated as regulations of the State Intellectual Property Office.

# Editor's Notes

1. These Guidelines consist of Foreword, Editor's Notes, Table of Contents, Main Text, Index, Explanatory Notes on the Amendment, and Annexes.

2. The main text of these Guidelines comprises the following five parts:

Part I: Preliminary Examination;

Part II: Substantive Examination;

Part III: Examination of International Applications Entering the National Phase;

Part IV: Examination of Requests for Reexamination and for Invalidation; and

Part V: Processing of Patent Applications and Procedural Matters.

Parts I, II, and IV deal with examination of patent applications sequentially. Part III provides for special rules on the examination of international applications entering the national phase. Part V provides common rules applicable to all the procedures.

3. Each Part of the Guidelines is divided into Chapters, each sub-divided into numbered Sections of four levels. For example, in Part II Chapter 3 (Novelty), 2.1.2.2 (Disclosure by Use) is a fourth level Section under Section 2.1.2 (Means of Disclosure) of the third level, which is subordinated to the second level Section 2.1 (Prior Art) that belongs to Section 2 (Concept of Novelty) of the first level.

4. The Table of Contents includes an outline contents to the chapter level, and a detailed contents to the lowest section level. A reader may first consult the outline contents to find the relevant chapter and then look for the exact position in the detailed contents.

5. For ease of understanding and reference, in the left side to the text of the Guidelines, marginal references to the applicable provisions of laws and regulations are also provided.

When reading the Guidelines, a reader may easily find the full text of the relevant provisions with the aid of these references.

6. Unless otherwise indicated, references in the Guidelines to "the Patent Law" are to the Patent Law of the People's Republic of China, to "the Implementing Regulations" are to the Implementing Regulations of the Patent Law of the People's Republic of China, to "Articles" are to those of the Patent Law, and to "Rules" are to those of the Implementing Regulations.

7. Whenever "he" is used in relation to applicant, inventor, patentee, petitioner, examiner, etc., this should be understood as indicating "she" (in case of female), "it" (in case of an entity such as company), or "they" (in case of plural form) where appropriate. The same is true for the possessive and objective cases.

8. This English translation is provided just for information, and the Guidelines in the Chinese language as promulgated shall be the only authentic version. The translators try their best to ensure correct translation. However, omissions and mistakes are expected. In case of any discrepancy or incorrect translation, the Chinese version shall prevail.

9. Those marginal references to the applicable provisions of laws and regulations in the left side to the text of the Guidelines are indicated in the abbreviated form, examples of which are provided in the following:

| | |
|---|---|
| Art. 26 | Article 26 of the Patent Law |
| Art. 38 & 39 | Articles 38 and 39 of the Patent Law |
| Art. 2, 5 & 25 | Articles 2, 5, and 25 of the Patent Law |
| Art. 31.1 | Article 31, Paragraph 1 of the Patent Law |
| Art. 22.2 & 3 | Article 22, Paragraphs 2 and 3 of the Patent Law |
| Art. 25.1(1) | Article 25, Paragraph 1, Item (1) of the Patent Law |
| Rule 1 | Rule 1 of the Implementing Regulations |
| Rule 45 | Rule 45 of the Implementing Regulations |

| | |
|---|---|
| Rules 95 & 96 | Rules 95 and 96 of the Implementing Regulations |
| Rules 21-23 | Rules 21 to 23 of the Implementing Regulations |
| Rule 44. 1 | Rule 44, Paragraph 1 of the Implementing Regulations |
| Rule 23. 1 &. 2 | Rule 23, Paragraphs 1 and 2 of the Implementing Regulations |
| Rules 42. 2 & 43 | Rule 42, Paragraph 2 and Rule 43 of the Implementing Regulations |
| Rules 21. 3 & 23. 2 | Rule 21, Paragraph 3 and Rule 23, Paragraph 2 of the Implementing Regulations |
| Rule 33(3) | Rule 33, Item (3) of the Implementing Regulations |
| Rule 17. 1(4) | Rule 17, Paragraph 1, Item (4) of the Implementing Regulations |
| PCT Art. 25 | Article 25 of the Patent Cooperation Treaty |
| PCT Rule 51 | Rule 51 of the Regulations under the Patent Cooperation Treaty |
| PCT Rule 13bis2. 3(a) | Rule 13bis2. 3, Paragraph (a) of the Regulations under the Patent Cooperation Treaty |

# Outline Contents

# Detailed Table of Contents

# Part I

# Preliminary Examination

# Chapter 1 Preliminary Examination of Patent Applications for Invention

## 1. Introduction

Article 34 provides that where, after receiving a patent application for invention, the Patent Office, upon preliminary examination, finds the application to be in conformity with the requirements of the Patent Law, it shall publish the application promptly after the expiration of eighteen months from the date of filing. Upon the request of the applicant, the Patent Office may publish the application earlier. Thus, the preliminary examination of a patent application for invention is an indispensable procedure after receipt of the application and before its publication.

The main tasks of the preliminary examination of a patent application for invention are as follows:

Art. 26
Rule 44

(1) to examine whether or not the application documents submitted by the applicant are in conformity with the provisions of the Patent Law and its Implementing Regulations. Where the Patent Office finds that there is any defect which can be rectified, it shall notify the applicant to eliminate the defect by submitting rectifications so as to make the said documents meet the requirements for publication; or where the Patent Office finds that there is any defect which cannot be corrected, it shall send an Office Action stating the nature of the defect, and terminate the examination procedure by rejecting the application;

Rule 45

(2) to examine whether or not other documents relating to the application, submitted by the applicant at the time of filing or thereafter, are in conformity with the provisions of the Patent Law and its Implementing Regulations. Where the Patent Office finds that there is any defect in these documents, it shall, depending on the nature of the defect, notify the applicant to eliminate the defect by submitting rectifications, or make the decision directly that the said documents are deemed not to have been submitted;

(3) to examine whether or not the other documents relating to the application were submitted by the applicant within the time limit prescribed in the Patent Law or its Implementing Regulations, or specified by the Patent Office. Where the said documents were not submitted

within the time limit, or were submitted after the expiration of the time limit, the Patent Office shall, depending on the circumstances, make a decision that the application is deemed to have been withdrawn, or the said documents are deemed not to have been submitted; and

Art. 75
Rules 95 & 96
Rule 99

(4) to examine whether or not the time limit of the payment of any relevant fee paid by the applicant and the amount of such fee are in conformity with the provisions of the Patent Law or its Implementing Regulations. If the fee is not paid, or not paid in full, or not paid within the time limit, the Patent Office shall, depending on the circumstances, make a decision that the application is deemed to have been withdrawn or the relevant request is deemed not to have been made.

Rule 44. 1

The scope of the preliminary examination of a patent application for invention includes:

(1) formal examination of application documents, including whether or not the application contains the documents required by Article 26, and whether or not the form of those documents is obviously not in conformity with the provisions of Rule 16-19 or 23, or is in conformity with the provisions of Rule 2, 3, 26. 2, 119 or 121;

(2) examination on obvious substantive defects in application documents, including whether or not the application obviously falls into the scope prescribed in Article 5 or 25, or is not in conformity with the provisions of Article 18, or 19. 1 or 20. 1, or is obviously not in conformity with the provisions of Article 2. 2, 26. 5, 31. 1 or 33, or Rule 17 or 19;

(3) formal examination of other documents, including whether or not the other formalities and documents relating to the application are in conformity with the provisions of Articles 10, 24, 29, 30, and Rules 2, 3, 6, 7, 15. 3, 15. 4, 24, 30, 31. 1-31. 3, 32, 33, 36, 40, 42, 43, 45, 46, 86, 87 and 100; and

(4) examination of relevant fees, including whether or not the payments of the relevant fees of the application have been made in accordance with the provisions of Rules 93, 95, 96 and 99.

## 2. Principles of Examination

In the procedure of preliminary examination, the examiner shall abide by the following principles of examination.

(1) Principle of confidentiality

In the patent application examination and approval proceedings, the examiner shall be obliged to keep secret the patent application docu-

ments and other contents related to patent application that are not published or announced, and other information that is not proper to be made known in accordance with the relevant provisions on secrecy.

(2) Principle of written examination

The examiner shall examine on the basis of the written documents submitted by the applicant. The Office Action (including the *Notification to Make Rectification*) and the result of examination shall be sent in written form to notify the applicant. In the preliminary examination procedure, in principle no interview will be held.

(3) Principle of hearing

Before making a decision of rejection, the examiner shall notify the applicant of the facts, grounds and evidence for rejection, and give the applicant at least one opportunity to make observations and/or amend the application documents. When the examiner makes a decision of rejection, the facts, grounds and evidence for rejection shall have been notified to the applicant, and the decision shall not contain any new facts, grounds and/or evidence.

(4) Principle of procedural economy

Where in conformity with the provisions, the examiner shall improve the efficiency of examination as much as possible, and shorten the examination period. With regard to the application with defects that can be eliminated through rectifications, the examiner shall conduct a comprehensive examination and do his best to point out all the defects in one *Notification to Make Rectification*. The examiner may, on his own initiative, correct the obvious clerical mistakes and symbol mistakes in the documents of application for a patent, and, shall notify to the applicant. With regard to the application with substantive defects that can not be eliminated through rectifications, the examiner may only point out the substantive defects in the Office Action without examining the formality defects in the application documents and other documents.

In addition to complying with the above principles, the examiner shall notify the applicant of subsequent procedures that can be initiated while making the decision that the application is deemed not to have been filed, the decision that the application is deemed withdrawn, or the decision of rejection.

## 3. Procedure of Examination

### 3.1 Passing Preliminary Examination

Upon preliminary examination, a patent application whose application documents are in conformity with the relevant provisions of the Patent Law and its Implementing Regulations and have no obvious substantive defects, including a patent application that has met the requirements of preliminary examination after rectification, shall be deemed to have passed the preliminary examination. The examiner shall issue the *Notification of Passing Preliminary Examination* and point out the text of the application on which the publication is based. Then the application enters into the publication procedure.

### 3.2 Rectification of Application Documents

During preliminary examination, for a patent application whose application documents have defects that can be eliminated through rectifications, the examiner shall conduct a comprehensive examination and issue the *Notification to Make Rectification*, in which the defects existing in the patent application shall be pointed out, the grounds shall be stated, and the time limit for response shall be specified. Where the defects still exist in the application documents after the applicant makes rectification, the examiner shall issue another *Notification to Make Rectification*.

### 3.3 Handling of Obvious Substantive Defects

During preliminary examination, for a patent application whose application documents have obvious substantive defects that can not be eliminated through rectifications, the examiner shall issue an Office Action, in which the substantive defects existing in the patent application shall be pointed out, the grounds shall be stated, and the time limit for response shall be specified.

The substantive defects existing in the application documents shall be pointed out and handled only if the defects are obvious and affect the publication.

### 3.4 Response to Notification

The applicant shall, after receiving the *Notification to Make Rectification* or the Office Action, make rectification or observations within

the specified time limit. The applicant shall, when making rectification of the patent application, submit the rectification and the corresponding replacement sheets of the amended documents. The replacement sheets of the amended application documents shall be in duplicate, while only one copy is required for other documents. The amendment of the application documents shall eliminate the defects which have been pointed out in the *Notification to Make Rectification*, and shall not go beyond the scope of disclosure contained in the description and claims filed on the date of filing.

Where the applicant makes no response within the time limit, the examiner shall, depending on the circumstances, issue the *Notification that Application Deemed to be Withdrawn* or other notifications. Where it is difficult for the applicant to make response within the specified time limit due to justified reasons, he may request to extend the time limit. The provisions of Chapter 7, Section 4 of Part V of these Guidelines shall apply in handling the request for extension of the time limit.

Where a patent application is deemed to have been withdrawn resulting from failure to meet the time limit due to force majeure or other justified reasons, the applicant may, within the prescribed time limit, submit a request to the Patent Office for restoration of the right. The provisions of Chapter 7, Section 6 of Part V of these Guidelines shall apply in handling the request for restoration of the right.

### 3.5 Rejection of Applications

Where obvious substantive defects exist in the application documents and remain unrectified after the applicant makes observations or amendment upon the examiner's issuance of the Office Action, or where formality defects exist in the application documents and remain unrectified after the applicant makes observations or rectification upon the examiner's issuance of the *Notification to Make Rectification* twice in respect of the said defects, the examiner may make a decision of rejection.

The text of the decision of rejection shall include three parts: brief of the case, grounds for rejection, and conclusion. The examination procedure of the rejected application shall be briefly described in the part of brief of the case. The facts, grounds and evidence for rejection shall be explained in the part of grounds for rejection. The corresponding provisions of the Patent Law and its Implementing Regula-

tions which the patent application is contravening shall be clearly indicated in the part of conclusion with a statement that the patent application is rejected in accordance with Rule 44.2.

### 3.6 Interlocutory Examination and Handling after Reexamination

Where the applicant is not satisfied with the decision of rejection, the applicant may, within the prescribed time limit, file a reexamination request with the Patent Reexamination Board. For the interlocutory examination for the reexamination request and the handling after reexamination, the provisions of Chapter 8, Section 8 of Part Ⅱ of these Guidelines shall apply.

Rule 44

## 4. Formal Examination of Application Documents

Art. 26.2
Rule 16

### 4.1 Request

#### 4.1.1 Title of Invention

The title of the invention in the request shall be identical with the one in the description. The title of the invention shall state briefly and accurately the claimed subject matter and category of the patent application for invention. The title of the invention shall not include non-technical terms, such as the name of an individual or entity, trademark, code or model, etc., nor shall it include any ambiguous terms, such as "and others", "and its like" etc. General terms shall not be used if they do not provide any information about the invention, for example, only such terms as "method", "equipment", "composition" and "compound" are used as the title of the invention.

In general, not more than 25 Chinese characters shall be used in the title of invention. In special circumstances, e.g., some inventions in the field of chemistry, the number of Chinese characters used in the title of invention can be up to 40 at most.

#### 4.1.2 Inventor

As prescribed in Rule 13, the inventor shall be the person who has made creative contributions to the substantive features of an invention-creation. However, the examiner does not examine whether or not the inventor whose name is filled in the request meets the requirements of the above provisions in the procedures of examination of the Patent Office.

The inventor shall be an individual, and an entity or organization shall not be filled in the request. For example, it shall not be filled in as "xx project group", etc. The inventor shall use his true name other than his pen name or other informal name. Where there is more than one inventor, the names thereof shall be indicated in the order from left to right. Where the inventor filled in the request is not in conformity with the provisions, the examiner shall issue the *Notification to Make Rectification*. Where the applicant corrects the inventor' s name filled in the request, he or it shall submit the rectification, the declaration of the party involved and the corresponding certifying document.

The inventor may request the Patent Office not to publish his name. Where such request is made when the patent application, "( do not publish the name)" shall be indicated after the corresponding inventor filled in the item of "inventor" in the request. After the request for not publishing the inventor' s name is made, if it is considered to be in conformity with the provisions, the Patent Office shall not publish the inventor' s name in the Patent Gazette, the separate copy of the application for patent for invention application, separate copy of patent for invention and the certificate of patent, and shall indicate the phrase "request not to publish the name" in the corresponding position. The inventor shall not request his name to be published afterwards. Where the request for not publishing the inventor' s name is made after the patent application is filed, a written declaration signed or sealed by the inventor shall be submitted. However, if such request is made after the patent application enters into the procedure of preparation for publication, it shall be deemed not to have been made. The examiner shall issue the *Notification that Request Deemed Not to Have Been Submitted*. A foreign inventor may use his initials in foreign language in the Chinese translation of his name. The initial of the first name shall be followed by a dot before the family name, such as M · Jones.

### 4.1.3 Applicant

#### 4.1.3.1 Applicant Being Chinese Individual or Entity

For a service invention, the right to apply for a patent belongs to the entity for which the inventor serves. While for a non-service invention, the right to apply for a patent belongs to the inventor himself.

In general, it is not necessary for the examiner to examine the eligibility of the applicant filled in the request in the examination proce-

dure of the Patent Office. Where the applicant is an individual, it may be presumed that the invention is a non-service invention, and the applicant has the right to file the patent application. Where the examiner determines the eligibility of the applicant is obviously questionable according to the contents of the patent application, the applicant shall be notified to submit a proof of non-service invention provided by the entity for which the applicant serves. Where the applicant is an entity, it may be presumed that the invention is a service invention, and the entity has the right to file the patent application. Where the eligibility of the entity as an applicant is obviously questionable, for example, the applicant filled in the request is "the Scientific Research Division of xx University" or "xx Project Group of xx Research Institute", the examiner shall issue the *Notification to Make Rectification* and notify the applicant to submit a document certifying its eligibility as an applicant.

Where the applicant declares he is eligible and submits the certifying documents, he is considered to be eligible as an applicant. The proof provided by the competent department of a next higher level, and the copy of the certificate of the legal representative with the seal of the entity affixed on or the copy of the valid business license with the seal of the entity affixed on shall all be deemed to be valid certifying documents. Where the applicant filled in the request needs to be changed because of ineligibility, the changed applicant shall go through the formalities of rectification, submitting rectification and the declaration of changing applicant signed or sealed by both of the applicant before changing and the applicant after changing.

Where the applicant is a Chinese entity or individual, its or his title or name, address, postal code, the code of the organization or the citizen identification card number shall be stated in the request. Where the applicant is an individual, his true name, not his pen name or other informal name, shall be used. Where the applicant is an entity, its full official title, not its abbreviation or its shorter title, shall be used. The title of the entity filled in the request shall be the same as it appears in the official seal of that entity. Where the applicant filled in the request is not in conformity with the provisions, the examiner shall issue the *Notification to Make Rectification*. Where the applicant corrects its or his name or title stated in the request, the rectification, the declaration of the party involved and the corresponding certifying document shall be submitted.

#### 4.1.3.2 Applicant Being Foreign Individual, Enterprise or Other Type of Organization

Article 18 provides that, where any foreign individual, enterprise or other type of organization having no habitual residence or business office in China files a patent application in China, the application shall be treated under the Patent Law in accordance with any agreement concluded between the country to which the applicant belongs and China, or in accordance with any international treaty to which both countries are party, or on the basis of the principle of reciprocity.

Where the applicant is a foreigner, a foreign enterprise or other foreign organization, his or its name or title, the nationality, or the country or region in which the applicant is registered shall be stated in the request. Where the examiner has any doubt about the nationality, or the registered place of the applicant filled in the request, he may invite the applicant to provide a certificate of nationality or document certifying the registered place in accordance with the provisions of Rule 33(1) or (2). Where the applicant states in the request that it has a business office in China, the examiner shall invite the applicant to submit a certifying document provided by the local administrative authority for industry and commerce. Where the applicant states that it has a habitual residence in China, the examiner shall invite the applicant to submit a document provided by the public security department, certifying that he is permitted to reside in China for one year or longer.

After it is affirmed that the applicant is a foreign individual, enterprise or other type of organization having no habitual residence or business office in China, the examiner shall examine whether or not the nationality or the registered place of the applicant, as filled in the request, is in conformity with one of the following three conditions:

(1) the country to which the applicant belongs has concluded with China an agreement affording patent protection to the nationals of each other;

(2) the country to which the applicant belongs is a country party to the Paris Convention for the Protection of Industrial Property (hereinafter referred to as the Paris Convention) or a member of the World Trade Organization; or

(3) the country to which the applicant belongs provides patent protection to foreign person on the basis of the principle of reciprocity.

Ru33(3)

The examiner shall start examination from whether or not the country to which the applicant belongs (where the applicant is an individual, it is determined by his nationality or habitual residence; where the applicant is an entity or other organization, it is determined by its registered place) is a country party to the Paris Convention or a member of the World Trade Organization. Generally, it is not necessary to examine whether or not there is any agreement, concluded between the relevant country and China, providing patent protection for the nationals of each other, because all of the countries which have concluded agreements with China are now parties to the Paris Convention or members of the World Trade Organization. Only when the country to which the applicant belongs is neither a country party to the Paris Convention nor a member of the World Trade Organization, is it necessary to examine whether or not there are provisions in the law of that country giving patent protection to foreign person on the basis of principle of reciprocity. If there are no such written provisions giving patent protection to foreign person on the basis of the principle of reciprocity, the examiner shall invite the applicant to submit a document certifying that his or its country recognizes that Chinese citizens and entities are, under the same conditions as its own nationals, entitled to enjoy patent right and other related rights in that country. Where the applicant fails to submit such documents, the patent application shall be rejected in accordance with Rule 44 on the ground that it is not in conformity with the provisions of Article 18.

Where the applicant comes from the dependent territory of a country party to the Paris Convention, it shall be examined whether or not that country has declared that the Paris Convention is applicable to that territory.

Where the applicant is an individual, the initials in foreign language may be used in the Chinese translation of his name. The initial of the first name shall be followed by a dot before the family name, such as M · Jones. Titles used to show any academic degree, occupation, etc., for example "Dr.", "Prof.", shall not be used in the applicant's name. Where the applicant is an entity or any other organization, it shall use its full name of the official Chinese translation. It is permitted to use certain title that indicates the status of independent legal person in accordance with the laws of the country to which the applicant belongs.

#### 4.1.3.3 Application Being Filed Jointly by Chinese and Foreign Applicants

Where a patent application is filed jointly by a Chinese applicant and a foreign applicant, Section 4.1.3.1 of this Chapter shall apply to the Chinese applicant, while Section 4.1.3.2 of this Chapter shall apply to the foreign applicant.

Rule 4.2

### 4.1.4 Contact Person

Where an applicant is an entity and it has not appointed a patent agency, the contact person shall be indicated. The contact person refers to one who receives correspondence from the Patent Office for the applicant. The contact person shall be a staff of the entity. The examiner may invite the applicant to submit certifications if necessary. Where the individual applicant needs another person, instead of himself, to receive correspondence from the Patent Office, the contact person may also be indicated. Only one person shall be indicated as the contact person. The address, postcode and telephone number of the contact person shall also be indicated.

Rule 15.4

### 4.1.5 Representative

Where there are two or more applicants and no patent agency is appointed, except for where otherwise provided for in the Guidelines, or unless otherwise stated in the request, the first named applicant shall be the representative. Where it is otherwise stated in the request, the stated representative must be one of the applicants. Except for the formalities directly relating to the joint rights, the representative can represent all the applicants to go through other formalities in the Patent Office. The formalities directly relating to the joint rights include filing the patent application, appointing a patent agency, assigning the right to apply for patent, the right of priority or the patent right, withdrawing the patent application, withdrawing the claim for the right of priority, abandoning the patent right, etc. The formalities directly relating to the joint rights shall be signed or sealed by all the owners of the rights.

Art. 19
Rule 16 (4)

### 4.1.6 Patent Agency and Patent Agent

Any patent agency shall be established in accordance with the provisions of the Regulations Governing Patent Agency and approved

by the State Intellectual Property Office.

Any patent agency shall use the full name which has been registered with the State Intellectual Property Office, and which shall be the same as that appearing in the official seal of that patent agency which is affixed on the application documents. Any abbreviation or initials shall not be used. The agency's organizational code given by the State Intellectual Property Office shall also be indicated in the request.

The term "patent agent" refers to a person who holds a Patent Agent Qualification Certificate, practices in a legitimate patent agency and has acquired a professional certificate of Patent Agent from the State Intellectual Property Office. The patent agent shall use his true name and fill the professional certificate number and the telephone number in the request. The applicant shall not appoint more than two patent agents for one patent application.

Art. 26.2
Rule 16

### 4.1.7 Address

The address (including the address of the applicant, patent agency or contact person) in the request shall meet the requirements for quick and accurate delivery by post. The domestic address shall include the postcode, the names of the province (autonomous region), municipality (autonomous prefecture), district, street, the number of the house, and the telephone number, or the names of the province (autonomous region), county (autonomous county), town (township), street, the number of the house, and the telephone number, or the names of the municipality directly under the Central Government, district, street, the number of the house, and the telephone number. Where a postbox is available, it may be used in accordance with the stipulations. The name of an entity may be included in the address, but it cannot be used to replace the address. For example, only "xx University of xx Province" shall not be used as an address. Where the address is in a foreign country, the names of the country and city (county, state) shall be clearly indicated, and the detailed address in foreign language shall be appended.

Art. 26.3
Rule 17

### 4.2 Description

The first line on page one of the description shall state the title of the invention, which shall be the same as that appearing in the request and shall be located in the middle of the line. No such words as "Title of Invention" or "Title" shall be used before the title of the invention.

A blank line shall be left between the title of invention and the text of the description.

The description shall contain the following parts, and each shall bear the headings respectively as follows:

Technical Field;

Background Art;

Contents of Invention;

Description of Figures;

Specific Mode for Carrying out the Invention.

Where there are no drawings in the description, the part of "Description of Figures" and the corresponding heading shall be omitted.

As for an application relating to nucleotide or amino acid sequence, such sequence listing shall be a separate part of the description and its pages shall be numbered separately from the description. The applicant shall at the time of filing submit a copy of computer-readable form which is in agreement with the sequence listing, such as a CD-ROM or floppy disc recording the above sequence listing and meeting the relevant prescriptions. Where the sequence listing recorded in the CD-ROM or floppy disc is not in agreement with the sequence listing stated in the description, the sequence listing stated in the description shall prevail. Where no such copy of computer-readable form has been submitted or the submitted copy is obviously not in conformity with the sequence listing stated in the description, the examiner shall issue the *Notification to Make Rectification* and invite the applicant to submit a corrected copy within the specified time limit. If the applicant fails to submit it within the specified time limit, the examiner shall issue the *Notification that Application Deemed to be Withdrawn*.

The text of the description may contain chemical, mathematical formulas, or tables, but drawings shall not be included.

Where there is description of figures in the text of the description, there shall be drawings in accordance with description. Where there are drawings, there shall be description to such figures in the text of the description.

Rule 40

Where the description states that it contains explanatory notes to the drawings but the drawings or part of them are missing, the applicant shall be invited, within the specified time limit, either to make a declaration for the deletion of the explanatory notes to the drawings or to furnish the corresponding drawings. If the applicant submits the drawings later, the date of their delivery at or mailing to the Patent Of-

fice shall be the date of filing of the application; and the examiner shall issue the *Notification of Redetermination of Filing Date*. If the explanatory notes to the drawings are to be deleted, the initial date of filing shall be retained.

Rule 121. 2

The pages of the description shall be numbered consecutively in Arabic numerals.

Rules 18 & 121

**4. 3 Drawings**

The drawings shall be executed in black ink with the aid of drafting instruments including computer. The lines shall be uniformly thick and well defined, dark enough, and free from color and alterations. Engineering blueprint drawings shall not be used.

The oblique hatching of cross-sections shall not impede the clear reading of the reference signs and leading lines.

The same sheet of paper may contain several figures. A single complete figure may be split over several different sheets, but the figures on each sheet must be independent, and shall be so arranged that when all the figures are assembled to form a single complete figure, it would not affect the clarity of the various figures. No frame line irrelevant to the figures shall be used around the figures. Where there are two or more figures, they shall be numbered consecutively in Arabic numerals, and the word “Figure” shall be added before the number, for example, “Figure 1”, “Figure 2”. The number shall be labeled right below the corresponding figures.

Figures shall be preferably arranged in an upright position on a sheet or sheets, clearly separated from one another. Where it is necessary to arrange the figure not in an upright position because the dimension of the horizontal section of the part is obviously larger than that of the vertical section, it shall be presented sideways with the top of the figure at the left side of the sheet. Where there are two or more figures on one sheet and one of them is presented in that way, the rest of the figures shall be presented in the same way.

Reference signs shall be numbered in Arabic numerals. Reference signs that are not mentioned in the text of the description shall not appear in the figures, and reference signs that do not appear in the figures shall not be mentioned in the text of the description. The reference signs for the same composite parts shall be identical throughout the application documents.

The size and distinctness of the figure shall ensure that each detail

of the figure shall be clearly distinguishable when the figure size is reduced to two-third so as to meet the requirements of copying and scanning process.

The identical scale shall be adopted in the same figure. An additional figure of partial enlargement may be added in order to make certain part of the figure be shown distinctively. Explanatory words are prohibited in the figure except a single word or words that are indispensable. Such word or words shall be in Chinese, and its original language may be added in brackets where necessary.

Flow charts and diagrams shall be considered as drawings, and indispensable notes and symbols shall be included in its frame. Generally, photographs shall not be used as drawings, however, under special circumstances, for example, when a metallographic structure, histocyte, or electrophoresis pattern is to be shown, photographs may be used as drawings and they may be pasted on the sheet of drawings.

All the pages of the drawings of description shall be numbered consecutively in Arabic numerals.

Rule 19. 2

### 4. 4 Claims

Where there are several claims, they shall be numbered consecutively in Arabic numerals. No words such as "claim", "item" shall be used before the numerals.

The claims may contain chemical or mathematical formulas, and tables if necessary, but shall not include drawings.

All the pages of the claims shall be numbered consecutively in Arabic numerals.

Art. 26. 1
Rule 23

### 4. 5 Abstract

Where a patent application for invention is filed, an abstract of the description (hereinafter referred to as the abstract) shall be submitted.

#### 4. 5. 1 Text of the Abstract

The text of abstract shall state the title of the invention and the technical field to which the invention pertains. It shall be drafted in a way which allows the clear understanding of the technical problem, the gist of the technical solution of that problem, and the principal use or uses of the invention. Where no title of invention is given or no gist of the technical solution is stated, the applicant shall be invited to make rectifications. Where words of commercial advertising are included,

the examiner may delete them or invite the applicant to delete them. Where the words are deleted by the examiner, the applicant shall be notified accordingly.

The title shall not be taken as heading in the text of the abstract. The text of the abstract shall contain not more than 300 Chinese characters (including punctuation). Where there are more than 300 Chinese characters, the examiner may make abridgements, or invite the applicant to make abridgements. Where the abridgement is made by the examiner, the applicant shall be notified accordingly.

#### 4.5.2 Figure Accompanying the Abstract

Where the description contains drawings, the applicant shall submit one figure which best characterizes the technical features of the invention as the figure accompanying the abstract. The figure accompanying the abstract shall be one of the drawings of the description. Where the applicant has not submitted such a figure, the examiner may invite the applicant to make rectifications, or may designate one *ex officio* and notify the applicant accordingly. Where the examiner considers that there is no suitable figure to be designated, he may not invite the applicant to make rectifications.

Where the figure accompanying the abstract submitted by the applicant obviously cannot characterize the main technical features of the invention or it is not one of the drawings in the description, the examiner may invite the applicant to make rectifications, or designate another one *ex officio* and notify the applicant accordingly.

The scale and the distinctness of the figure accompanying the abstract shall be as such that a reproduction with a linear reduction in size to 4cm × 6cm would still enable all details to be clearly distinguished.

The abstract may contain chemical formula which best characterizes the invention. Such chemical formula may be deemed as the figure accompanying the abstract.

Rule 121

### 4.6 Format Examination of Application Documents for Publication

When a patent application is published, the text of the description, claims and abstract shall be neat and legible, free from alteration and obliteration, without any character or word added between the lines. The lines of the drawings of the description and the figure of the abstract (including the outlines, dotted lines, section lines, central

lines, indicative lines, etc.) shall be legible and discernible. Both characters and lines shall be in sufficiently black, and kept in a clean background so as to meet the requirements of copying and scanning process. The text and drawings shall have no frame around them. The sheets of each part of the documents shall be numbered in order respectively.

Where the application documents are not in conformity with the above requirements, the examiner shall issue the *Notification to Make Rectification* to notify the applicant to make rectifications. Where no rectification is made within the time limit, the examiner shall issue the *Notification that Application Deemed to be Withdrawn*.

Rule 42.1

## 5. Preliminary Examination of Special Patent Applications

### 5.1 Divisional Application

#### 5.1.1 Examination of Divisional Application

Where a patent application contains two or more inventions, the applicant may submit a divisional application on his own initiative or in accordance with the Office Action of the examiner. A divisional application shall be submitted on the basis of the initial application (first filed application). The category of a divisional application shall be the same as that of the initial application. The application number and the filing date of the initial application shall be indicated in the request for the divisional application. Where the applicant files another divisional application based on an already filed divisional application, the application number of the already filed divisional application shall be filled in the parenthesis after the application number of the initial application.

For a divisional application, besides examining the application documents and other documents as prescribed, the examiner shall examine the following matters on the basis of the initial application:

(1) The filing date of the initial application indicated in the request

The filing date of the initial application shall be indicated in the request correctly. If it is not correct, the examiner shall issue the *Notification to Make Rectification* to the applicant for rectifications. Where no rectification is made within the time limit, the examiner shall issue the *Notification that Application Deemed to be Withdrawn*. If the rectifi-

cation is in conformity with the provisions, the examiner shall issue the *Notification of Redetermination of Filing Date*.

(2) The application number of the initial application indicated in the request

The application number of the initial application shall be indicated in the request correctly. Where the initial application is an international application, the applicant shall indicate the application number of the international application in the brackets that follow the initial application number filled in the request. Where the application documents are not in conformity with the requirements, the examiner shall issue the *Notification to Make Rectification,* and invite the applicant to make rectification. Where no rectification is made within the time limit, the examiner shall issue the *Notification that Application Deemed to be Withdrawn*.

(3) Submission time of divisional application

The applicant shall file a divisional application no later than the expiration of two months (i. e., the time limit for going through the formalities of registration) from the date of receiving the *Notification to Grant Patent Right* to the initial application issued by the Patent Office. After the expiration of the above time limit, or where the initial application has been rejected, or the initial application has been withdrawn, or is deemed to have been withdrawn and the right has not been restored, no divisional application shall be filed in general.

With regard to the initial application to which the examiner has issued the decision of rejection, the applicant may file a divisional application within three months from the date that the applicant receives the decision of rejection regardless of whether the applicant requests for reexamination or not. The applicant, after requesting for reexamination or during the initiation of the administrative litigation against the reexamination decision, may also file a divisional application.

During the preliminary examination, where the filing date of a divisional application is not in conformity with the said provisions, the examiner shall issue the *Notification that Divisional Application Deemed Not to Have Been Filed*, and make a decision to close the case.

Where an applicant files another divisional application based on an already filed divisional application, the submission date of another divisional application shall be examined according to the initial application. Where the submission date of another divisional application is not in conformity with the above provisions, no divisional application

shall be filed, however, with the exception that another divisional application is filed by the applicant according to the Office Action made by the examiner due to a unity defect in the divisional application. Regarding this exception, the applicant, when filing another divisional application, shall submit a copy of the Office Action indicating the unity defect or of the *Notification to Make Divisional Application* issued by the examiner. Where the copy of the Office Action or of the *Notification to Make Divisional Application* in conformity with the provisions is not submitted, the application shall not be treated as exception. Where the copy is not in conformity with the provisions, the examiner shall issue *the Notification to Make Rectification* notifying the applicant to make rectification. Where no rectification is made within the time limit, the examiner shall issue the *Notification that Application Deemed to be Withdrawn*. Where the copy is still not in conformity with the provisions after rectification, the examiner shall issue the *Notification that Divisional Application Deemed Not to Have Been filed* and make a decision to close the case.

(4) Applicant and inventor of divisional application

The applicant of a divisional application shall be the same as that of the initial application. Where this is not the case, a document certifying the change of the applicant shall be submitted. The inventor of a divisional application shall be the inventor or part of the inventors of the initial application. Where there is any inconformity with the provisions, the examiner shall issue the *Notification to Make Rectification* notifying the applicant to make rectification. Where no rectification is made within the time limit, the examiner shall issue the *Notification that Application Deemed to be Withdrawn*.

(5) Submitted documents of divisional application

Besides the application documents, a copy of the application documents of the initial application and a copy of other documents relevant to the divisional application in the initial application (such as copy of the priority document) shall also be submitted. With regard to the various certifying materials that have been submitted with the initial application, duplicate copies may be used. Where the international publication of the initial application is in a language other than Chinese, a copy of such international publication shall be submitted together with a Chinese copy of the initial application. Where any inconformity with the provisions exists, the examiner shall issue the *Notification to Make Rectification* to the applicant for rectification. Where

no rectification is made within the time limit, the examiner shall issue the *Notification that Application Deemed to be Withdrawn*.

#### 5.1.2 Time Limit and Fees of Divisional Application

The various prescribed time limits applicable for a divisional application, such as the time limit for submitting the request for substantive examination, shall be calculated from the initial date of filing. Where the various time limits have expired, or are less than two months from the submission date of the divisional application to the date of expiration, when the divisional application is submitted, the applicant may go through the various formalities within two months from the submission date of the divisional application, or within fifteen days from the date of receipt the *Notification of Acceptance*. Where the applicant fails to go through any of the formalities within the time limit, the examiner shall issue the *Notification that Application Deemed to be Withdrawn*.

The applicant shall pay all the same fees for a divisional application as he shall pay for a new application. Where the time limits for paying the various fees have expired, or are less than two months from the submission date of the divisional application to the date of expiration, the applicant shall pay the fees within two months from the submission date of the divisional application, or within fifteen days from the date of receipt the *Notification of Acceptance*. If the fees are not paid or not paid in full within the time limit, the examiner shall issue the *Notification that Application Deemed to be Withdrawn*.

Rule 24

### 5.2 Application Relating to Biological Material

#### 5.2.1 Examination of Application Relating to Biological Material

For an application relating to biological material, the applicant shall, in addition to the other requirements provided for in the Patent Law and its Implementing Regulations, go through the following formalities:

(1) depositing a sample of the biological material with a depositary institution designated by the State Intellectual Property Office before the date of filing, or, at the latest, on the date of filing (or the priority date where priority is claimed);

(2) stating, in the request and the description, the name and address of the depositary institution with which the sample of biological

material was deposited, the date on which the sample was deposited, the accession number of the deposit, and the scientific name of the biological material (with its Latin name);

(3) giving in the application document relevant information of the characteristics of the biological material; and

(4) submitting, within four months from the date of filing, a certificate of deposit and a certificate of viability of the biological material issued by the depositary institution.

In preliminary examination, where the applicant submits a certificate of deposit within the prescribed time limit, the examiner shall examine the following matters on the basis of the certificate:

(1) Depositary institution

The depositary institution shall be an international depositary institution designated by the State Intellectual Property Office for the deposit of the biological material samples. If this provision is not complied with, the examiner shall issue the *Notification that Biological Material Sample Deemed Not to Have Been Deposited*.

(2) Date of deposit

The date of deposit shall be before or on the date of filing (or the priority date where priority is claimed). If this provision is not complied with, the examiner shall issue *the Notification that Biological Material Sample Deemed Not to Have Been Deposited*.

However, where the date of deposit indicated in the certificate of deposit is after the date of priority claimed and before the filing date, the examiner shall issue the *Notification to Rectify Formalities,* and invite the applicant to withdraw the claim for priority or to declare that the priority of the contents of the biological material concerned in the certificate of deposit will not be claimed within the specified time limit. If the applicant fails to make any response within the time limit or the correction is not in conformity with the provisions, the examiner shall issue the *Notification that Biological Material Sample Deemed Not to Have Been Deposited*.

(3) Consistency between the certificate of deposit, certificate of viability and the request

The certificate of deposit and certificate of viability shall be consistent with the items appearing in the request. Where there are any inconsistencies, the examiner shall issue the *Notification to Make Rectification* inviting the applicant to make rectifications within the specified time limit. If the applicant fails to make rectifications within the time

limit, the examiner shall issue the *Notification that Biological Material Sample Deemed Not to Have Been Deposited*.

In preliminary examination, where the applicant fails to submit the certificate of deposit within the prescribed time limit, the sample of the biological material shall be deemed not to have been deposited, and the examiner shall issue the *Notification that Biological Material Sample Deemed Not to Have Been Deposited*. Where, within four months from the date of filing, the applicant fails to submit the certificate of viability of the biological material sample, and fails to give justified reasons for its omission, the sample of the biological material will be deemed not to have been deposited, and the examiner shall issue *the Notification that Biological Material Sample Deemed Not to Have Been Deposited*.

Where the sample of the biological material ceases to be viable in the course of the transmittal of the sample to the depositary institution, the sample of the biological material will be deemed not to have been deposited, and the examiner shall issue *the Notification that Biological Material Sample Deemed Not to Have Been Deposited*, unless the applicant proves that he is not responsible for the loss of viability of the sample of the biological material. Where the applicant submits such evidence, he may make a new deposit of the sample of the biological material that is identical with the original one within four months from the date of filing, and the initial date of deposit shall be the date of deposit.

The applicant of a patent application relating to biological material shall, in the request and the description, indicate the scientific name of the biological material, the name and address of the depositary institution in which the sample of biological material is deposited, the date and the accession number of the deposit, all of which shall be consistent with each other (see Chapter 10, Section 9.2.1 of Part II of these Guidelines). Where, at the time of filing, they are not indicated in the request and the description, the applicant shall make rectification within four months from the date of filing. If the applicant fails to make rectification within the time limit, the sample of the biological material shall be deemed not to have been deposited. If the indication in the request is not consistent with that in the description, the applicant may make rectification within the specified time limit after receiving the notification of the Patent Office. If no rectification is made within the time limit, the biological material sample shall be deemed not to have

been deposited.

#### 5.2.2 Restoration of Deposit

After the examiner issues the *Notification that Biological Material Sample Deemed Not to Have Been Deposited*, if the applicant has any justified reason for objection, the applicant may request the Patent Office to restore his right in accordance with Rule 6.2. Except for other ones, the justified reasons in respect of the deposit of the sample of the biological material or the viability of the sample include the following:

(1) it is the depositary institution that fails to furnish the certificate of deposit or the certificate of viability of the biological material sample within four months from the date of filing, and it has furnished documents certifying this; and

(2) the sample of the biological material ceases to be viable in the course of the transmittal of the sample, for which the applicant can provide evidence to prove he is not responsible.

Art. 26.5
Rule 26.2

### 5.3 Application Relating to Genetic Resources

Where an application for patent is filed for an invention-creation which is developed on the basis of genetic resources, the applicant shall state the source of said genetic resources in the request, and fill in the *Registration Form for Indicating Source of Genetic Resources*, indicating the direct source and original source of such genetic resources. Where the applicant fails to state the original source, he or it shall state the reasons thereof. Where the application is not in conformity with the provisions, the examiner shall issue the *Notification to Make Rectification*, inviting the applicant to make rectification. Where no response is made within the time limit, the examiner shall issue the *Notification that Application Deemed to be Withdrawn*. Where the application is still not in conformity with the provisions after rectification, the application shall be rejected.

## 6. Examination of Other Documents and Relevant Formalities

### 6.1 Appointment of Patent Agency

Rule 44

#### 6.1.1 Appointment

Article 19.1 provides that where any foreign individual, enterprise or other type of organization having no habitual residence or business

office in mainland China applies for a patent, or has other patent matters to attend to, in China, or the applicant, as the first named applicant in a patent application jointly with an applicant from mainland China, applies for a patent and has other patent matters to attend to, he or it shall appoint a patent agency to act as his or its agent. In the examination of the application, if it is found that such an applicant has not appointed a patent agency, the examiner shall issue the Office Action to notify the applicant to response within the specified time limit. If the applicant fails to make any response within the specified time limit, the application shall be deemed to have been withdrawn. Where, after the applicant has made his observations or rectifications, the application is still not in conformity with the provisions of Article 19. 1, the application shall be rejected.

Any entity or individual in mainland China may appoint a patent agency to apply for a patent and to attend to other patent matters in the country. Where the appointment is not in conformity with the provisions, the examiner shall issue the *Notification to Make Rectification,* and invite the patent agency to make rectification within the specified time limit. Where the patent agency fails to make any response within the time limit, or where the rectification is still not in conformity with the provisions after rectification, the examiner shall issue the *Notification that Patent Agency Deemed Not to Have Been Appointed* to both the applicant and the appointed patent agency.

Where any applicant of Hong Kong, Macao, or Taiwan having no habitual residence or business office in mainland China applies for a patent or has other patent matters to attend to before the Patent Office, or the applicant, as the first applicant in a patent application jointly with an applicant from mainland China, applies for a patent and has other patent matters to attend to, he or it shall appoint a patent agency to act as his or its agent. Where no patent agency is appointed, the examiner shall issue the Office Action notifying the applicant to response within the specified time limit. If the applicant fails to make any response within the specified time limit, the application shall be *deemed to have been withdrawn.* Where, after the applicant has made his observations or rectifications, the application is still not in conformity with the provisions, the application shall be rejected.

The parties to the appointment are the applicant and the appointed patent agency. Where there are two or more applicants, the parties are all of the applicants and the appointed patent agency. Only one patent

agency shall be appointed, except otherwise prescribed in these Guidelines. After accepting the appointment, the patent agency shall designate its patent agents to handle the relevant matters. The said agents so designated shall not be more than two persons.

Rule 15.3

### 6.1.2 Power of Attorney

Any applicant who appoints a patent agency for applying for a patent , or for having other patent matters to attend to before the Patent Office, shall submit a power of attorney. The power of attorney shall be in the unified form prescribed by the Patent Office, and shall indicate the scope of the authorized power, the title of the invention-creation, the names of the patent agency and the patent agent, which shall be the same as that appearing in the request. Where the power of attorney is submitted after the application number of the application is accorded, the application number shall also be indicated.

The power of attorney shall be signed or sealed by the applicant if the applicant is an individual. Where the applicant is an entity, the power of attorney shall be sealed by the entity, and may also be signed or sealed by its legal representative. Where there are two or more applicants, the power of attorney shall be signed or sealed by all of the applicants. In addition, the official seal of the patent agency shall be affixed on the power of attorney.

Where any applicant appoints a patent agency, a general power of attorney may be deposited with the Patent Office. Where a due general power of attorney is received, the Patent Office shall accord a number to it and notify the patent agency accordingly. After a general power of attorney has been deposited, when filing a patent application, the applicant may submit a copy of the general power of attorney instead of the original, and indicate the title of the invention-creation, names of the patent agency and the patent agent, and the number of that general power of attorney accorded by the Patent Office. The official seal of the patent agency shall be affixed.

Where the power of attorney is not in conformity with the requirements, the examiner shall issue the *Notification to Make Rectification* inviting the patent agency to make rectifications within the specified time limit. Where the first applicant is an entity or individual of mainland China, and no response is made within the time limit or the rectification made by the applicant is still not in conformity with the requirements, the examiner shall issue the *Notification that Patent Agen-*

*cy Deemed Not to Have Been Appointed* to both parties. Where the first applicant is a foreign individual, foreign enterprise or other type of organization, if no response is made within the time limit, the examiner shall issue the *Notification that Application Deemed to be Withdrawn*. If the requirements are still not met after rectification, the patent application shall be rejected. Where the first applicant is an individual, enterprise or other organization of Hong Kong, Macao or Taiwan, if no response is made within the time limit, the examiner shall issue the *Notification that Application Deemed to be Withdrawn*. If the requirements are still not met after rectification, the patent application shall be rejected.

### 6.1.3 Dissolution of Appointment and Resignation of Appointment

After the applicant (or patentee) appoints a patent agency, he may dissolve the appointment. After the patent agency accepts the applicant's (or patentee's) appointment, it may resign from the appointment as well. The provisions of section 6.7.2.4 of this chapter shall apply for the formalities of going through the dissolution or resignation of appointment.

## 6.2 Claiming Right of Priority

Claiming the right of priority means that the applicant claims in an application filed with the Patent Office to enjoy a right of priority on the basis of one or more previous filed applications in accordance with Article 29. Claiming the right of priority shall be in conformity with the provisions of Articles 29 and 30, Rules 31 and 32, and the relevant provisions of the Paris Convention.

Art. 29.1

Where an applicant files an application in China within twelve months from the date of filing his first application for invention or utility model of the same subject matter in a foreign country or within six months from the date of filing his first application for design of the same subject matter in a foreign country, he may enjoy the right of priority in accordance with the agreement concluded between that county and China or international treaties to which both countries are parties, or under the principle of reciprocity on priority. Such right of priority is called foreign priority.

Art. 29.2

Where the applicant, within twelve months from the date of filing his first application for invention or utility model of the same subject matter in China, files an application for invention or utility model on

the basis of the first filed application for invention, or files an application for utility model or invention on the basis of the first filed application for utility model with the Patent Office, he may enjoy the right of priority. Such priority is called domestic priority.

### 6.2.1 Claiming Foreign Priority

Art. 29.1

#### 6.2.1.1 Previous Application and Subsequent Application Claming Priority

Where any applicant files a patent application which contains a declaration claiming the priority of a previous application filed in a foreign country, the examiner shall examine whether or not the previous application, as the basis of the right of priority, was filed in any country party to the Paris Convention, or is a region application or an international application which is valid in that country party to the Convention. If the application was filed in a country which is not party to the Paris Convention, the examiner shall examine whether or not that country recognizes the right of priority of China on the basis of the principle of reciprocity. The examiner shall also examine whether or not the applicant claiming the priority is entitled to the rights accorded under the Paris Convention, i. e., whether or not he is a national or resident of a country party to the Convention, or examine whether or not the applicant is a national or resident of a country recognizing the right of priority of China on the basis of the principle of reciprocity.

Furthermore, the examiner shall examine whether or not the subsequent application claiming priority is filed within the prescribed time limit. If this requirement is not complied with, the examiner shall issue the *Notification that Claim to Priority Deemed Not to Have Been Made*. Where there are two or more previous applications, the priority period shall be calculated from the date of filing of the first application. Where a certain subsequent application is filed later than the specified time limit, the examiner shall issue the *Notification that Claim to Priority Deemed Not to Have Been Made* regarding the declaration of claiming priority made later than the time limit.

In the course of the preliminary examination, the examiner shall not examine whether or not the previous application is the first application defined by the Paris Convention, and whether or not the subject matter of the subsequent application is identical with that of the previ-

ous application, unless the first application is obviously not in conformity with the relevant provisions of the Paris Convention, or the subject matter of the subsequent application is obviously not related with that of the previous application.

The previous application may be an application for inventor's certificate defined in Article 4 of the Paris Convention.

Art. 30
Rules 16(5) & 31.2

#### 6.2.1.2 Declaration of Claiming Priority

Where any applicant claims the right of priority, he shall make a declaration in the request when the patent application is filed. If the applicant fails to do so, the claim to the right of priority shall be deemed not to have been made.

The applicant shall, in his declaration, indicate the filing date and the application number of the previous application, which is the basis of the right of priority, and the name of the authority with which the application was first filed. Where one or two items of the date of filing, the filing application number of the earlier application and the name of the authority with which the application was first filed are missing or incorrect in the request, and the applicant has submitted a copy of the previous application document within the prescribed time limit, the examiner shall issue the *Notification to Rectify Formalities*. If the applicant fails to make any response within the time limit or the requirements are not met after rectification, the examiner shall issue the *Notification that Claim to Priority Deemed Not to Have Been Made*.

Where more priorities are claimed, but one or two items of the date of filing, the filing application number of the earlier application and the name of the authority with which the application was first filed are missing or incorrect in the request, and the applicant has submitted copies of the previous applications documents within the prescribed time limit, the examiner shall issue the *Notification to Rectify Formalities*. If the applicant fails to make any response within the time limit or the requirements are still not met after rectification, the priority shall be deemed not to have been made, and the examiner shall issue the *Notification that Claim to Priority Deemed Not to Have Been Made*.

#### 6.2.1.3 Copy of Previous Application Documents

Rule 31.1

The copy of the previous application document, which is the basis of the right of priority, shall be provided by the authority with which the previous application was filed. The formality of the copy of the

said application document shall be in conformity with the international practice. At least, the name of the authority with which the application was filed, the name of the applicant, the date of filing and the application number shall be indicated. Where the application is not in conformity with those requirements, the examiner shall issue the *Notification to Rectify Formalities*. If the applicant fails to make any response within the time limit, or if the rectification is not in conformity with the said requirements, it shall be deemed that no copy of the previous application document has been submitted, and the examiner shall issue the *Notification that Claim to Priority Deemed Not to Have Been Made*.

Where multiple priorities are claimed, the copies of all the relevant previous application documents shall be submitted. If this requirement is not met, the examiner shall issue the *Notification to Rectify Formalities*. If the applicant fails to make any response within the specified time limit or if the rectification is not in conformity with the requirements, it shall be deemed that copies of the previous application documents have not been submitted, and the examiner shall issue the *Notification that Claim to Priority Deemed Not to Have Been Made* regarding the declaration claiming that right of priority of which the copy of the previous application documents does not meet the requirements.

The copy of the previous application document shall be submitted within three months from the filing date of the subsequent application. If the said copy has not been submitted within the time limit, the examiner shall issue the *Notification that Claim to Priority Deemed Not to Have Been Made*.

Where, in accordance with the agreement between the State Intellectual Property Office and the said authority with which the previous application was filed, the Patent Office obtains a copy of the earlier application documents through electronic transmission or in any other manners, the copy of the earlier application documents certified by the authority shall be deemed to have been submitted by the applicant.

Where the copy of the previous application document which has been submitted to the Patent Office is required to be submitted again, the Chinese translation of the extract may be submitted instead, and indicates the application number of the subsequent application in the file of which the certified copy of the previous application document is deposited.

Rule 31.3

#### 6.2.1.4 Applicant of Subsequent Application

The applicant(s) of the subsequent application claiming the right of priority shall be the same as the applicant, or at least one of the applicants recorded in the certified copy of the previous application document.

Where the applicants of the two applications are entirely different, and the right of priority of the previous application has been assigned to the applicant of the subsequent application, a document certifying the assignment of the right of priority, signed or sealed by all of the applicants of the previous application, shall be submitted within three months from the filing date of the subsequent application. Where the previous application has several applicants and the subsequent application has several different applicants, a document certifying the assignment of the right of priority, signed or sealed by all of the applicants of the previous application, to all of the applicants of the subsequent application may be submitted; or a document certifying the assignment of the right of priority, signed or sealed respectively by all of the applicants of the previous application, to the applicants of the subsequent application may be submitted.

Where the applicant fails to submit a document certifying the assignment of the right of priority within the time limit or where the certifying document submitted is not in conformity with the requirements, the examiner shall issue the *Notification that Claim to Priority Deemed Not to Have Been Made.*

### 6.2.2 Claiming Domestic Priority

#### 6.2.2.1 Previous Application and Subsequent Application Claiming Priority

Rule 32.2

The previous application and the subsequent application claiming priority shall meet the following requirements:

(1) the previous application shall be a patent application for invention or for utility model, and it shall not be a divisional application, nor shall it be a patent application for design;

(2) no foreign or domestic priority has been claimed for the subject matter of the previous application, or though the foreign or domestic priority has been claimed, it does not enjoy the priority;

(3) no patent right has been granted for the subject matter of the

previous application; and

(4) the subsequent application which claims the right of priority has been submitted within twelve months from the filing date of the previous application.

When the requirement referred to above in item (3) is examined, the reference time shall be the filing date of the subsequent application claiming priority. When the requirement referred to above in item (4) is examined, where multiple priorities are claimed, the reference time shall be the filing date of the earliest application, i. e. , the subsequent application claiming priority shall be filed within twelve months from the filing date of the earliest application.

Where any one of the above requirements is not complied with, the examiner shall, regarding the declaration claiming priority which is not in conformity with the requirements, issue the *Notification that Claim to Priority Deemed Not to Have Been Made*.

When the claim to the right of priority is examined, if it is found that the *Notification to Grant Patent Right* and the *Notification to Go through Formalities of Registration* of the previous application have been sent out by the Patent Office and the applicant has gone through formalities of registration, the examiner shall issue the *Notification that Claim to Priority Deemed Not to Have Been Made* to the subsequent application. In the course of the preliminary examination, the examiner shall only examine whether or not the subject matter of the subsequent application is obviously not related to that of the previous application, and the examiner shall not examine whether or not the subject matter of the previous application and that of the subsequent application are identical in substance. Where the subject matter of the previous application and that of the subsequent application are obviously not related with each other, the examiner shall issue the *Notification that Claim to Priority Deemed Not to Have Been Made*.

Art. 30
Rules 16(5) & 31.2

**6.2.2.2 Declaration of Claiming Priority**

Any applicant who claims the right of priority shall make a declaration in the request when the application is filed. If the applicant fails to do so, the claim to the right of priority shall be deemed not to have been made.

The applicant shall indicate the date of filing, the application number of the previous application, which is the basis of the right of priority, and the name of the authority with which the previous appli-

cation was filed (in this case, China) in the declaration claiming the priority. If the applicant fails to indicate or indicates wrongly one or two items of those matters, the examiner shall issue the *Notification to Rectify Formalities*, if the applicant fails to make any response within the time limit, or if the rectification is still not in conformity with the requirements, the examiner shall issue the *Notification that Claim to Priority Deemed Not to Have Been Made.*

Where multiple priorities are claimed, if one of the written declaration fails to indicate or wrongly indicates one or two items of the filing date, application number, or the name of the authority with which the previous application was filed of the previous application, the examiner shall issue the *Notification to Rectify Formalities*, if the applicant fails to make any response within the time limit, or if the rectification is still not in conformity with the requirements, the claim to the right of priority shall be deemed not to have been made, and the examiner shall issue the *Notification that Claim to Priority Deemed Not to Have Been Made.*

Rule 31.1

**6.2.2.3 Copy of Previous Application Documents**

The copy of the previous application document shall be prepared by the Patent Office in accordance with the provisions. Where the right of domestic priority is claimed, if the date of filing and the application number of the previous application are indicated in the request by the applicant, the copy of the previous application documents shall be deemed to have been submitted.

Rule 31.3

**6.2.2.4 Applicant of Subsequent Application**

The applicant of the subsequent application claiming priority shall be the same as that of the previous application. If they are different, the applicant of the subsequent application shall submit a document certifying the assignment of the right of priority signed or sealed by all the applicants of the previous application within three months from the filing date of the subsequent application. Where the applicant of the subsequent application fails to submit such a document within the time limit or the document certifying the assignment of the right of priority fails to meet the requirements, the examiner shall issue the *Notification that Claim to Priority Deemed Not to Have Been Made.*

Rule 32.3

#### 6.2.2.5 Procedure of Previous Application Deemed to Have been Withdrawn

Where the right of domestic priority is claimed, the previous application shall be deemed to have been withdrawn from the date on which the subsequent application is filed.

Where any claim to the right of domestic priority made by the applicant is, after the preliminary examination, found to be in conformity with the provisions, the examiner shall issue the *Notification that Application Deemed to be Withdrawn* to the previous application. Where two or more domestic priorities are claimed, if the claims are, after the preliminary examination, found to be in conformity with the provisions, the examiner shall issue the *Notification that Application Deemed to be Withdrawn* to the relevant previous applications.

Any application that is deemed to have been withdrawn in such circumstance shall not be restored by request.

### 6.2.3 Withdrawal of Claim to the Right of Priority

The applicant may withdraw his claim to the right of priority after claiming the priority. Where multiple priorities are claimed, the applicant may withdraw his claim to one or some or all of the rights of priority.

Where any applicant withdraws his claim to the right of priority, he shall submit a declaration of withdrawal of the right of priority signed or sealed by all the applicants. If the declaration is in conformity with the provisions, the examiner shall issue the *Notification of Passing Examination on Formalities.* If the declaration does not comply with the provisions, the examiner shall issue the *Notification that Declaration Deemed Not to Have Been Submitted.*

Where the earliest priority date of a patent application is changed due to the withdrawal of a claim to the right of priority, and the various time limits from that priority date have not expired, these time limits shall be recalculated from the earliest priority date or the filing date after the change. Where the request for withdrawal of the claim to the right of priority reaches the Patent Office after fifteen months from the original earliest priority date, the time limit for publication of the subsequent application shall be still calculated from the original earliest priority date.

Where any applicant claims the right of domestic priority, after

the withdrawal of the priority, the previous application, which has been deemed to be withdrawn under Rule 32.3, shall not be requested to be restored due to the withdrawal of the priority claim.

### 6.2.4 Fee for Claiming Priority

Rule 93.1(1)
Rule 95.2

Where any claim to the right of priority is made, the applicant shall pay the fee for claiming priority when paying the filing fee. If the fee is not paid or not paid in full within the time limit, the examiner shall issue the *Notification that Claim to Priority Deemed Not to Have Been Made*.

Where the claim to the right of priority is deemed not to have been made or is withdrawn, the fee paid for claiming priority shall not be refunded.

### 6.2.5 Restoration of Claim to Right of Priority

Where the claim to the right of priority is deemed not to have been made and one of the following circumstances is met, the applicant may request to restore the right of claiming priority in accordance with the provisions of Rule 6:

(1) where the claim to the right of priority is deemed not to have been made because the applicant has failed to make any response to the *Notification to Rectify Formalities* within the specified time limit;

(2) where at least one item is filled correctly in the declaration claiming the priority, but the copy of the previous application document or the document certifying the assignment of the right of priority has not been submitted within the prescribed time limit;

(3) where at least one item is filled correctly in the declaration claiming the priority, but the fee for claiming the right of priority has not been paid or not paid in full within the prescribed time limit; or

(4) where the initial application of the divisional application has claimed the right of priority.

The provisions of Chapter 7, Section 6 of Part V of the Guidelines shall apply concerning dealing with the request for restoration of right.

Except for the above circumstances, the right of priority that is deemed not to have been made due to other reasons shall not be restored. For example, where the claim to the right of priority is deemed not to have been made by reason that the applicant fails to make a declaration in the request when the patent application is filed, the right of claiming priority shall not be restored.

### 6.3 Non-Prejudicial Disclosures

Article 24 provides that an invention-creation for which a patent is applied for does not lose its novelty if, within six months before the date of filing (or the priority date where priority is claimed), one of the following events occurred:

(1) where it was first exhibited at an international exhibition sponsored or recognized by the Chinese Government;

(2) where it was first made public at a prescribed academic or technological meeting; or

(3) where it was disclosed by another person without the consent of the applicant.

Rule 30.1

#### 6.3.1 First Exhibited at an International Exhibition Sponsored or Recognized by the Chinese Government

The international exhibitions sponsored by the Chinese Government include those sponsored by the State Council or its departments, or by other institutions or local governments approved by the State Council. The international exhibitions recognized by the Chinese Government refer to the international exhibitions that are registered with or recognized by the International Exhibitions Bureau as stipulated by the International Exhibitions Convention. The international exhibitions refer to those at which exhibits shall be from foreign countries as well as from the organizing country.

Where an invention-creation for which a patent is applied for was first exhibited at an international exhibition sponsored or recognized by the Chinese Government within six months before the date of filing, if the applicant requests the grace period concerning novelty, the applicant shall make a declaration in the request while filing the application, and submit certifying materials within two months from the filing date.

The certifying materials of the international exhibition shall be provided by the organizer of the exhibition. In the certifying materials shall be indicated the date, venue, and name of the exhibition, and the exhibition date, form and contents of the invention-creation with the official seal of the organizer affixed.

Rule 30. 2

### 6.3.2 First Made Public at a Prescribed Academic or Technological Meeting

Prescribed academic or technological meetings refer to those organized or held by the competent authorities under the State Council or national academic organizations, excluding those held below the provincial level or with the entrustment or in the name of the departments under the State Council or national academic organizations. Disclosure at a meeting of the latter nature is prejudicial to the novelty of the content, unless there is an agreement on confidentiality being concluded on such a meeting.

Where an invention-creation for which a patent is applied for was first made public at a prescribed academic or technological meeting within six months before the date of filing, if the applicant requests the grace period concerning novelty, the applicant shall make a declaration in the request while filing the application, and submit certifying materials within two months from the filing date.

The certifying materials of the academic or technological meetings shall be provided by the competent authority under the State Council or national academic organizations organizing the meeting. In the certifying materials shall be indicated the date, venue and name of the meeting, and the publication date, form, and contents of the invention-creation with the official seal of the organizer affixed.

### 6.3.3 Disclosed by Another Person Without the Consent of the Applicant

The disclosure made by any other person without the consent of the applicant includes the disclosure of the contents of an invention-creation by another person for his failure to comply with the explicit or implicit confidentiality agreement, and disclosure caused after another person gets to know the contents of an invention-creation from the inventor or applicant by means of coercion, fraud or espionage.

Where an invention-creation for which a patent is applied for is disclosed by another person without the consent of the applicant within six months before the date of filing, if the applicant knows about it before the date of filing, the applicant shall make a declaration in the request while filing the application, and submit certifying materials within two months from the filing date. If the applicant knows about the matter after the date of filing, he shall submit a declaration to request

for the grace period concerning novelty with certifying materials within two months after he knows about it. The examiner may, when necessary, require the applicant to submit the relevant certifying materials within the specified time limit.

In the certifying materials submitted by the applicant on the disclosure of the application contents by another person shall be indicated the date, manner and contents of the disclosure, which shall be signed or sealed by an attester.

Where the request for the grace period concerning novelty by the applicant is not in conformity with the above provisions, the examiner shall issue *the Notification that Grace Period Concerning Novelty Deemed Not to Have Been Claimed*.

### 6.4 Request for Substantive Examination

The procedure of substantive examination of a patent application for invention shall commence mainly at the request of the applicant for a substantive examination.

#### 6.4.1 Relevant Requirements of Request for Substantive Examination

Art. 35.1
Rules 93.1(2) & 96

The request for substantive examination shall be made within three years from the date of filing (or priority date where priority is claimed) and the substantive examination fee shall be paid within the time limit.

Art. 36

When the applicant for a patent for invention requests substantive examination, he shall furnish pre-filing-date (or pre-priority-date where priority is claimed) reference materials concerning the invention.

#### 6.4.2 Examination and Handling of Request for Substantive Examination

The request for substantive examination shall be examined in accordance with the following requirements:

(1) where the applicant has not submitted the request for substantive examination within three months before the expiration of the time limit, the Patent Office shall issue the *Notification Before Expiration of Time Limit*.

(2) where the request for substantive examination has been made and the substantive examination fee has been paid within the time limit, but the formalities of the request for substantive examination have

not been in conformity with the requirements, the examiner may issue the *Notification that Request Deemed Not to Have Been Submitted*. If the *Notification Before Expiration of Time Limit* has been issued, the examiner shall issue the *Notification to Rectify Formalities* to invite the applicant to make rectifications within the specified time limit. If no rectification is made within the time limit or if the rectification is not in conformity with the provisions, the examiner shall issue the *Notification that Request Deemed Not to Have Been Made*.

(3) where the applicant fails to submit the request for substantive examination within the prescribed time limit, or if the substantive examination fee is not paid or not paid in full within the prescribed time limit, the examiner shall issue the *Notification that Application Deemed to be Withdrawn*.

(4) where the formalities for substantive examination are in conformity with the provisions, the examiner shall issue the *Notification that Patent Application for Invention Entering the Substantive Examination Stage* when the application enters the procedure of substantive examination.

Rule 46

**6.5 Request for Earlier Publication**

The request for earlier publication is applicable only to patent applications for invention.

Where the applicant makes a request for earlier publication, the publication shall not be subject to any condition.

Where any declaration of request for earlier publication is not in conformity with the provisions, the examiner shall issue *the Notification that Request Deemed Not to Have Been Made*; otherwise the preparation of publication shall be started promptly after the patent application passes the preliminary examination. After the application enters the preparation of publication, any request made by the applicant for revoking the previous request for earlier publication shall be deemed not to have been made, and the application documents shall be published in due course.

Art. 32
Rule 36.1

**6.6 Declaration of Withdrawal of Patent Application**

Any applicant may request to withdraw his patent application at any time before the patent right is granted. When withdrawing a patent application, the applicant shall submit a declaration of withdrawal of the patent application with materials signed or sealed by all the ap-

plicants certifying agreement on the withdrawal of the patent application, or submit only a declaration of withdrawal of the patent application signed or sealed by all the applicants. Where any patent agency is appointed, the formalities of withdrawing the patent application shall be gone through by the patent agency with materials signed or sealed by all the applicants certifying agreement on the withdrawal of the patent application, or submit only a declaration of withdrawal of the patent application signed or sealed by the patent agency and all the applicants.

When a declaration of withdrawal of a patent application is submitted, the withdrawal shall not be subject to any condition.

Where the declaration of withdrawal of a patent application is not in conformity with the provisions, the examiner shall issue the *Notification that Declaration Deemed Not to Have Been Submitted*. If the declaration complies with the provisions, the examiner shall issue the *Notification of Passing Examination on Formalities*. The effective date of withdrawal of a patent application is the date of issuance of the *Notification of Passing Examination on Formalities*. Where the patent application for invention has been published, the withdrawal shall be announced on the Patent Gazette. The applicant shall not request to revoke the declaration of withdrawal of a patent application without justified reasons. Where the declaration of withdrawal is made in bad faith by a person who unlawfully usurped the right to apply for the patent, the person who has the right to apply for the patent (the valid legal proof shall be submitted) may request that the declaration of withdrawal of the patent application be revoked.

Rule 36.2

Where any declaration to withdraw a patent application is submitted after the preparation of publication, the application documents shall be published or announced as scheduled, but the examination procedures shall come to an end.

### 6.7 Changes in Bibliographic Data

The bibliographic data (i. e., bibliographic matters) includes the application number, filing date, title of invention-creation, classification symbol, information relating to priority (including the application number, the filing date, and the name of the competent authority of the earlier application), information relating to the applicant or the patentee (including his/its name, nationality or country/region in which it is registered, address and postcode, organizational code or number of

identification card), name of the inventor, information relating to the patent agency (including its name, its organizational code, address and postcode, name of the patent agent, his certificate number, and the telephone number), information relating to the contact person (including his name, address and postcode, and the telephone number), and representative, etc.

Where any of the bibliographic data concerning information relating to personnel (referring to information relating to the applicant or patentee, name of the inventor, information relating to the patent agency, information relating to the contact person and representative) has changed, the party concerned shall go through formalities to make a change in the bibliographic data in accordance with the relevant provisions. Where any other bibliographic data has changed, the Patent Office may make changes *ex officio* in the light of specific circumstances.

Art. 10
Rule 119. 2

Where the patent application right (or the patent right) is assigned or is transferred for any other reason, the applicant or patentee shall register it with the Patent Office in the form of changes in the bibliographic data.

### 6. 7. 1 Formalities of Making Changes in Bibliographic Data

#### 6. 7. 1. 1 Statement for Change in Bibliographic Data

Where any change in the bibliographic data is requested, it is required to submit the statement for change in bibliographic data. Where several items of the bibliographic data of a patent application are to be changed at the same time, only one such statement is required to be submitted. Where the same item of the bibliographic data of one patent application is to be changed continuously, one statement for each of the changes is required to be submitted respectively. Where the same item of the bibliographic data of several patent applications is to be changed, even if the contents to be changed are completely identical, one statement for each application is required to be submitted.

Rule 93. 1(5)

#### 6. 7. 1. 2 Handling Fee for Change in Bibliographic Data

When a request for a change in the bibliographic data is submitted, the handling fee for a change in the bibliographic data shall be paid in accordance with the relevant provisions. The handling fee for a change in the bibliographic data in the patent fee schedule prescribed by the Patent Office refers to the fee for each request for each change

in the bibliographic data of each patent application. In going through the formalities of a change in bibliographic data in one patent application (or patent), where the applicant makes a request for change in the same item of the bibliographic data continuously, it shall be regarded as one change. Where the applicant requests to change the inventor and/or the applicant (or patentee), 200 Yuan shall be paid for a change in the bibliographic data. Where the applicant requests to change the patent agency and/or agent, 50 Yuan shall be paid for a change in the bibliographic data.

For example, in going through the formalities of a change in bibliographic data, where the applicant requests to change the applicant of a patent application from A to B, and then from B to C, such continuous change shall be regarded as one change in the bibliographic data of applicant, and 200 Yuan shall be paid for a change in the bibliographic data. If at the same time requesting to change the name of the inventor, the applicant is still only required to pay 200 Yuan for a change in one item in the bibliographic data.

For another example, in going through the formalities of a change in bibliographic data, where the applicant requests to change the applicant of a patent application from A to B, and at the same time requests to change the patent agency and agent, 200 Yuan shall be paid for a change in the bibliographic data of the applicant and 50 Yuan shall be paid for a change in the bibliographic data of patent agency and agent by the applicant.

Rule 99.3

#### 6.7.1.3 Time Limit for Paying Handling Fee for Change in Bibliographic Data

Unless otherwise prescribed in the provisions, the handling fee for a change in the bibliographic data shall be paid within one month from the date on which the request concerned is submitted. If the fee is not paid or not paid in full within the time limit, the request for a change in the bibliographic data shall be deemed not to have been made.

#### 6.7.1.4 Person Going through Formalities of Change in Bibliographic Data

Where no patent agency is appointed, the applicant (or patentee), or his representative shall go through the formalities of a change in the bibliographic data. Where any patent agency has been appointed, the formalities shall be gone through by the patent agency. Where the

change is due to the transfer of the right, the formalities may be gone through by the new right owner or his appointed patent agency.

Art. 10

### 6.7.2 Certifying Documents for Change in Bibliographic Data

Rule 119.2

#### 6.7.2.1 Change of Name of Applicant (or Patentee)

(1) Where any person submits the request for a change due to the change of his name, certifying document provided by the household registration administrative authority shall be submitted.

(2) Where any person submits the request for a change due to writing errors, a declaration signed or sealed by himself and the document certifying his identification shall be submitted.

(3) Where any legal person of an enterprise submits the request for a change due to the change of its name, the certifying document provided by the administrative authority for industry and commerce shall be submitted.

(4) Where any legal person of an institute or social body submits the request for a change due to the change of its name, the certifying document provided by registration administrative authority shall be submitted.

(5) Where any legal person of an administrative organ submits the request for a change due to the change of its name, the certifying document provided by the administrative authority of the next higher level shall be submitted.

(6) Where any other type of organization submits the request for a change due to the change of its name, the certifying document provided by the registration administrative authority shall be submitted.

(7) Where any foreign individual, enterprise, or other type of organization submits the request for a change due to the change of his/its name, the corresponding certifying document shall be submitted with reference to the above-mentioned provisions.

(8) Where any foreign individual, enterprise, or other type of organization submits the request for a change due to the change in the Chinese translation of his/its name, the applicant's (or patentee's) declaration shall be submitted.

Rule 14.1

#### 6.7.2.2 Transfer of Right to Apply for a Patent (or Patent Right)

(1) Where the request for a change is submitted due to a right transfer as a result of a dispute over the ownership of the right of the

applicant (or patentee), the person requesting a change in the bibliographic data shall submit an agreement of transfer of the right signed or sealed by all the interested parties if the dispute has been settled through negotiations; if the dispute is settled by the local intellectual property administrative authority through mediation, the mediation award of the said authority shall be submitted; or if the dispute is settled by the People's Court through mediation or judgment, the mediation award or judgment of the People's Court which has taken effect shall be submitted. With regard to the judgment made by a first-instance court, the examiner shall, after receiving the judgment, inquire the parties concerned whether or not an appeal has been lodged. Where no response is made or no appeal has been lodged within the specified time limit, the change shall be made in accordance with the said judgment. If an appeal has been lodged, the interested party shall furnish the certifying documents provided by the People's Court of the higher level, and the initial judgment of the People's Court shall no longer have any legal effect. Where the dispute is settled by an arbitration organization through mediation or arbitration, the mediation or arbitration award shall be submitted.

(2) Where the right of the applicant (or patentee) has been transferred because of assignment or gift, and a request for a change in the bibliographic data is submitted, the contract on the assignment or gift shall be submitted. If such a contract is concluded by any entity, the official seal of the entity or the seal specially used for concluding contracts shall be affixed. If the contract is concluded by any individual, it shall be signed or sealed by the person himself. Where there are two or more applicants (or patentees), a document certifying that all the right owners have agreed on the assignment or gift shall be submitted.

(3) Where the assignment (or gift) of the right to apply for a patent (or the patent right) involves a foreign individual, enterprise or other type of organization, any request for a change in the bibliographic data shall be in conformity with the following provisions:

(i) where both the assignor and the assignee are foreign individuals, enterprises, or other type of organizations, the contract on the assignment signed or sealed by both parties shall be submitted;

Art. 10

(ii) for an application for patent for invention or utility model (or patent), where the assignor is an individual or entity of mainland China and the assignee is a foreign individual, enterprise or other type of organization, the technology export license or the freely export tech-

nology contract registration certificate issued by the competent authority for commerce under the State Council, or the Freely Export Technology Contract Registration Certificate issued by the local competent authority for commerce, along with the contract on assignment signed or sealed by both parties, shall be submitted; or

(iii) where the assignor is a foreign individual, enterprise or other type of organization and the assignee is an individual or entity of mainland China, the contract on assignment signed or sealed by both parties shall be submitted.

Where an individual or entity in mainland China and a foreign individual, enterprise or other type of organization are joint assignors, and the assignee is a foreign individual, enterprise or other type of organization, the provisions of item (ii) shall apply; where an individual or entity in mainland China and a foreign individual, enterprise or other type of organization are joint assignees, and the assignor is a foreign individual, enterprise or other type of organization, the provisions of item (iii) shall apply.

Where an individual or entity in mainland China and an individual, enterprise or other organization of Hong Kong, Macao or Taiwan are joint assignor, and the assignee is a foreign individual, enterprise or other type of organization, the provisions of item (ii) shall apply; where an individual or entity of mainland China and an individual, enterprise or other organization of Hong Kong, Macao, or Taiwan are joint assignee, and the assignor is a foreign individual, enterprise or other type of organization, the provisions of item (iii) shall apply.

Where the assignor is an individual or entity in mainland China and the assignee is an individual, enterprise or other organization of Hong Kong, Macao or Taiwan, the provisions of item (ii) shall apply.

(4) Where any applicant (or patentee), which is an entity, requests to make a change in the bibliographic data due to merger, breakup, winding-up, or changed organization form, certifying documents provided by the registration administrative authority shall be submitted.

(5) Where any applicant (or patentee) requests to make a change in the bibliographic data due to succession, a document that has been notarized certifying that the interested party is the only legitimate successor or the interested party has included all successors in title. The joint successors in title shall inherit jointly the right to apply for a patent (or the patent right) except where otherwise provided for in a law.

(6) Where the request to make a change is due to auction of the

right to apply for a patent (or the patent right), legally valid certifying documents shall be submitted.

(7) For the transfer of patent right in hypothecation, documents certifying the agreement on the change from both parties of hypothecation shall be submitted besides required certifying documents for the change.

Rule 119.2

#### 6.7.2.3 Change of Inventor

(1) Where the request to make a change is due to the change of the inventor's name, the provisions of Section 6.7.2.1 (1) of this chapter shall apply.

(2) Where the request to make a change is due to failure to fill in the name of inventor or his wrong name filled in, the certifying document signed or sealed by all the applicants (or patentees) and all the inventors before the change shall be submitted.

(3) Where the request to make a change is due to the dispute over the eligibility of the inventor, the provisions of Section 6.7.2.2 (1) of this chapter shall apply.

(4) Where the request to make a change is due to the change of the Chinese translation, the inventor's declaration shall be submitted.

Rule 119.2

#### 6.7.2.4 Change of Patent Agency and Agent

(1) Where a patent agency changes its name or address, it shall firstly request to make a change in the registration at the competent department of the State Intellectual Property Office. After the change in the registration takes effect, the Patent Office shall make changes in the bibliographic data of all the valid patent applications and patents for which it acts as the patent agency. The patent agency shall go through the formalities for the change of a patent agent for each application having such change.

(2) Before going through the formalities of dissolution or resignation of appointment, one party shall inform the other party in advance.

To dissolve the appointment, the applicant (or patentee) shall submit the request for making a change in the bibliographic data and attach a dissolution signed or sealed by all the applicants (or patentees), or shall submit only the request for making a change in the bibliographic data signed or sealed by all the applicants (or patentees).

To resign from the appointment, the patent agency shall submit the request for making a change in the bibliographic data, and attach a

declaration of accepting resignation from the appointment signed or sealed by the applicant (or patentee) or its representative, or a declaration sealed by the patent agency indicating the applicant (or patentee) has been notified.

Before the formalities of making a change take effect (i. e., the *Notification of Passing Examination on Formalities* is issued), the agency relationship is still valid and the acts performed by the patent agency on behalf of the applicant (or patentee) shall remain valid after the formalities of making a change take effect. Where the formalities for a change are not in conformity with the provisions, the examiner shall issue the *Notification that Request Deemed Not to Have Been Submitted* to the party going through the formalities for a change. Where the formalities for a change meet the requirements, the examiner shall issue the *Notification of Passing Examination on Formalities* to parties.

Where the first applicant is a foreign applicant having no habitual residence or business office in the mainland China, when going through the formalities of dissolving or resigning the appointment, the applicant (or patentee) shall at the same time appoint a new patent agency, otherwise the formalities of dissolving or resigning the appointment shall not be gone through, and the examiner shall issue the *Notification that Request Deemed Not to Have Been Made*.

Where the first applicant is from Hong Kong, Macao, or Taiwan having no habitual residence or business office in the mainland China, when going through the formalities of dissolving or resigning the appointment, the applicant (or patentee) shall at the same time appoint a new patent agency, otherwise the formalities of dissolving or resigning the appointment shall not be gone through, and the examiner shall issue the *Notification that Request Deemed Not to Have Been Made*.

(3) Where any applicant (or patentee) changes his patent agency, the declaration dissolving the appointment of the initial patent agency and the power of attorney of the new appointed patent agency, signed or sealed by all the applicants (or patentees), shall be submitted.

(4) Where the right to apply for a patent (or the patent right) is transferred, if the applicant (or patentee) after the change appoints a new patent agency, the power of attorney signed or sealed by all the applicants (or patentees) after the change shall be submitted. Where the applicant (or patentee) after the change appoints the initial patent agency, the power of attorney signed or sealed by the newly added applicant (or patentee) shall be submitted.

Rule 119.2

#### 6.7.2.5 Change of Nationality of Applicant (or Patentee)

Where any applicant (or patentee) changes his nationality, documents certifying his identification shall be submitted.

Rule 120

#### 6.7.2.6 Formalities Requirements for Certifying Documents

(1) For any submitted certifying document, the application number (or patent number), the title of invention-creation and the name of the applicant (or patentee) shall be indicated.

(2) One certifying document corresponds to only one request to make a change in the bibliographic data. Separate certifying documents shall be submitted for continuous changes of the same item in the bibliographic data.

(3) The certifying document shall be the original. Where the certifying document is a copy, it shall be notarized or affixed with the official seal of the competent department providing the certifying document (except that the original document has been deposited for the record in the Patent Office). Where the certifying document formed in a foreign country is a copy, it shall be notarized.

### 6.7.3 Examination and Approval of Request for Change in Bibliographic Data

The examiner shall examine in accordance with the statement for change in bibliographic data and the attached certifying document submitted by the parties involved. Where the formalities of requesting to make a change in the bibliographic data are not in conformity with the provisions, the *Notification that Request Deemed Not to Have Been Made* shall be sent to the requesting person. Where the formalities of requesting to make a change in the bibliographic data are in conformity with the provisions, the *Notification of Passing Examination on Formalities* shall be sent to the parties concerned, informing them the state of the bibliographic data before and after the change. If the change is required to be announced, the requesting person shall also be informed of the volume number and the issue number of the Patent Gazette in which the announcement is scheduled.

Where the change in the bibliographic data relates to the transfer of the relevant right, the *Notification of Passing Examination on Formalities* shall be issued to both parties. Where one request for change of the applicant (or patentee) involves several continuous changes, the

*Notification of Passing Examination on Formalities* shall be issued to the applicant (or patentee) before the change and the applicant (or patentee) after the last change. The applicant (or patentee) indicated in the notification shall be the applicant (or patentee) after the change. Where the request for making a change concerns the change of the patent agency, the notification shall be sent to both patent agencies before and after the change. At the same time, the examiner shall complete the followings:

(1) where reduction or postponement of payment of fees are involved:

(i) where all the applicants (or patentees) have been changed, the reduction or postponement of payment of fees will not be granted if the new applicant (or patentee) does not request it. The examiner shall change the sign marking the reduction or postponement of payment of fees in the database and notify the applicant (or patentee);

(ii) where the number of applicants (or patentees) increases after the change, the reduction or postponement of payment of fees will not be granted if the new added applicant (or patentee) does not request it. The examiner shall change the sign marking the reduction or postponement of payment of fees in the database and notify the applicant (or patentee);

(iii) where the number of applicants (or patentees) decreases after the change, the proportion of reduction or postponement of payment of fees shall not be changed if the applicant (or patentee) does not request it.

The applicant (or patentee) after the change may again go through the formalities of request for reduction or postponement of payment of fees in accordance with the rules for reduction or postponement of payment of fees.

(2) Where the applicant (or patentee) has filled in the information of the contact person before the change, if the applicant (or patentee) after the change does not appoint as such, the examiner shall delete the information of the contact person appointed by the former applicant (or patentee) in the database.

(3) Where the appointment of a patent agency is involved, if the applicant (or patentee) after the change has not appointed any patent agency, the examiner shall delete the information of the patent agency appointed by the former applicant (or patentee) in the database.

(4) Where the change shall be announced in the Patent Gazette in

accordance with the provisions, e. g. , the change of the patentee, etc. , the information before and after the change shall be announced.

(5) Where the name or address of a patent agency is changed, or the revocation of patent agency is approved in accordance with the Rules Governing Patent Agency, the examiner shall complete the following:

(i) as for the uniformly handling due to the group change of the patent agency in the bibliographic data and revocation of patent agency, the relevant bibliographic data in database shall be amended uniformly;

(ii) where the applicant (or patentee) of the patent application (or patent) having appointed the revoked patent agency is an individual or entity in mainland China, the first applicant (or patentee) shall be deemed to be the representative of the patent application from the date of the announcement of the said revocation unless otherwise declared. The applicant (or patentee) may appoint another patent agency.

Art. 10. 3

### 6.7.4 Taking Effect of Change in Bibliographic Data

(1) The change in the bibliographic data shall take effect from the date of issuance of *Notification of Passing Examination on Formalities* by the Patent Office. Transfer of the right to apply for a patent (or the patent right) shall take effect from the date of registration, which is the date of issuance of the above *Notification of Passing Examination on Formalities*.

(2) Before the formalities of change in the bibliographic data take effect, the notification issued by the Patent Office and the relevant matters under the preparation for publication or announcement shall be based upon those before the change.

Rule 44

## 7. Examination on Obvious Substantive Defects

### 7.1 Examination According to Article 2.2

According to Article 2. 2, “invention” in the Patent Law means any new technical solution relating to a product, a process or improvement thereof.

In the preliminary examination, where the application documents describe part of the technical features of the “invention”, the examiner may not judge whether or not the technical solution is complete, or may not judge whether or not the technical solution can be carried

out. However, if there are only descriptions of technical index, advantages and effects but no description relating to the solution of a technical problem or even no description of technical contents, the examiner shall issue the Office Action and invite the applicant to make observations or amendments within the specified time limit. If no response is made within the specified time limit, the examiner shall issue the *Notification that Application Deemed to be Withdrawn*. If the application is still not in conformity with the provisions after the applicant has made observations or amendments, the examiner may reject the application.

### 7.2 Examination According to Article 5

According to Article 5, no patent right shall be granted for any invention-creation that is contrary to the laws or social morality or that is detrimental to public interest, and no patent right shall be granted for an invention-creation where acquisition or use of genetic resources, on which the development of the invention-creation relies, is not consistent with the requirements of the laws and administrative regulations.

In preliminary examination, the examiner shall, under the provisions of Chapter 1, Section 3 of Part II of the Guidelines, examine whether or not the invention-creation is obviously contrary to the laws, or obviously contrary to social morality, or obviously detrimental to public interest; where the development of the invention-creation relies on the said genetic resources, the examiner shall examine whether or not the acquisition or use of genetic resources is obviously contrary to the relevant laws and administrative regulations. If the examiner finds that the entire contents or part of the contents of the application fall under one of those aspects mentioned above, for example, if the applicant filed an application with the following or similar contents: “A kind of drug taking tool”, “A kind of tool for gambling and the method of its use”, the examiner shall issue the Office Action, state the reasons, and notify the applicant to submit observations or to delete the relevant part within the specified time limit. If the observations submitted by the applicant are not sufficient to justify that the relevant invention does not fall under Article 5, or the applicant refuses to delete the relevant part of the invention without any fully justified reason, the examiner shall reject the application. If the applicant has deleted the relevant part of the invention as requested by the examiner, and added a few words or sentences that are indispensable from the context, it shall be permitted.

Rule 10

Any invention-creation that is contrary to Article 5 referred to in the above paragraph shall not include the invention-creation merely because the exploitation of which is prohibited by the laws.

**7.3 Examination According to Article 20.1**

According to Article 20.1, where any applicant intends to file an application abroad for any invention developed in China, it or he shall file it in advance with the Patent Office for confidentiality examination.

According to Rule 8.1, the invention developed in China refers to an invention the substantive contents of the technical solution of which were made within the territory of China.

In preliminary examination, where the examiner finds, with justified reasons, that an application for patent has been filed in a foreign country in violation of above provisions, the examiner shall issue Office Action when a patent is applied for the same invention in China. If the observations made by the applicant fail to prove that the application does not fall under the circumstances mentioned above, the examiner may reject the application on the grounds of Article 20.1, Article 20.4, and Rule 44.

**7.4 Examination According to Article 25**

According to Article 25, no patent right shall be granted for any of the following subject matters:

(1) scientific discoveries;

(2) rules and methods for mental activities;

(3) methods for the diagnosis or for the treatment of diseases;

(4) animal and plant varieties; or

(5) substances obtained by means of nuclear transformation.

For processes used in producing products referred to in item (4) of the preceding paragraph, patent right may be granted in accordance with the provisions of the Patent Law.

In preliminary examination, the examiner shall, under the provisions of Chapter 1, Section 4 of Part II of these Guidelines, examine whether or not any invention for which a patent is applied for obviously falls under any of the subject matters for which no patent right shall be granted in accordance with Article 25. If it is found that the entire contents of the application belong to one of the subject matters described in Article 25, for example, the applicant filed an application for

patent for the following or similar contents: "A newly discovered minor planet", "A method for diagnosing diseases of the human body", the examiner shall issue the Office Action, state the reasons, and notify the applicant to submit observations within a specified time limit. If the applicant' s observations fail to prove that the subject matter of the application is not one of the subject matters mentioned above, the examiner may make a decision of rejection. If it is found that only a part of the contents of the application belongs to one of the subject matters mentioned above, and that part is difficult to be separated from the application, the application may be left to be handled in the substantive examination without any handling in the preliminary examination.

### 7.5 Examination According to Article 31.1

According to Article 31.1, a patent application for invention shall be limited to one invention. Two or more inventions belonging to a single general inventive concept may be filed as one application.

Rule 42.2

In preliminary examination, only when the application contains two or more inventions which obviously have not any relation with each other, the examiner shall issue the Office Action and notify the applicant to amend the application to meet the requirement of unity. If the applicant refuses to do so without any justified reason, the application may be rejected.

### 7.6 Examination According to Article 33

According to Article 33, an applicant may amend his patent application for invention, but the amendment to the application may not go beyond the scope of the disclosure contained in the initial description and claims.

In preliminary examination, only when the examiner issues the Office Action, and requests the applicant to amend the application, is it necessary to examine whether or not the amendments made by the applicant obviously go beyond the scope of the disclosure contained in the initial description and claims. If the amendments obviously go beyond the scope of the initial disclosure, for example, the applicant has amended the data or has expanded the scope of the numerical value, or has introduced a claim of a technical solution which has not been disclosed in the initial description, or has added one or more pages of the substantive contents of the invention which are not included in the initial description or claims, the examiner shall issue the Office Action

and notify the applicant that the amendments are not in conformity with the provisions of Article 33. If the amendments are still not in conformity with the requirements after the applicant makes observations or rectification, the examiner may make a decision of rejection.

In preliminary examination, where the applicant submits the text of amendments on his own initiative in accordance with Rule 51, the examiner, besides examining the formalities of the rectification, shall only examine whether or not the time for submitting the said amendments on the applicant's initiative is in conformity with the provisions of Rule 51. If it meets the requirements, the decision that the said amendments have passed the formal examination shall be made and the said amendments shall be kept in the file. If it does not meet the requirements, the decision providing reference for the substantive examination shall be made and the said amendments shall be kept in the file. The contents of the text of amendments submitted by the applicant on his own initiative shall not be examined and shall be left to be handled in the substantive examination.

### 7.7 Examination According to Rule 17

The description shall not use any words or sentences that have no relation to technology. Nor shall it contain any commercial advertising or any language belittling or slandering other persons or products of other persons. However, pointing out objectively the problems existing in the background art shall not be regarded as a belittling act. The description shall include technical contents of the invention. Where the description is obviously not in conformity with those requirements, the examiner shall issue the Office Action, state the reasons, and invite the applicant to make observations or rectifications within the specified time limit. If no response is made within the specified time limit, the examiner shall issue the *Notification that Application Deemed to be Withdrawn*. If the application is still not in conformity with the provisions after the applicant has made observations or rectifications, the examiner may reject the application.

In preliminary examination, if part of the technical features of the invention are described in the description, and its form is in conformity with the requirements of Section 4.2 of this Chapter, it is not necessary to examine other substantive issues, which shall be dealt with in the substantive examination.

### 7.8 Examination According to Rule 19

The claims shall describe the technical features of the invention.

The claims shall not contain any words or sentences that have no relation to the contents of the technical solution, such as "to ask for the protection of the right of production and sale under this patent", etc., nor shall the claims contain any commercial advertising, or any language belittling other persons or products of other persons.

In preliminary examination, where the claims are obviously not in conformity with those requirements, the examiner shall issue the Office Action, state the reasons, and invite the applicant to make observations or rectifications within the specified time limit. If no response is made within the specified time limit, the examiner shall issue the *Notification that Application Deemed to be Withdrawn*. If the application is still not in conformity with the provisions after the applicant has made observations or rectifications, the examiner may reject the application.

## 8. Amendment Made by Examiner *Ex Officio*

According to Rule 51.4, the examiner may make amendment *ex officio* to the obvious clerical mistakes and symbol mistakes in the documents of patent application for invention before the application is qualified to pass the preliminary examination, and notify the applicant accordingly. The usual circumstances of amendment *ex officio* include the following:

(1) request: amend the omission, error or repetition of the names of the province (autonomous region, the municipality directly under the Central Government), the names of the municipality, the postcode and other information in the address of the applicant or contact person;

(2) claims and description: correct the obvious clerical mistakes and punctuation mistakes, amend the obvious editorial mistakes, and delete the obviously unnecessary information. However, any amendment likely to cause the change of the scope of the disclosure contained in the initial application documents falls outside the scope of amendment *ex officio*; and

(3) abstract: add content obviously missing, correct the obvious clerical mistakes and punctuation mistakes, delete the obviously unnecessary information, and specify the figure accompanying the abstract.

# Chapter 2 Preliminary Examination of Patent Applications for Utility Model

## 1. Introduction

In accordance with the provisions of Articles 3 and 40, the Patent Office receives and examines patent applications for utility model. Where it is found after preliminary examination that there is no grounds for rejection of the application, the Patent Office shall make a decision to grant the patent right for utility model, issue the relevant patent certificate, and register and announce it. Hence, the preliminary examination of a patent application for utility model is a necessary procedure after the acceptance of a patent application for utility model, and before the grant of that application.

Rule 44.1

The scope of the preliminary examination of a patent application for utility model is as follows:

(1) formal examination of the application documents, including whether or not the patent application contains the application documents as provided for in Article 26, and whether or not the documents are in conformity with the provisions of Rules 2, 3, 16-23, 40, 42, 43.2, 43.3, 51, 52, 119, and 121;

(2) examination on obvious substantive defects of the application documents, including whether or not the patent application obviously falls under Article 5 or 25, or is obviously not in conformity with the provisions of Article 18, 19.1 or 20.1, or is obviously not in conformity with the provisions of Article 2.3, 22.2 or 22.4, 26.3 or 26.4, 31.1, 33, or Rules 17-22, 43.1, or is not entitled to a patent right in accordance with the provisions of Article 9;

(3) formal examination of other documents, including whether or not other formalities and documents relating to the patent application are in conformity with Articles 10.2, 24, 29, 30 and Rules 2, 3, 6, 15, 30, 31.1-31.3, 32, 33, 36, 45, 86, 100 and 119; and

(4) examination of the relevant fees, including whether or not the relevant fees for the patent application have been paid in accordance with Rules 93, 95 and 99.

## 2. Principles of Examination

In the procedure of preliminary examination, the examiner shall abide by the following principles of examination.

(1) Principle of confidentiality

In the patent application examination and approval proceedings, the examiner shall be obliged to keep confidential the patent application documents and other patent application related contents that are not published or announced, and other information that is not proper to be made known in accordance with the relevant provisions on confidentiality.

(2) Principle of written examination

The examiner shall examine on the basis of the written documents submitted by the applicant. The Office Action (including the *Notification to Make Rectification*) and the result of examination shall be sent in written form to notify the applicant. In the preliminary examination procedure, no interview shall be held in principle.

(3) Principle of hearing

Before making a decision of rejection, the examiner shall notify the applicant of the facts, grounds and evidence for rejection, and give the applicant at least one opportunity to make observations and/or amend the application documents. When the examiner makes a decision of rejection, the facts, grounds and evidence for rejection shall have been notified to the applicant, and the decision shall not contain any new facts, grounds and/or evidence.

(4) Principle of procedural economy

Where the provisions are complied with, the examiner shall improve the efficiency of examination as much as possible, and shorten the examination period. With regard to the application with defects that can be eliminated through rectifications, the examiner shall conduct a comprehensive examination and do his best to point out all the defects in one *Notification to Make Rectification*. With regard to the application with substantive defects that can not be eliminated through rectifications, the examiner may only point out the substantive defects in the Office Action without examining the formal defects in the application documents and other documents. With regard to the application with defects that all of them can be amended *ex officio*, the examiner may not issue the *Notification to Make Rectification*.

In addition to complying with the above principles, the examiner

shall notify the applicant of subsequent procedures that can be initiated while making the decision that any document relating to the patent application is deemed not to have been submitted, the decision that the application is deemed to have been withdrawn, or the decision of rejection.

### 3. Procedure of Examination

Art. 40

#### 3.1 Notification to Grant Patent Right

Where it is found after preliminary examination that there is no grounds for rejection of the patent application for utility model, the examiner shall make a decision to grant the patent right for utility model. The patent application for utility model for which the patent right may be granted includes the application which satisfies the requirements of the preliminary examination without the necessity of rectification and the application which meets the requirements of the preliminary examination through rectification.

The *Notification to Grant Patent Right* shall, besides the information of the addressee and the bibliographic data, include the text to which the right is granted and the name of the utility model. Where the examiner has made amendments *ex officio*, the corresponding content of the amendments shall be indicated.

#### 3.2 Rectification of Application Documents

During preliminary examination, for a patent application whose application documents have defects that can be eliminated through rectifications, the examiner shall conduct a comprehensive examination and issue the *Notification to Make Rectification*. Where the defects still exist in the application documents after the applicant makes rectification, the examiner shall issue another *Notification to Make Rectification*.

The *Notification to Make Rectification* shall, besides the information of the addressee and the bibliographic data, include the following contents:

(1) pointing out which documents the *Notification to Make Rectification* is directed to and when the applicant filed them;

(2) clearly and specifically pointing out the defects in the application documents, and pointing out what provisions of the Patent Law and its Implementing Regulations the application documents do not comply with;

(3) making the examiner's opinion clear and specific with possible suggestions so as to enable the applicant to understand the examiner's intentions;

(4) specifying the time limit of response to the *Notification to Make Rectification* for the applicant; and

(5) suggesting the applicant the types of documents and the required number thereof while making rectification.

### 3.3 Handling of Obvious Substantive Defects

During the procedure of the preliminary examination, if the examiner finds the application documents of a patent application have obvious substantive defects that cannot be eliminated through rectification, the examiner shall issue an Office Action.

The Office Action shall, besides the information of the addressee and the bibliographic data, include the following contents:

(1) pointing out which documents the Office Action is directed to and when the applicant filed them;

(2) clearly and specifically pointing out the defects in the application documents, and pointing out which provisions of the Patent Law and its Implementing Regulations the application documents do not comply with; with regard to the facts that the application includes obvious substantive defects, the examiner may make explanation in support of evidence when necessary;

(3) making clear the examiner's opinion that the patent application is to be rejected under the relevant provisions of the Patent Law and its Implementing Regulations; and

(4) specifying the time limit of response to the Office Action for the applicant.

### 3.4 Response to Notification

The applicant shall, after receiving the *Notification to Make Rectification* or the Office Action, make rectification or observations in the specified time limit. The applicant shall, when making rectification of the patent application, submit the rectification and the corresponding replacement sheets of the amended documents. The replacement sheets of the amended application documents shall be in duplicate, while only one copy is required for other documents. The amendment of the application documents shall be made to the defects pointed out in the *Notification to Make Rectification*. The content of amendment shall not go

beyond the scope described in the description and claims filed on the date of filing.

Where the applicant makes no response within the time limit, the examiner shall, depending on the circumstances, issue the *Notification that Application Deemed to be Withdrawn* or other notifications. Where it is difficult for the applicant to make response within the specified time limit due to justified reasons, he may request to extend the time limit. The provisions of Chapter 7, Section 4 of Part V of these Guidelines shall apply when handling the request for extension of the time limit.

Where a patent application is deemed to have been withdrawn resulting from failure to meet the time limit due to force majeure or with justified reasons, the applicant may, within the prescribed time limit, submit a request to the Patent Office for restoration of the right. The provisions of Chapter 7, Section 6 of Part V of these Guidelines shall apply when handling the request for restoration of the right.

### 3.5 Rejection of Application

#### 3.5.1 Conditions of Rejection

Where obvious substantive defects which, the examiner believes, can not be eliminated through rectifications exist in the application documents, if the applicant, within the specified time limit, has neither put forward any convincing observations and/or evidences, nor made any amendments on the defects pointed out in the notification after the examiner' s issuance of the Office Action, for example, the applicant only corrects the clerical mistakes or changes the expressions, the examiner may make a decision of rejection. Where the applicant has made amendments on the defects pointed out in the notification, another opportunity to make further observations and/or amendments to the application documents shall be provided to the applicant even if the said defects still exist. However, where the later amendments concern the same kinds of defects, if such defects which have been notified to the applicant still remain unrectified, the examiner may make a decision of rejection.

Where formal defects which can be eliminated through rectification exist in the application and remain unrectified after the applicant makes observations or rectification within the specified time limit upon the examiner' s issuance of the *Notification to Make Rectification* twice in respect of the said defects, the examiner may make a decision of rejection.

#### 3.5.2 The Text of Decision of Rejection

The text of the decision of rejection shall include three parts: brief of the case, grounds for rejection, and conclusion.

(1) The part of brief of the case shall indicate the text of the application upon which the decision of rejection is based and briefly state the examination procedure of the rejected application.

(2) The part of grounds for rejection shall state in detail the facts, grounds and evidence on which the rejection is based, with special attention paid to the following requirements:

(i) applying the provisions appropriately. Where a patent application can be rejected under different provisions of the Patent Law and its Implementing Regulations, the rejection shall be based upon the most applicable, dominant provisions, and all the other substantive defects in the patent application shall be indicated briefly; the provisions upon which rejection is based shall be included in the list provided in Rule 44.

(ii) basing the rejection on the convincing facts, grounds and evidence, and the hearing of these facts, grounds and evidence has been in conformity with the requirements for the rejection of the application;

(iii) where an application is to be rejected due to the remaining defects which are not eliminated after several rectifications, the examiner shall point out that the defects still exist in the final rectified documents after the examiner has issued twice or more the *Notification to Make Rectification* regarding the said defects; and

(iv) where the rejection is made on the basis of Article 2.3, 5, 9, 20.1, 22.2 or 22.4, 25, 26.3 or 26.4, 31.1, 33, or Rule 20, 43.1, the obvious substantive defects of the application documents shall be analyzed.

The examiner shall also give a brief comment on the argument made by the applicant in the part of the grounds for rejection.

(3) The corresponding provisions of the Patent Law and its Implementing Regulations which the patent application is contravening shall be clearly indicated in the part of conclusion with a statement that the patent application is rejected in accordance with Rule 44.2.

### 3.6 Interlocutory Examination and Handling after Reexamination

Where a patent application is rejected for not in conformity with the provisions of the Patent Law and its Implementing Regulations, the applicant may, within the prescribed time limit, file a reexamination re-

quest with the Patent Reexamination Board if he is not satisfied with the decision of rejection. For the interlocutory examination for the re-examination request and the handling after reexamination, the provisions of Chapter 8, Section 8 of Part II of these Guidelines shall apply.

## 4. Examination of Other Documents and Relevant Formalities

### 4.1 Appointment of Patent Agency

The provisions in Chapter 1, Section 6.1 of this Part shall apply.

### 4.2 Claiming Right of Priority

The provisions in Chapter 1, Section 6.2 of this Part shall apply.

### 4.3 Non-Prejudicial Disclosures

The provisions in Chapter 1, Section 6.3 of this Part shall apply.

### 4.4 Declaration of Withdrawing Patent Applications

The provisions in Chapter 1, Section 6.6 of this Part shall apply.

### 4.5 Changes in Bibliographic Data

The provisions in Chapter 1, Section 6.7 of this Part shall apply.

## 5. Examination in Accordance with Articles 5 and 25

For the examination on whether a patent application for utility model obviously belongs to the application for which no patent right shall be granted under Articles 5 and 25, the provisions in Chapter 1, Section 3 and 4 of Part II of these Guidelines shall apply.

## 6. Examination in Accordance with Article 2.3

In accordance with Article 2.3, "Utility Model" in the Patent Law means any new technical solution relating to the shape, the structure, or their combination, of a product, which is fit for practical use. This is the general definition of utility model which is eligible for patent protection, and is not the specific examination criteria to determine the novelty, inventiveness and practical applicability.

### 6.1 Only Product Can Get Patent Protection for Utility Model

According to Article 2.3, patent for utility model can be granted only for products. The products herein shall be objects manufactured

by industrial methods, having definite shape and structure, and occupying a certain space.

All the processes and the objects which exist naturally and are not made by man are not the subject matter protected by the patent for utility model.

The processes referred to above include the manufacturing processes, methods of use, methods of communication, processing methods, computer programs or the method of applying a product to a specific purpose, etc.

For example, a process of manufacturing a kind of gear, a method of dust-eliminating in the workshop, a data processing method and naturally existing Yuhua stones, etc. , shall not be the subject matters eligible for patent protection for utility model.

An invention-creation may include not only the improvement of the shape and structure of a product, but also the improvement of the specific method, process, and the material of which the product is made. However, the patent for utility model only protects the improved technical solutions relating to the shape or structure of a product.

It shall be noted that:

(1) the claims may include the name of known method to define the shape or structure of a product, and shall exclude the steps or processing conditions of the method. For example, if the name of known method, such as soldering or riveting, is used to define the connection of different parts, the claim does not include the improvement relating to the method *per se*.

(2) if a claim contains not only the features of shape and structure, but also improvement relating to the method per se, such as technical features defining the method for making or using product, or technical features defining computer program, it does not belong to the subject matter eligible for patent protection for utility model. For example, a kind of wood toothpick, whose main part is cylindrical and whose end parts are conical, is characterized by processing the said wood toothpick into a predetermined shape, immersing the said wood toothpick in medical bactericide for 5-20 minutes, then taking it out and airing it. Since the claim contains the improvement relating to the method per se, it does not belong to the subject matter eligible for patent protection for utility model.

### 6.2 Shape and/or Structure of Product

In accordance with Article 2.3, the subject matter of utility model shall include the improvement relating to the shape and/or structure of product.

#### 6.2.1 Shape of Product

The shape of a product refers to certain space-shape possessed by the product, which can be observed from the outside.

The improvement relating to the shape of a product may be the improvement relating to either the three-dimensional shape of the product, such as the improvement of the shape of a cam or a cutter, or the two-dimensional shape of the product, such as the improvement of the cross-sectional shape of a profiled bar.

As for the product which has a non-fixed-shape, such as the substance or material in gaseous state, liquid state, powder state or particle state, its shape cannot be regarded as the shape feature of a utility model product.

It shall be noted that:

(1) the biological shape or naturally-formed shape cannot be regarded as the shape feature of a product. For example, neither the shape of a miniature tree growing in a potted landscape nor the shape of naturally-formed rockery can be regarded as the shape feature of a product;

(2) a non-fixed shape formed by means of arrangement or stacking cannot be regarded as the shape feature of a product;

(3) a product may have a certain technical feature of non-fixed shape substance, such as the substance in gaseous state, liquid state, powder state or particle state, provided that it is defined by the structure feature of the product. For example, it is permitted to have ethyl alcohol of non-fixed shape included in the technical solution relating to the shape or structure of a thermometer; and

(4) the shape of a product may be a definite space-shape which exists under specific circumstances, such as an ice-made cup with a certain novel shape, or a parachute, etc. Again, for example, a kind of steel band packing case for transporting and storing the steel band, which consists of internal steel ring, external steel ring, binding band, external protection plate, and waterproof composite paper. However, when it is used to pack the steel band correlatively in accordance with the technical solution, a fixed space-shape will be formed, which is not

arbitrary. Such a packing case is the subject matter eligible for patent protection for utility model.

### 6.2.2 Structure of Product

The structure of a product refers to the arrangement, organization and correlation of each part of a product.

The structure of a product may be either the mechanical structure or the circuit structure. The mechanical structure refers to the relative position relationship, coupling relationship, and necessary mechanical matching relationship and so on of the components or parts of which the product consists. The circuit structure refers to the fixed connection relationship amongst the components or elements devices of which the product consists.

The composite layer may be regarded as the structure of the product. Carburized layer, oxide layer and so on of a product belong to the structure of the composite layer.

The molecular structure, component and metallographic structure of a substance do not belong to the structure of the product protected by a patent for utility model. For example, a welding rod which has only a change in the composition of soldering paste is not the subject matter eligible for patent protection for utility model.

It shall be noted that:

(1) the claims may include the names of known materials. The use of material known in the prior art in the product which has its own shape and structure, for example, composite floor boards, plastic cup, heart catheter holder made of alloy with memory, is not improvement relating to the material *per se*.

(2) If the claim contains not only the features of shape and structure, but improvement relating to the material per se as well, it is not the subject matter eligible for patent protection for utility model. For example, a rhombic tablet, which is characterized in that the tablet comprises 20% of component A, 40% of component B, and 40% of component C. Since the claim contains the improvement relating to the material per se, it is not the subject matter eligible for patent protection for utility model.

## 6.3 Technical Solution

The technical solution provided in Article 2.3 refers to the collection of technical means that are adopted to solve a technical problem in

observance of the laws of nature. The technical means is usually embodied by technical features.

Solutions that do not use technical means to resolve technical problems and to achieve technical effect in conformity with the laws of nature are not the subject matter eligible for patent protection for utility model.

If the new solution consisting of the shape of a product or of the pattern, color, or the combination thereof in the appearance of a product does not solve any technical problem, it is not the subject matter eligible for patent protection for utility model. The new solution consisting of character, symbol, chart or the combination thereof in the appearance of a product is not the subject matter eligible for patent protection for utility model. For example, a keyboard of computer or mobile phone with changed characters and symbols in its appearance; can opener with the shapes of twelve animals representing the twelve Earthly Branches, used to symbolize the year in which a person is born; chess or cards and their like, of which the distinguishing features are just in their pattern design, like ancient poetry cards, and so on.

## 7. Examination of Application Documents

### 7.1 Request

The provisions in Chapter 1, Section 4.1 of this Part shall apply.

### 7.2 Description

In the preliminary examination, the description shall be examined whether or not it is obviously not in conformity with Article 26.3 and Rule 17.1-17.3. For examination relating to Article 26.3, the provisions in Chapter 2, Section 2.1 of Part II of these Guidelines shall apply.

The examination of the description includes the following:

Art. 26.3

(1) the description shall set forth the utility model in a manner sufficiently clear and complete so as to enable a person skilled in the art to carry it out, which means that such person can carry out the technical solution of the utility model, solve the technical problem and achieve the expected technical effects according to the contents of the description;

Rule 17.1 & .2

(2) the description shall state the title of the utility model, which shall be the same as that appearing in the request. The description shall

include the technical field, background art, contents of the utility model, description of figures and mode of carrying out the utility model, and the title of each part shall be indicated respectively;

Rule 17.1(3) (3) in the part of the contents of the utility model, it shall disclose the technical problem to be solved by the utility model, the technical solution adopted to solve the problem, and the advantageous effects of the utility model as compared with the prior art. The technical problem to be resolved, the technical solution adopted and the advantageous effects shall be mutually compatible, and not contradictory, or irrelevant;

(4) the contents of the utility model described in the description shall be consistent with the relevant technical solutions defined in the claims;

Rule 17.1(4) (5) the name of each drawing shall be indicated in the description, and a brief explanation of the contents of the drawings shall be presented. Where there is more than one drawing, each of them shall be explained;

Rule 17.1(5) (6) in the part of the mode of carrying out the utility model, at least one preferential embodiment of the utility model shall be stated, and it shall be described with reference to the drawings;

Rule 17.3 (7) in the description, the standard terms shall be used, the wording shall be clear, the technical terminology adopted shall be accurate to express the technical solution of the utility model. The description shall not contain such references to the claims as "as described in claim xx", nor shall it contain words or sentences for commercial advertising or for belittling other person or products thereof;

(8) the text of the description may contain chemical or mathematical formulae or charts, but no drawings, including flowchart, block diagram, diagram of curves and phase diagram, etc., which may be used as the drawings of the description only;

Rule 40 (9) where the text of the description contains explanation of drawings, but the corresponding drawings are absent, the applicant shall be notified to delete the explanation of drawing from the text of the description, or to supplement the corresponding drawings within the specified time limit. Where the applicant supplements drawings, the date on which the drawings are submitted or mailed to the Patent Office shall be the date of filing, and the examiner shall issue the *Notification of Re-determination of Filing date*. Where the applicant deletes the explanation of drawings, the original date of filing shall remain; and

Rule 121.2

(10) the description shall be consecutively numbered in Arabic numerals.

### 7.3 Drawings

The drawings are a component part of the description. The function of drawings is to supplement the explanation in the text of the description with figures to enable a person to intuitively and visually understand each technical feature and the whole technical solution of the utility model. Therefore, the drawings shall clearly reflect the contents of the utility model.

The drawings shall be examined in accordance with Rules 17.5 and 18. The examination of the drawings shall include the following:

(1) no engineering blueprints or photographs shall be used as drawings;

Rule 121.1

(2) the drawings shall be drawn by drawing instruments including computers and in black ink, and the line shall uniformly thick and distinct, free from color and alteration. Frame lines irrelevant to the figures are not allowed around the figures;

Rule 18.1

(3) the figures shall be numbered consecutively in Arabic numerical order as "Fig. 1" and "Fig. 2", and the number shall be placed right below each figure;

Rule 121.3

(4) figures shall be preferably arranged in an upright position on the paper, one clearly separated from another. When the transverse dimension of the parts obviously exceeds their vertical dimension and they must be horizontally placed, the top of the figure shall be arranged on the left of the paper. When there are two or more figures on one piece of paper, and one is horizontally arranged, the other figures on the same piece of paper shall also be horizontally arranged;

(5) the scale and distinctness of the drawings shall be as such that a reproduction with a linear reduction in size to two-thirds would still enable all details to be clearly distinguished to meet the requirement of copying and scanning;

Rule 18.2

(6) where there are several drawings in one patent application, the reference signs used for the same constituent part (same technical feature or same object) in different figures describing the same mode of carrying out the utility model shall be identical. The reference signs used in the text of the description and in the drawings shall indicate the same constituent part. The reference signs not mentioned in the text of the description shall not appear in the drawings, and the reference signs

not used in the drawings shall not be mentioned in the text of the description;

(7) the drawings shall not contain any other notes, except indispensable words which shall be in Chinese; when necessary, the original words may be indicated in brackets thereafter;

(8) the structure diagram, logic diagram and flowchart shall have necessary words and symbols contained in its frame;

(9) the identical scale shall be adopted in the same figure, an additional figure of partial enlargement may be added in order to make certain part of the figure shown distinctively;

Rule 17.5

(10) the drawings shall contain figures demonstrating the shape, structure or their combination of the product to be protected. They shall not contain only the figures of prior art or figures demonstrating the effect or function of the product, such as graphs of temperature changing; and

Rule 121.2

(11) all the pages of drawings of the description shall be consecutively numbered in Arabic numerals.

**7.4 Claims**

In the preliminary examination, the claims shall be examined whether they are obviously not in conformity with Article 26.4 and Rules 19-22. For the examination according to Article 26.4, the provisions in Chapter 2, Section 3.2 of Part II of these Guidelines shall apply.

The examination of the claims shall include the following:

Art. 26.4

(1) the claims shall be supported by the description and shall define the extent of the patent protection asked for in a clear and concise manner;

Rule 19.1

(2) the claims shall describe the technical features of the utility model;

Rules 20.2 & 21.1

(3) an independent claim shall outline the technical solution of a utility model. Except where it is required to be expressed in another form, the independent claim shall contain a preamble portion and a characterizing portion. The preamble portion shall indicate the title of the subject matter of the technical solution of the utility model seeking protection, and those necessary technical features which the subject matter of the utility model share with the most related prior art. The characterizing portion shall state, in such words as "characterized in that" or in similar expressions, the technical features of the utility mod-

el which distinguish it from the most related prior art;

Rules 20.3 &22.1 (4) a dependent claim shall, by additional technical features, further define the claim which it refers to. It shall contain a reference portion and a characterizing portion. The reference portion shall indicate the serial number(s) of the claim(s) referred to, and the title of the subject matter, which is the same as that appearing in the independent claim. The characterizing portion shall state the additional technical features of the utility model;

Rule 21.3 (5) a utility model shall have only one independent claim, which shall precede all of the dependent claims relating to the same utility model;

Rule 26.4 (6) the contents which are stated in the claims but not in the description shall be added to the description;

Rule 19.1 (7) the claims shall not include any feature that does not produce any technical effect;

Art. 26.4 (8) the claims generally shall not include any technical features defined by graphics;

Art. 26.4 (9) the claims shall avoid using, as far as possible, any feature of function or effect to define the utility model. The characterizing portion shall not state the function of the utility model alone. Only if certain technical feature cannot be defined with the feature of structure, or the technical features are less properly defined with features of structure than with features of function or effect, and the said function and effect have been fully described in the description, it is possible to allow the utility model defined with features of function or effect;

Art. 26.4 (10) the claims shall not contain any sentences the technical meaning of which is ambiguous or uncertain; and

Rule 19.1 (11) the claims shall not use any words or sentences irrelevant to the content of technical solution, such as "claiming the right of manufacture or sale of the patent", nor shall use any words or sentences for commercial advertising or belittling other person or product thereof.

Moreover, the claims shall be in conformity with the following formality requirements:

(1) the full stop shall be used only at the end of each claim. Each claim shall be expressed either in one natural paragraph, or in several lines or sub-paragraphs in one natural paragraph, and only a comma or a semicolon may be used at the end of the line or sub-paragraph. Where necessary, the sequence number may be placed before the line or subparagraph;

(2) no title shall be used in claims;

Rule 19.2 (3) where there are several claims, they shall be numbered consecutively in Arabic numerals;

Rule 19.3 (4) the claims may contain chemical or mathematical formulae but no drawings, and no forms in general. They shall not, except where it is absolutely necessary, contain such references to the description or drawings "as described in part… of the description", or "as illustrated in Figure… of the drawings";

Rule 19.4 (5) in order to facilitate understanding of the technical solution described in the claims, the technical features mentioned in the claims may make reference to the corresponding reference signs in drawings of the description. Such reference signs shall be included after the corresponding technical features and placed in parenthesis. The reference signs shall be the same as those that appear in the drawings of the description;

Rule 22.2 (6) a dependent claim shall refer only to a previous claim or claims. A multiple dependent claim referring to two or more previous claims shall refer to such claims in the alternative only, and shall not serve as a basis for any other multiple dependent claim, i. e., the subsequent multiple dependent claims shall not refer to the preceding multiple dependent claims; and

Rule 121.2 (7) all the pages of claims shall be numbered consecutively in Arabic numerals.

### 7.5 Abstract

The examination of the abstract shall be conducted in accordance with Rule 23, including the following:

Rule 23.1 (1) the abstract shall indicate the title and technical field of the utility model, clearly present the technical problems to be solved, the gist and principal use of the technical solution to the problem, especially the technical features which represent the improvement of the shape or structure of the utility model as compared with the prior art. The abstract shall not be written as a commercial advertisement or an introduction of the product of a purely functional nature;

Rule 23.2 (2) the abstract shall not use the title of the utility model as its title;

(3) the abstract may contain chemical or mathematical formulae;

(4) the whole text of the abstract shall contain no more than 300 Chinese characters (including punctuation marks); and

(5) the abstract shall contain a figure accompanying the abstract, which is submitted by the applicant and selected from the drawings of the description and can show the technical solution.

Rule 121

### 7.6 Format Examination of Application Documents for Publication

The provisions in Chapter 1, Section 4.6 of this Part shall apply.

## 8. Examination in Accordance with Article 33

The applicant may make amendment to his patent application for utility model in accordance with Article 33. However, the amendment to the patent application documents for utility model shall not go beyond the scope described in the initial description and claims.

If the applicant, when amending the application documents, introduces any contents which cannot be directly and unambiguously derived by a person skilled in the art from the initial description and claims, such amendment shall be regarded as having gone beyond the scope described in the initial description and claims.

If the applicant deletes one or more features from an application, it may also lead to go beyond the scope described in the initial description and claims.

If any technical feature which is included in the initial claims but not described in the initial description is introduced into the description and its contents are extended, such amendment shall be regarded as going beyond the scope described in the initial description and claims.

If any technical feature, which is not described in the initial description and claims and cannot be unambiguously determined by virtue of the contents of the initial description drawings, is introduced into the description, such amendment shall be regarded as going beyond the scope described in the initial description and claims.

It shall be noted that:

(1) the correction of obvious mistakes shall not be regarded as going beyond the scope described in the initial description and claims. "Obvious mistakes" means the incorrect contents which can be clearly judged from the context of the initial description and claims and without any possibility of other explanations or amendments; and

(2) any structure feature, which can be obviously seen from the drawings and has only one possible explanation, may be introduced into the description and included in the claims.

In accordance with Rule 51, the applicant may amend the patent

application documents for utility model on his own initiative within two months from the date of filing. Besides, the applicant shall amend the application documents on the defects pointed out in the *Notification upon receipt of the Office Action* or the *Notification to Make Rectification* from the Patent Office.

Rule 51.2

**8.1 Amendment Made by Applicant on His Own Initiative**

With regard to the amendment made by the applicant on his own initiative, the examiner shall first examine whether or not the date of amendment is within two months from the filing date. With regard to the amendment made two months later, if the amended documents remove the defects existing in the initial application documents, and have the prospect of being granted the patent right, the amended documents may be accepted. With regard to the amended documents which cannot be accepted, the examiner shall issue the *Notification that Amendments Deemed Not to Have Been Submitted.*

With regard to the amendment made by the applicant on his own initiative within the two months, the examiner shall examine whether or not the amendment goes beyond the scope described in the initial description and claims. If the amendment goes beyond the scope described in the initial description and claims, the examiner shall issue the Office Action to notify the applicant that the amendment is not in conformity with the provisions of Article 33. If the amendment is still not in conformity with the provisions after the applicant makes observations or rectification, the examiner may make a decision of rejection according to the provisions of Article 33 and Rule 44.

Rule 51.3

**8.2 Amendment as Required by the Notification**

With regard to the amendment in response to the notification, the examiner shall examine whether or not the amendment goes beyond the scope described in the initial description and claims, and is made as required by the notification. Where the rectified documents submitted by the applicant contain amendments which are not made as required by the notification, if the amendments are in conformity with the provisions of Article 33, the amendments may be deemed to be the amendments made as required by the notification and the application documents amended in this way may be accepted, provided that the defects existing in the initial application documents are eliminated in the amended documents and there is prospect for the application to be granted

the panted right. Where the amended documents are not in conformity with the provisions of Rule 51. 3, the examiner may issue a notification, state the reason for not accepting the amendment, and invite the applicant to submit an amendment complying with the provisions of Rule 51. 3 within the specified time limit. In the meanwhile, it shall be indicated that if the text of amendment submitted by the applicant is still not in conformity with the provisions of Rule 51. 3, the examiner will continue examination based on the former application documents without the amendments, which may, for example, lead to a decision of granting patent right or decision of rejection.

If the amendment goes beyond the scope described in the initial description and claims, the examiner shall issue the Office Action to notify the applicant that the amendment is not in conformity with the provisions of Article 33. If the amendment is still not in conformity with the provisions after the applicant makes observations or rectification, the examiner may make a decision of rejection according to the provisions of Article 33 and Rule 44.

Rule 51. 4

### 8. 3 Amendment Made by Examiner *Ex Officio*

The examiner may make amendments to the obvious clerical mistakes and symbol mistakes in the documents of patent application *Ex Officio* before he issues a *Notification to Grant Patent Right for Utility Model*. The contents of such amendment include the following:

(1) request: amend the omission, error or repetition of names of the province (autonomous region, the municipality directly under the Central Government), names of the city, postal code and other information in the address of the applicant or contact person;

(2) description: amend the obviously improper title and/or the technical field of the utility model; correct wrong or misused words, symbols and signs, etc.; revise obviously nonstandard terms; add titles missing in each part of the description; and delete unnecessary explanatory notes in the drawings;

(3) claims: correct wrong or misused words, wrong punctuation marks, wrong reference signs, and add parenthesis to reference signs. But any amendment likely to cause the change of the protection scope falls outside the scope of amendment made *ex officio*; and

(4) abstract: amend the improper contents and obvious errors in the abstract, and specify the abstract drawing.

The amendment made by the examiner ex officio shall be recorded

in the documents and be notified to the applicant.

**9. Examination in Accordance with Article 31.1**

The examination of a patent application for utility model on the obvious lack of unity shall be conducted in accordance with the provisions of Article 31.1 and Rule 34. In the preliminary examination of the utility model, the special technical features are generally determined on the basis of the background art described in the documents of the application.

With regard to the examination of unity, the provisions in Chapter 6, Section 2 of Part II of these Guidelines shall apply.

**10. Examination in Accordance with Rule 43**

The examination on the divisional application for utility model shall be conducted in accordance with the provisions of Rules 42 and 43. With regard to the examination of divisional application, the provisions in Chapter 1, Section 5.1 of this Part shall apply, and the provisions in Chapter 6, Section 3 of Part II of these Guidelines shall also apply.

**11. Examination in Accordance with Article 22.2**

In the preliminary examination, the examiner generally does not determine on search whether a utility model is obviously lack of novelty, but may determine on the information of related prior art or conflicting applications obtained not through search.

However, where an abnormal applications for utility model is involved, such as an application obviously plagiarizing prior art or repeated submission of an application with substantially identical content, the examiner shall judge whether the utility model is obviously lack of novelty depending on the reference document obtained through search or information obtained by other approaches.

With regard to the examination on novelty, the provisions of Chapter 3 of Part II of these Guidelines shall apply.

**12. Examination in Accordance with Article 22.4**

Practical applicability means that the product of a patent application for utility model must be one which can be made or used in an industry and can produce positive effect.

With regard to the examination on practical applicability, the pro-

visions of Chapter 5 of part Ⅱ of these Guidelines shall apply.

## 13. Examination in Accordance with Article 9

In accordance with Article 9.1, for any identical invention-creation, only one patent right shall be granted. In accordance with Article 9.2, where two or more applicants file applications for patent for the identical invention-creation, the patent right shall be granted to the applicant whose application was filed first.

In the preliminary examination, whether or not a patent application for utility model may obtain a patent right according to Article 9 shall not be examined through search in general. However, if the examiner knows that there is an applicant who has filed a patent application for the identical invention-creation, he shall conduct the examination.

With regard to the handling of identical inventions-creations, the provisions in Chapter 3, Section 6 of Part Ⅱ of these Guidelines shall apply.

## 14. Examination in Accordance with Article 20.1

In accordance with Article 20.1, where the applicant files abroad a patent application for utility model developed in China, he shall file it in advance with the Patent Office for confidentiality examination.

In accordance with Rule 8.1, the utility model developed in China refers to a utility model the substantive contents of the technical solution of which was made within the territory of China.

In preliminary examination, where the examiner finds, with justified reasons, that the applicant filed abroad a patent application in violation of above provisions, the examiner shall issue an Office Action regarding the application for utility model with identical contents filed in China. If the observations made by the applicant fail to prove that the application does not fall under the circumstances mentioned above, the examiner may reject the application on the basis of Article 20.1, Article 20.4, and Rule 44.

## 15. Examination of International Application Entering the National Phase

This section provides explanations and stipulations only for special issues of the international applications for patent protection of utility model entering the national phase (hereinafter referred to as international application). For the issues which are the same as those in na-

tional applications, other provisions of this chapter shall apply.

## 15.1 Determination of the Texts Forming Basis for Examination

### 15.1.1 Request of Applicant

At the time of entering the national phase, the applicant of an international application shall indicate, in the written entering statement (hereinafter referred to as entering statement), the text which he wishes the Patent Office use for examination.

The examination of the international application in the national phase shall be performed, upon the request of the applicant, on the basis of the text indicated in the written entering statement and other texts submitted in a later stage which meet the relevant requirements.

### 15.1.2 Text Forming Basis for Examination

The text used as the basis for examination may include:

(1) where the international publication of an international application is in Chinese, the international application as originally filed; where the international publication of an international application is in a foreign language, the Chinese translation of the international application as originally filed;

(2) where the international publication of an international application is in Chinese, the claims as amended and submitted under Article 19 of the Treaty; where the international publication of an international application is in a foreign language, the Chinese translation of the claims as amended and submitted under Article 19 of the Treaty;

(3) where the international publication of an international application is in Chinese, the claims, description and drawings as amended and submitted under Article 34 of the Treaty; where the international publication of an international application is in a foreign language, the Chinese translation of the claims, description and drawings as amended and submitted under Article 34 of the Treaty;

(4) the amended text of the application as submitted under Rules 44 and/or 104; and

(5) the amended text of the application as submitted under Rule 112.1.

The submission of the claims, description and drawings amended under Articles 28 and 41 of the Treaty shall meet the time limit prescribed in the provisions of Rule 112.1.

The texts used as the basis for examination shall be the one indicated in the statement concerning the basis for examination. The statement shall contain indications in the prescribed items of entering statement at the time of entering the national phase, and the complementary indications made by the way of complementary statement within the prescribed time limit after entering national phase. The latter is a complement and a correction to the former.

If the applicant indicates in entering statement that there are elements or parts incorporated by reference in the application documents and the filing date for china has been redetermined in the preliminary examination stage, the elements or parts incorporated by reference shall be considered as part of the application documents originally submitted. The applicant shall not be permitted to retain the elements or parts incorporated by reference by the means of requesting to amend the international application date for china in the process of examination.

Where, the amendments made in the international phase fail to be indicated as the basis for the examination at the time of entering the national phase, or where the Chinese translation of the amendments is not submitted according to the provisions, it shall not be used as the basis for examination.

#### 15.1.3 Legal Effect of International Application Documents as Originally Filed

Where the international publication of an international application is in a language other than Chinese, the examination shall be conducted according to its Chinese translation. The examiner, generally speaking, need not check the original. Nevertheless, the international application documents as originally filed shall have legal effect and form the legal basis for any amendment to the application documents.

For an international application, the original description and claims indicated in Article 33 refer to the description, claims, and drawings of the international application as originally filed.

### 15.2 Requirements of Examination

#### 15.2.1 Examination of Application Documents

Provisions of the Paten Law, its Implementing Regulations and the Guidelines shall be applied to the form or content of the application documents, except for the following:

(1) Where there are no redundant words in the name of utility model, the examiner shall not request the applicant to amend or amend them *ex officio* on the grounds of not complying with the requirements on the number of words in the name as provided for in Chapter 1, Section 4.1.1 of Part I of these Guidelines.

(2) Where there are no unnecessary words or sentences in the abstract, the examiner shall not request the applicant to amend or amend them *ex officio* on the grounds of not complying with the requirements on the number of words in the abstract as provided for in Rule 23.2.

(3) The examiner shall not request the applicant to amend or amend *ex officio* the description on the grounds of not complying with the requirements on the manner, order and subtitle as provided for in Rules 17.1 and 17.2.

**15.2.2 Examination of Unity**

In the examination, if the examiner finds, in the application documents used as the basis for the examination, there are multiple claimed utility models between which unity does not exist, the following aspects shall be checked:

(1) whether the multiple utility models lacking unity contain any invention-creation which has not been conducted international search or international preliminary examination in the international phase;

(2) whether the multiple utility models lacking unity contain any invention-creation which has been abandoned by the applicant in the international phase (such as an invention abandoned by an applicant in the international phase by restricting certain claims); and

(3) for situations indicated in point (1) or (2), whether the decision of lacking unity made by the international Authority is correct.

Where it is confirmed that the decision made by the International Authority is correct, the examiner shall issue the *Notification to Pay Restoration Fee for Unity* to notify the applicant to pay the restoration fee for unity within two months. If the applicant fails to pay or pay in full the restoration fee for unity within the prescribed time limit, and fails to delete the utility model(s) lacking unity, the examiner shall issue an Office Action to notify the applicant that the utility model(s) for which an international search has not been conducted shall be deemed to have been withdrawn, and invite the applicant to submit an amended text after deleting such utility model(s). The examiner shall continue the examination based on the text without such utility model(s).

As for the utility model (s) deleted due to failure to pay the restoration fee for unity by the applicant, according to the provisions of Rules 115. 2 and 42. 1, the applicant shall not request for divisional application (s). Except for the above circumstance, where the international application contains more than two utility models, the applicant may file a divisional application in accordance with Rule 115. 1.

For circumstances where the International Authority has not raised an objection of unity during the search and examination in the international phase, but actually there is a defect of lacking unity in the application, the provision in Section 9 of this chapter of these Guidelines shall apply.

### 15. 2. 3 Earlier Application Being Filed in China

If the international application entering national phase requests priority of the previous application which is filed in China or that of a previous international application having entered Chinese national phase, double-patenting may arise. To avoid double-patenting thereof, the provision of Section 13 of this chapter shall apply.

It shall be noted that: if the claim of priority is deemed not to have been made, the previous application may become the prior art or conflicting application which may destroy the novelty of this international application.

### 15. 2. 4 Correction of Translation Mistakes

In accordance with the provision of Rule 113, before the Patent Office completes the technical preparation for announcement of a patent right for Utility Model, if the applicant finds there are mistakes in the Chinese translation of the submitted description, claims or texts in drawings, he may request to correct the mistakes. Where the applicant intends to correct the mistakes in the translation, he or it shall file a written request and pay the prescribed fee for the correction of the translation.

# Chapter 3 Preliminary Examination of Patent Applications for Design

## 1. Introduction

Under Articles 3 and 40, the Patent Office receives and examines the patent application for design. Where it is found after preliminary examination that there is no grounds for rejection of that application, the Patent Office shall make a decision to grant the patent right for design, issue the certificate of patent for design, register and announce it. Therefore, the preliminary examination of an application for design is a necessary procedure after receipt of an application for design and before granting the applicant a patent right for design.

Rule 44.1

The scope of the preliminary examination for an application for design is as follows:

(1) formal examination of the application documents, including whether or not the application contains the application documents as provided for in Article 27.1, and whether or not those documents comply with the provisions of Rules 2, 3.1, 16, 27, 28, 29, 35.3, 51, 52, 119, and 121;

(2) examination on obvious substantive defects of the application documents, including whether or not the application obviously falls under Article 5.1 or 25.1 (6), or is not in conformity with the provisions of Article 18 or 19.1, or is obviously not in conformity with the provisions of Articles 2.4, 23.1, 27.2, 31.2 or 33, and of Rule 43.1, or is not entitled to a patent right in accordance with the provisions of Article 9;

(3) formal examination of other documents, including whether or not other documents and formalities relating to the application are in conformity with the provisions of Articles 24, 29.1, 30, and Rules 6, 15.3, 15.4, 30, 31, 32.1, 33, 36, 42, 43.2, 43.3, 45, 86, 100; and

(4) examination of the relevant fees, including whether or not the relevant fees have been paid in accordance with Rules 93, 95, and 99.

## 2. Principles of Examination

In the procedure of preliminary examination, the examiner shall abide by the following principles of examination.

(1) Principle of confidentiality

In the patent application examination and approval proceedings, the examiner shall be obliged to keep secret the patent application documents and other patent application related contents that are not announced, and other information that is not proper to be made known in accordance with the relevant provisions on secrecy.

(2) Principle of written examination

The examiner shall examine on the basis of the written documents submitted by the applicant. The Office Action (including *Notification to Make Rectification*) and the result of examination shall be sent in written form to notify the applicant. In the preliminary examination procedure, no interview shall be held in principle.

(3) Principle of hearing

Before making a decision of rejection, the examiner shall notify the applicant of the facts, grounds and evidence for rejection, and give the applicant at least one opportunity to make observations and/or amend the application documents. When the examiner makes a decision of rejection, the facts, grounds and evidence for rejection shall have been notified to the applicant, and the decision shall not contain any new facts, grounds and/or evidence.

(4) Principle of procedural economy

Where in conformity with the provisions, the examiner shall improve the efficiency of examination as much as possible, and shorten the examination period. With regard to the application with defects that can be eliminated through rectifications, the examiner shall conduct a comprehensive examination and do his best to point out all the defects in one *Notification to Make Rectification*. With regard to the application with substantive defects that cannot be eliminated through rectifications, the examiner may only point out the substantive defects in the Office Action without examining the formality defects in the application documents and other documents. With regard to the application with defects that can be eliminated through amending *ex officio*, the examiner may not issue *Notification to Make Rectification*.

In addition to complying with the above principles, the examiner shall notify the applicant of subsequent procedures that can be initiated while making the decision that the application is deemed not to have been filed, the decision that the application is deemed withdrawn, or the decision of rejection.

## 3. Procedure of Examination

Art. 40

### 3.1 Notification to Grant Patent Right

Where it is found after preliminary examination that there is no grounds for rejection of the application for design, the examiner shall make *Notification to Grant Patent Right for Design*. The application for design for which the patent may be granted includes the application which complies with the requirements of the preliminary examination without the necessity of rectification and the application which complies with the requirements of the preliminary examination through rectification.

### 3.2 Rectification of Application Documents

During the preliminary examination, for a patent application whose application documents have defects that can be eliminated through rectifications, the examiner shall conduct a comprehensive examination and issue *Notification to Make Rectification*. Where the defects still exists in the application documents after the applicant makes rectification, the examiner shall issue another *Notification to Make Rectification*.

Besides the information of the person who receives correspondence and the bibliographic data of the application, *Notification to Make Rectification* shall include the followings :

(1) indicate the type and the submission time of the file which the *Notification to Make Rectification* is aimed at;

(2) point out the defects existing in the application definitely and concretely, and state the grounds in the Patent Law and its Implementing Regulation;

(3) explain the oriented opinion of the examiner and the possible suggestions, in order to help the applicant understand the examiner's intention; and

(4) specify the time limit for response.

### 3.3 Handling of Obvious Substantive Defects

During the preliminary examination, for a patent application whose application documents have obvious substantive defects that cannot be eliminated through rectifications, the examiner shall issue the Office Action.

Besides the information of the person who receives correspondence and the bibliographic data of the application, the Office Action shall include the followings :

(1) indicate the type and the submission time of the file of which the Office Action is aimed at;

(2) point out the defects exist in the application definitely and concretely, state the grounds in the Patent Law and its Implementing Regulations, and analyze the fact that the application documents have obvious substantive defects together with related evidence if necessary;

(3) indicate the examiner' s oriented opinion and grounds in the Patent Law and its Implementing Regulation on which the examiner is intended to reject the patent application; and

(4) specify the time limit for response.

### 3.4 Response to Notification

The applicant shall, after receiving the *Notification to Make Rectification* or the Office Action, make rectification or observations within the specified time limit. The applicant shall, when making rectification of the application, submit the rectification and the corresponding replacement sheets of the amended documents. The replacement sheets of the amended application documents shall be in duplicate, while only one copy is required for other documents. The amendment to the application documents shall be made concerning the defects indicated in the notification or Office Action, and shall not go beyond the scope of the disclosure contained in the drawings or photographs filed on the date of filing.

Where the applicant makes no response within the time limit, the examiner shall, depending on the circumstances, issue *Notification that Application Deemed to be Withdrawn* or other notifications. Where it is difficult for the applicant to make response within the specified time limit due to justified reasons, he may request to extend the time limit. The provisions of Chapter 7, Section 4 of Part V of these Guidelines shall apply when handling the request for extension of the time limit.

Where an application is deemed to have been withdrawn resulting from failure to meet the time limit due to force majeure or other justified reasons, the applicant may, within the prescribed time limit, submit a request to the Patent Office for restoration of the right. The provisions of Chapter 7, Section 6 of Part V of these Guidelines shall apply when handling the request for restoration of the right.

### 3.5 Rejection of Applications

Rule 44.2

Where obvious substantive defects exist in the application documents and remain unrectified after the applicant makes observations or amendment upon the examiner's issuance of the Office Action, or where formality defects exist in the application documents and remain unrectified after the applicant makes observations or rectification upon the examiner's issuance of *Notification to Make Rectification* twice in respect of said defects, the examiner may make a decision of rejection.

The text of the decision of rejection shall include three parts: brief of the case, grounds for rejection, and conclusion.

The examination procedure of the rejected application shall be briefly described in the part of brief of the case, namely all of the observations and the summaries of the responses from the applicant, the defects in the application which result in the rejection of the application and the text of the application upon which the rejection is based.

The part of grounds for rejection shall include the facts, grounds and evidence for rejection and the examiner shall follow the below requirements:

(1) choose the provisions correctly. Where the application may be rejected according to different provisions in the Patent Law and its Implementing Regulations, the examiner shall choose the most suitable, leading provision as the main foundation for rejection, and simultaneously indicate the other defects in the application briefly; and

(2) reject the application with compellent facts, grounds and evidence, and shall have notified the applicant of those facts, grounds and evidence, and have already gave the applicant at least one opportunity to make observations and/or amend the application documents.

The examiner shall remark briefly on the argument of the applicant in the part of grounds for rejection.

The corresponding provisions of the Patent Law and its Implementing Regulations which the patent application is contravening shall be clearly indicated in the part of conclusion with a statement that the patent application is rejected in accordance with Rule 44.2.

### 3.6 Interlocutory Examination and Handling after Reexamination

Where an application is rejected for not in conformity with the provisions of the Patent Law and its Implementing Regulations, the applicant may, within the prescribed time limit, file a reexamination re-

quest with the Patent Reexamination Board if he is not satisfied with the decision of rejection. For the interlocutory examination for the reexamination request and the handling after reexamination, the provisions of Chapter 8, Section 8 of Part Ⅱ of these Guidelines shall apply.

## 4. Examination of Application Documents

Article 27 provides that, where an application for a patent for design is filed, a request, drawings or photographs of the design as well as a brief explanation of the design, etc. shall be submitted; the relevant drawings or photographs submitted by applicant shall clearly indicate the design of the product for which patent protection is sought.

### 4.1 Request

#### 4.1.1 Name of Product Incorporating Design

Rule 16

The name of the product incorporating the design may explain the category of the product as shown in the drawings or photographs. The name of the product incorporating the design shall be in accordance with the design as shown in the drawings or photographs and indicate the design for which protection is sought accurately and concisely. The name of the product shall generally be in conformity with the name listed in the subclass of the International Classification for Industrial Design. It shall generally contain no more than 20 Chinese characters.

The use of the following names shall generally be avoided:

(1) names of product containing the name of a person, a place, a nation, an entity, a trademark, a code, a model or a historical age;

(2) improper generic or abstract names, such as "stationery", "cooking utensils", "musical instruments", "articles for building", etc.;

(3) names describing the internal structure, technical effect of the product, such as "oil-saving engine", "human body height-increasing shoe-pad", "automobile with new type of engine", etc.;

(4) names with specification, size, scale or numerical unit of the product, such as "21-inch TV set", "medium-sized bookshelf", "one pair of gloves", etc.; and

(5) names in foreign language or without specific meaning in Chinese language, such as"kelaisi wine bottle", but words well known and having specific meaning can be used, such as"DVD player", "LED

light", "USB line concentrator", etc.

#### 4.1.2 Creator

The provisions concerning the inventor of Chapter 1, Section 4.1.2 of this Part shall apply.

#### 4.1.3 Applicant

The provisions of Chapter 1, Section 4.1.3 of this Part shall apply.

#### 4.1.4 Contact Person

The provisions of Chapter 1, Section 4.1.4 of this Part shall apply.

#### 4.1.5 Representative

The provisions of Chapter 1, Section 4.1.5 of this Part shall apply.

#### 4.1.6 Patent Agency and Patent Agent

The provisions of Chapter 1, Section 4.1.6 of this Part shall apply.

#### 4.1.7 Address

The provisions of Chapter 1, Section 4.1.7 of this Part shall apply.

### 4.2 Drawings or Photographs

Article 59.2 provides that, the extent of protection of the patent right for design shall be determined by the design of the product as shown in the drawings or photographs. The brief explanation may be used to interpret the design of the product as shown in the drawings or photographs. Article 27.2 provides that, the relevant drawings or photographs submitted by applicant shall clearly indicate the design of the product for which patent protection is sought.

So far as the product with a three-dimensional design is concerned, if the essential features of the design of the product involve six sides, the applicant shall submit orthographic projection of six-side views; if the essential features of the design of the product involve the view of one side or several sides only, the applicant shall submit at

least orthographic projection view and space diagram of the side concerned, and indicate the reason of the omission of the view in the brief explanation.

So far as the product with plane design is concerned, if the essential features of the design of the product involve the view of one side only, the applicant may submit the orthographic projection view of the relevant side only; if the essential features of the design of the product involve the view of two sides, the applicant shall submit the orthographic projection views of the two relevant sides.

The applicant shall also submit, if necessary, the exploded view, cutaway view, sectional view, enlarged view and view of state of variation.

In addition, the applicant may submit the reference views. Reference views are usually used to indicate the purpose of use, method or places of use of the product incorporating the design.

The colour includes black-white-grey series and multicolour series. Where an application for design has a declaration "seeking concurrent protection of colour" in the brief explanation, the colour of the drawings shall be fast and not easy to fade.

#### 4.2.1 Titles of Views and Marking Thereof

The titles of the six-side views are front view, back view, left view, right view, top view and bottom view. The side corresponding to the front view shall be the side which faces consumers when in use or which can best show the overall design of the product. For example, the front view of a cup with a handle shall be the one where the handle is on the edge of the side.

The title of each view shall be indicated exactly under the relevant view.

In respect of the product in set, Arabic numerals shall be marked before the titles of the views of each product with the word "item" placed before the numerals. For example, the title of the front view of the No. 4 item in the product set is "Item 4, Front View".

In respect of two or more similar designs for the same product in one application, Arabic numerals shall be marked before the titles of the views of each product with the word "design" placed before the numerals. For example, the title of the front view of the No. 1 design in the application is "Design 1, Front View".

Combination product refers to a single product consisting of a

number of components. It could be divided into assembled product with only one option of assembly, combination product needless of assembly or assembled product with more than one option of assembly. In respect of the assembled product with only one option of assembly, views showing the state of combination shall be submitted; in respect of the combination product needless of assembly or assembled product with more than one option of assembly, views showing each component shall be submitted, and Arabic numerals shall be marked before the titles of the views of each component with the word "component" placed before the numerals. For example, the title of the left view of the No. 3 component of the combination product is "Component 3, Left View".

In respect of the product incorporating design with variations, the Arabic numbers shall be marked after the title of the view showing the state of variation in the patent application thereof.

#### 4.2.2 Making of Drawings

Rule 121.1

The drawings shall be made in accordance with the provisions on normal projection, width of lines, and section mark of the state standards of technical drawing and mechanical drawing. Solid lines of even thickness shall be used to show the shape of the design. Shadow lines, indicative lines, dotted lines, central lines, size lines, and dot-dash lines shall not be used to show the shape of a design. Two parallel double-dotted lines or natural geosutures can be used to show the omitted part of a long and thin product. The indicative lines may be used to show the section place and direction, enlarged parts, and transparent parts without unnecessary lines and marks. The drawings shall show the design clearly.

The drawing may be drawn with the aid of drawing instruments including computer. Pencil, crayon or ball-pen shall not be used. Blueprint, sketching, mimeograph shall also not be used. Where the drawing of the design is made with computer, its resolution shall meet the requirements of being distinct.

#### 4.2.3 Taking of Photographs

(1) The photographs shall be clear, and avoid vagueness resulting from focusing problems, etc.

(2) The background of the photographs shall be plain, and avoid showing other contents except the product incorporating the design.

The product and the background shall have appropriate distinction in brightness to show the design clearly.

(3) The photographs shall be taken in conformity with the rules of exact projection and avoid distortion caused by perspective.

(4) The photographs shall avoid strong light, blinking, shadow, reflection, etc.

(5) The product in the photographs should not be allowed to indicate generally accompanied with additional inside filling or liner, unless the additional inside filling or liner must be kept in order to show the design clearly.

Art. 27.2

### 4.2.4 Defects of Drawings or Photographs

Where the content of the drawings or photographs of a patent application has defects, the examiner shall issue *Notification to Make Rectification* or Office Action to the applicant. The amendments to the application for design made by the applicant shall not go beyond the scope of the disclosure as shown in the initial drawings or photographs according to the provisions of Article 33. The defects mentioned above mainly refer to the followings:

(1) where the relation of projection of the views is wrong, for example, the relation of projection is not in conformity with the rules of exact projection, corresponding projection relation among the views lacks, or the direction of the view is upside down;

(2) where the content of the design cannot be correctly expressed because the drawings or photographs are not clear enough, or the size of the figure of product as shown in the drawings or photographs is too small, or there is strong light, blinking, shadow, reflection, inside filling or liner which makes the design indicated incorrectly though the figure is clear;

(3) where, in the drawings of the design, there are lines to show the product which shall be deleted or amended, such as a shadow line, indicative line, dotted line, central line, dimension line, or dot-dash line, and so on;

(4) where the views of a three-dimensional product has any of the following circumstances:

(i) the scale of the various views is not the same; and

(ii) where the essential features of the design of the product involve six sides, there are no six-sided views, however, with the following exceptions:

the back view may be omitted if it is identical or symmetrical with the front view;

the left view (or the right view) may be omitted if it is identical or symmetrical with the right view (or the left view);

the top view (or the bottom view) may be omitted if it is identical or symmetrical with the bottom view (or the top view);

the bottom view may be omitted in the case of the large-scale apparatus, or apparatus with fixed position or the articles with bottoms not often be seen;

(5) where the view of a product with plane design has any of the following circumstances:

(i) the scale of various views is not the same; and

(ii) the essential features of the design of the product involve two sides, but there are no two-sided views, except that the back view is identical or symmetrical with the front view or there is no pattern in back view;

(6) where, in the case of a long and thin product, such as the measuring rule or section bar, the middle part of the product is omitted in the drawing, but the double parallel two-dot dash lines or natural geosutures are not used;

(7) where the section and the section surface of the sectional view or sectional surface view has any of the following circumstances:

(i) no section line or the section line is incomplete; and

(ii) the line, symbol and direction showing the place of section are incomplete or absent (however, it is not necessary to indicate the mark to show the cut-off from the central part).

(8) where there is an enlarged view of a certain part but the position of that enlarged part in the relevant drawing is not indicated;

(9) where an assembled product with only one option of assembly lacks the corresponding views showing the state of combination; a combination product needless of assembly or an assembled product with more than one option of assembly lacks necessary views of each component; and

(10) where the outer layer and inner layer of the design of transparent articles have two or more shapes, patterns and colours that are not expressed separately.

### 4.3 Brief Explanation

Article 59.2 provides that, the extent of protection of the patent

right for design shall be determined by the design of the product as shown in the drawings or photographs. The brief explanation may be used to interpret the design of the product as shown in the drawings or photographs.

According to Rule 28, a brief explanation shall include the following contents:

(1) the title of the product incorporating the design. The title of the product indicated in the brief explanation shall be in accordance with the title of the product in the request;

(2) the use of the product incorporating the design. The use of the product which is helpful to ascertain the classification shall be indicated in the brief explanation. As regards product has multiple uses, the multiple uses shall be indicated in the brief explanation;

(3) the essential features of the design. The essential features mean that the shape, pattern or their combination, or the combination of the colour with shape or pattern, or the position, which is different from prior design. The description of the essential features shall be compendious; and

(4) which drawing or photograph is designated to best show the essential features of the design. The designated drawing or photograph is used for the publication in the Patent Gazette.

Furthermore, the following contents shall be indicated in the brief explanation:

(1) protection for colour is claimed or a view is omitted.

Where protection for colour is sought in a design patent application, it shall be claimed in the brief explanation.

Where a view of the product incorporating the design is omitted, the applicant shall generally indicate the reason of the omission of the view, such as a view is omitted because it is symmetrical or identical with another view; if it is hard to indicate the reason, may only indicate the view which is omitted, for example, a large-scale apparatus lacks bottom view, it may be described as "bottom view is omitted".

(2) where an application for a patent for design is filed relating to several similar designs of the same product, one of the designs shall be designated as the main design in the brief explanation.

(3) as regards plane product such as printed cloth, wallpaper, shall describe the unit pattern of the plane product which is connected in two sides or four sides and has no fixed limits if necessary.

(4) as regards a long and thin product, shall indicate the length is

omitted in the drawings or photographs if necessary.

(5) where the product incorporating the design is made of transparent material or new material which creates special visual effect, it shall be indicated in the brief explanation if necessary.

(6) where the design product is a product in set, the names of the items in the product set shall be indicated if necessary.

The brief explanation shall contain no language of commercial advertisement, and shall not be used to show the function of the product.

## 5. Examination of Other Documents and Relevant Formalities

### 5.1 Appointment of Patent Agency

The provisions of Chapter 1, Section 6.1 of this Part shall apply.

### 5.2 Claiming Right of Priority

Where the applicant claims priority, the provisions of Articles 29.1 and 30, Rules 31 and 32.1, and the relevant provisions of the Paris Convention shall apply.

In accordance with Article 29.1, only foreign priority may be claimed for a patent application for design, that is, where, within six months from the date on which any applicant first filed in a foreign country a patent application for design, if he files in China a patent application for the same subject matter, he may, in accordance with any agreement concluded between said foreign country and China, or in accordance with any international treaty to which both countries are party, or on the basis of the principle of mutual recognition of the right of priority, enjoy a right of priority.

According to Rule 31.4, where the applicant of an application for a patent for design claims a foreign priority, if the earlier application does not include any brief explanation of the design, and if the brief explanation filed by the applicant in accordance with the provision of Rule 28 of these Implementing Regulations does not go beyond the extent of protection determined by the drawings or photographs of the earlier application documents, the priority will not be affected.

In accordance with Rule 32.1, the applicant may claim one or multiple priorities in one patent application for design.

During the preliminary examination of an application claiming multiple priorities, each priority shall be examined for its compliance

with the relevant provisions of this Chapter.

#### 5.2.1 Earlier Application and Subsequent Application Claiming Priority

The provisions of Chapter 1, Section 6.2.1.1 of this Part shall apply.

#### 5.2.2 Declaration of Claiming Priority

The provisions of Chapter 1, Section 6.2.1.2 of this Part shall apply.

#### 5.2.3 Copy of Earlier Application Document

The provisions of Chapter 1, Section 6.2.1.3 of this Part shall apply.

#### 5.2.4 Applicant of Subsequent Application

The provisions of Chapter 1, Section 6.2.1.4 of this Part shall apply.

#### 5.2.5 Withdrawal of Claim to the Right of Priority

The provisions of Chapter 1, Section 6.2.3 of this Part shall apply.

#### 5.2.6 Fee for Claiming Priority

The provisions of Chapter 1, Section 6.2.4 of this Part shall apply.

#### 5.2.7 Restoration of Claim to the Right of Priority

The provisions of Chapter 1, Section 6.2.5 of this Part shall apply.

### 5.3 Non-Prejudicial Disclosures

The provisions of Chapter 1, Section 6.3 of this Part shall apply.

### 5.4 Declaration of Withdrawing Patent Application

The provisions of Chapter 1, Section 6.6 of this Part shall apply.

### 5.5 Changes in Bibliographic Data

The provisions of Chapter 1, Section 6.7 of this Part shall apply.

## 6. Examination According to Article 5.1 and Article 25.1(6)

### 6.1 Examination According to Article 5.1

Article 5.1 provides that no patent right shall be granted for any invention-creation that is contrary to the laws or social morality or that is detrimental to public interest.

The examiner shall, according to the relevant provisions of Chapter 1, Section 3 of Part Ⅱ of these Guidelines, examine whether or not the design applying for a patent is obviously contrary to the laws, whether or not it is obviously contrary to social morality, and whether or not it is obviously detrimental to public interest.

#### 6.1.1 Contrary to the Laws

To be "contrary to the laws" refers to that the contents of a patent application for design have violated the laws formulated and promulgated by the National People's Congress or the Standing Committee of the National People's Congress according to the legislative procedure.

For example, a design of the bed sheet containing the pattern of Renminbi shall not be granted the patent right because it is contrary to the Law of the People's Republic of China on the People's Bank of China.

#### 6.1.2 Contrary to Social Morality

The social morality refers to ethic or moral concepts and standards of behavior generally believed to be appropriate and accepted by the public. Based on a given cultural background, what the social morality covers constantly changes with the progression of time and the progress of the society, and varies in different regions. The social morality mentioned in the Patent Law of China is limited in China. For example, designs containing drawings or photographs of violence, murder, and pornography shall not be granted the patent right.

#### 6.1.3 Detrimental to Public Interest

To be "detrimental to public interest" refers to that the exploitation or use of the design may harm the interests of the public or society, or may affect the normal order of the State and society.

Where the words or patterns of the design in a patent application relate to a major national political, economical or cultural event, or re-

ligious belief and consequently is detrimental to public interest, hurts the feeling of the people or the nation, propagates feudalism and superstition, or cause detrimental political impact, no patent right shall be granted to that application.

A design containing a famous building (e. g., the Tian' anmen Gate) or the portrait of a national leader shall not be granted the patent right.

Any design that takes Chinese national flag or Chinese national emblem as the pattern shall not be granted the patent right.

### 6.2 Examination According to Article 25.1(6)

Article 25.1 (6) provides that, for designs of two-dimensional printing goods, made of patterns, colours or their combination, which serve mainly as indicators, no patent right shall be granted. According to the provision of Rule 44.1(3), whether or not any application for a patent for design obviously falls under Article 25.1(6) of the Patent Law shall be examined during the preliminary examination of the design patent application.

Where an application for a patent for design meets the following three requirements, the application falls under Article 25.1(6) and no patent right shall be granted:

(1) the product for which the design is applied is a plane printed matter;

(2) the design is made of patterns, colours, or their combination; and

(3) the design serves mainly as indicator.

When examine the design patent application according to the mentioned provisions above, the examiner shall first examine, based on the drawings or photographs and the brief explanation, whether the product incorporating the design is a plane printing goods. Secondly, the examiner shall examine whether the design is made of patterns, colours, or their combination. As the shape element is not considered, thus, designs of all the two-dimensional printing goods may be deemed as designs made of patterns, colours, or their combination. Thirdly, the examiner shall examine whether the design serve mainly as indicator. "Serve mainly as indicators" means that the main purpose of the design is to help the public identify the related product, the origin of the service, etc.

Wallpapers, textiles are not the subject-matters that excluded by

this provision.

## 7. Examination According to Article 2.4

In accordance with the provisions of Article 2.4, "design" in the Patent Law means any new design of the shape, the pattern or their combination, and the combination of the colour with shape or pattern, of a product, which creates an aesthetic feeling and is fit for industrial application.

### 7.1 The Carrier of a Design Must be a Product

A design is the design of a product. The carrier of a design must be a product. Handicrafts, agricultural products, livestock products or natural products, which cannot be produced repeatedly, shall not be the carrier of the design.

### 7.2 Shape, Pattern, or Their Combination, Combination of Colour with Shape and/or Pattern

What constitute a design are the design elements or their combination of a product, including the shape, the pattern or their combination and the combination of the colour with shape or pattern. The colour of a product alone cannot constitute a design unless the change of the colour of a product constitutes a pattern. The combinations that may constitute a design include: the shape of a product; the pattern of a product; the shape and pattern of a product; the shape and colour of a product; the pattern and colour of a product; the shape, pattern and colour of a product.

"Shape" refers to the design of the molding of a product, that is, the external outline of a product presented by the move, change or combination of the dot, line or side of the external part of the product. That is the result of the synchronal design, manufacture of the structure, external shape and so on of a product.

"Pattern" refers to the figure constituted on the surface of the product by means of the arrangement or combination of the line, character, symbol or colour piece. Pattern may be created by drawing or other means which is able to embody the designing conception of the creator. The pattern of a product shall be permanent and visible, and not flickering or visible only under specific conditions.

"Colour" refers to the colour or combination of colours applied on the product. The natural colour of the raw material appeared on a

product is not the colour of the design.

The three elements, that is, shape, pattern and colour are inter-dependent, and sometimes it is difficult to define their boundary. For example, the arrangement of many colour pieces may constitute a pattern.

### 7.3 Aesthetic New Design Fit for Industrial Application

To be "fit for industrial application" refers to a design which may be used in industry and may be manufactured in batches.

"Aesthetic" means that when judging whether the subject matter is patentable, the visual sensation of the appearance of the product shall be taken into consideration, but not the function or technical effect of the product.

Article 2.4 is the general definition of a design which may obtain the patent protection. It is not the specific examination standard for determining whether designs are identical or substantive identical. As a result, during the preliminary examination, the examiner normally determines whether the claimed design meets the general requirements of "new design" only on the basis of the contents of the application documents and the common sense of the normal consumers.

### 7.4 Nonpatentable Situations for Design for Patent

According to Article 2.4, the following situations are ineligible for patent protection for design:

(1) any fixed building, bridge and the like which depends on their specific geographic conditions and cannot be rebuilt elsewhere, such as villa built by a particular lake or hill;

(2) any product which has no fixed shape, pattern or colour because it contains the substance which has no fixed shape, such as gas, liquid or powder;

(3) any component part of the product which cannot be partitioned or sold and used independently, such as the heel of socks, the peak of a hat, the handle of a cup, and so on;

(4) in the case of any product consisting of several component parts which have different shape or pattern, if each component part itself cannot be sold and used independently, such component part is not the subject matter under protection of the patent for design. For example, a jigsaw toy consisting of plug-in pieces of varied shape is a patentable subject matter only when one application relating to all the

pieces is filed;

(5) any product which cannot be perceived by the visual sense or be determined with the naked eye, and the shape, pattern or colour of which has to be distinguished by means of specific instruments, for example, a product whose pattern is only visible under an ultraviolet lamp;

(6) any design for which the protection is sought is not the design of the state of normal product, for example the design of the state of an animal made with a handkerchief;

(7) any design of which the main portion is the original shape, pattern or colour of the natural object, such design normally includes two situations, the natural object itself and the imitational design of the natural object;

(8) any work which belongs wholly to the field of fine arts, penmanship or photography;

(9) any design which is constituted only by geometric shapes or patterns of common sight in the field of the relevant product;

(10) the pronunciations or meanings of the words and numerals shall not be the contents of design protection; and

(11) the pattern shown when the product is electrified, such as the pattern on the electronic watch dial, the pattern on the screen of the mobile phone, software interface, and so on.

## 8. Examination According to Article 23.1

During the preliminary examination, the examiner usually does not conduct search and normally judges whether the design application obviously does not meet the requirements of Article 23.1 only on the basis of the content of the application document and common sense of the normal consumer.

The examiner, however, may judge whether the design obviously does not meet the requirements of Article 23.1 on the basis of the information, which is not resulted from search, concerning prior design or conflicting application.

When examining design relating to abnormal filing, among other things, obviously plagiarizing prior design or prior application with substantially identical content, the examiner shall judge whether the design obviously does not meet the requirements of Article 23.1 on the basis of prior design document resulted form search or information obtained through other channels.

Examination regarding identical or substantially identical designs shall follow provisions in Chapter 5 of Part IV of these Guidelines.

## 9. Examination According to Article 31.2

Article 31.2 provides that an application for a patent for design shall be limited to one design. Two or more similar designs for the same product or two or more designs which are incorporated in products belonging to the same class and sold or used in sets may be filed as one application (combination application for short).

### 9.1 Two or More Similar Designs of the Same Product

Rule 35.1

According to Article 31.2, two or more similar designs for the same product may be filed as one application.

No more than 10 similar designs in one application may be claimed. If more than 10 similar designs in one application have been claimed, the examiner shall issue the Office Action. If the applicant fails to overcome the defect after amendments, the application shall be rejected.

#### 9.1.1 Same Product

According to Article 31.2, each design shall be of the same product, for example, designs of dinner plate. If the designs are for dinner plate, saucer, cup and bow respectively, though they are under the same class, they do not belong to the same product.

#### 9.1.2 Similar Designs

According to Rule 35.1, the other designs for the product shall be similar to the main design designated in the brief explanation.

When judging similarity of designs, the examiner shall compare the other designs with the main design respectively.

Rule 44.1(3)

When an application involves similar designs during preliminary examination, the application shall be examined whether the design obviously does not meet the requirements of Article 31.2. Normally through overall observation, if the other designs and the main design have same or similar design features, and if the difference between them lies in slight changes in some fine details, usual design of this category of the products, the repeated and continuous arrangement of a design unit or mere change of colour element, they are considered as similar designs.

Art. 31. 2

### 9. 2 Designs of Products in Set

According to Rule 35. 2, products which belong to the same class and are customarily sold or used at the same time, and the designs of which have the same concept of design, may be filed in one application.

Products in set means that two or more products belonging to the same class, but independent from each other. The design concept for the products are the same. Each product has its own independent value of use while the combination of them reflects collective value of use, for example, a coffee set consisting of coffee cup, coffee pot, milk pot and sugar pot.

#### 9. 2. 1 Same Class

According to the provisions of Article 31. 2 and Rule 35. 2, one of the conditions for two or more designs to be filed in one application is that said two or more designs are incorporated in products belonging to the same class, that is, the products belonging to the same class in the International Classification for Industrial Designs.

It shall be noted that products being in the same class is not the only condition for two or more designs being filed in one application, the requirements concerning being sold or used in set and having the same design concept as provided for in Article 31. 2 shall also be complied with.

#### 9. 2. 2 Sold or Used in Set

"Being sold or used at the same time" provided in Rule 35. 2 means that the products incorporating the designs are customarily sold or used at the same time and have collective value of use.

(1) Sold at the same time

"Being sold at the same time" means that the products incorporating the designs are customarily sold at the same time, such as the multiple-piece bedding consisting of bedspread, sheet, pillow case and the like. The products which are sold together for the purpose of promotion cannot be filed as a set of products, such as a schoolbag and a pencil box. Although a pencil box will be given as a gift when a schoolbag is sold, they cannot be regarded as having been customarily sold together at the same time and they cannot be filed as a set of products.

(2) Used at the same time

"Used at the same time" means that the products are customarily used at the same time. Namely, when people use one product of the set, they often associate it with the existence of other products of the set. However, it does not necessarily mean use of the products of the set at the same moment, such as the case with coffee cup, coffee pot, sugar pot and milk pot of the coffee utensils.

### 9.2.3 Various Products Having Same Design Concept

"Same concept of design" refers to the unity of the style of design of each product. That means the design of the shape, pattern or their combination, or the combination of the colour with shape or pattern of each product is unified.

The unity of the shape means that each component product is characterized by a specific molding, or the combination relation between the component products is constituted on the basis of a specific molding. Under such circumstances, the products shall be regarded as being in conformity with the unity of the shape.

The unity of the pattern means that the design of the pattern and its subject matter, composition, form of expression, and so on, of each product shall be unified. If one aspect of them is different, the pattern of the products shall be regarded as not unified. For example, where the subject matter of the design of the coffee pot is orchid, while the subject matter of the design of the coffee cup is a panda, since the selected subject matters of design are different, the patterns are not unified, the principle of unity and coordination is not complied with, and hence, they cannot be filed in one application.

The unity of the colour cannot be considered alone. It must be considered comprehensively with the shape and pattern of each product. Where the shape, pattern of each product complies respectively with the principle of unity and coordination, if the statement of "seeking protection of colour" is not made in the brief explanation, the design concepts are the same; if the statement of "seeking concurrent protection of colour" is made in the brief explanation, and the style of the colour of the products is unified, the design concepts are the same; if the colour of each component product is quite different and the harmony of the entirety is damaged, the designs shall not be filed in one application.

#### 9.2.4 Products in Set Shall Not Include Similar Designs

Design patent application of products in set shall not include similar designs of one or more products. For example, a design patent application of products in set including dinner cup and saucer shall not involve two or more similar designs related to said cup and saucer.

Where the application is found to be not in conformity with said requirements, the examiner shall issue the Office Action to invite the applicant to make amendments.

### 9.3 Designs United in One Application Shall Respectively Meet the Requirements for Being Granted a Patent Right

It shall be noted that either two or more similar designs of the same product or a patent application for design in respect of a set of products, each design or design of each product, in addition to compliance with the relevant requirements concerning combination application mentioned above, shall respectively comply with the other requirements of granting. If one design or one design of one product fails to comply with the requirements, the design or the design of the product shall be removed, or the patent application shall not be granted a patent right.

### 9.4 Examination on Divisional Application

#### 9.4.1 Verification of Divisional Application

The provisions of Chapter 1, Section 5.1.1 of this Part shall apply.

#### 9.4.2 Other Requirements for Divisional Application

(1) Where the initial application contains two or more designs, the design of the divisional application shall be one or more of the designs taken out from the initial application and shall not go beyond the scope of the disclosure as shown in the initial application.

(2) Where the design of the initial application is a design of the whole product, the applicant is not allowed to take only part of the product out of the design as the subject matter of the divisional application. For example, where a patent application is filed to protect the design of a motorcycle as a whole, no divisional application may be made for the design of its spare parts or components.

Where a divisional application is found not to be in conformity with the requirement of item (1), the examiner shall issue the Office Action and invite the applicant to make amendments. Where no response is made within the time limit, the examiner shall issue *Notification that Application Deemed to be Withdrawn.* Where the applicant refuses to make amendments without sufficient reason, the examiner shall make a decision to reject the divisional application. Where the application is found to be not in conformity with the requirement of item (2), the examiner shall issue the Office Action. If no response is made within the specified time limit, the examiner shall issue *Notification that Application Deemed to be Withdrawn.* Where the applicant insists on filing a divisional application without sufficient reason, the examiner shall make a decision to reject the divisional application.

### 9.4.3 Time Limit and Fees for Divisional Application

The provisions of Chapter 1, Section 5.1.2 of this Part shall apply.

Rule 51.2 &.3

## 10. Examination According to Article 33

In accordance with the provisions of Article 33, the amendment made by the applicant to the patent application for design may not go beyond the scope of the disclosure as shown in the initial drawings or photographs. "The amendment goes beyond the scope of the disclosure as shown in the initial drawings or photographs" means that the design after amendment and the corresponding design disclosed in the initial application documents are not the same.

When judging whether the amendment made by the applicant to his patent application goes beyond the scope of the disclosure as shown in the initial drawings or photographs, if the content after amendment has been shown in the initial drawings or photographs, or can be determined directly and unambiguously therefrom, the amendment is considered in conformity with Article 33.

The applicant may amend the patent application documents for design on his own initiative within two months from the date of filing. Furthermore, upon the receipt of the Office Action or *Notification to Make Rectification* the applicant shall amend the patent application documents in response to the defects pointed out in the notification.

Rule 51.2

### 10.1 Amendment Made by Applicant on His Own Initiative

With regard to the amendment made by the applicant on his own initiative, the examiner shall first examine whether or not the date of amendment is within two months from the filing date. With regard to the amendment made two months later, if the amended documents overcome the defects existing in the initial application documents, and have the prospect of being granted the patent, the amended documents may be accepted. With regard to the amended documents which cannot be accepted, the examiner shall issue *Notification that Amendments Deemed Not to Have Been Submitted.*

With regard to the amendment made by the applicant on his own initiative within the two months, the examiner shall examine whether or not the amendment goes beyond the scope of the disclosure as shown in the initial drawings or photographs. If the amendment goes beyond the scope of the disclosure as shown in the initial drawings or photographs, the examiner shall issue the Office Action to notify the applicant that the amendment is not in conformity with the provisions of Article 33. If the amendment is still not in conformity with the provisions after the applicant makes observations or rectification, the examiner may make a decision of rejection according to the provisions of Article 33 and Rule 44.2.

Rule 51.3

### 10.2 Amendment in Response to Defects Pointed Out in Notification

With regard to the amendment in response to defects pointed out in the notification, the examiner shall examine whether or not the amendment goes beyond the scope of the disclosure as shown in the initial drawings or photographs, and whether or not it is in response to the defects pointed out in the notification. With regard to the amended document filed by the applicant including the amendment not in response to defects pointed out in the notification, if the amendment is in conformity with the provisions of Article 33, and overcomes defect in the original application document and the application has prospect of being granted, the amendment may be considered as the amendment in response to defects pointed out in the notification, the amended application document shall be accepted. If the amendment goes beyond the scope of the disclosure as shown in the initial drawings or photographs, the examiner shall issue the Office Action to notify the appli-

cant that the amendment is not in conformity with the provisions of Article 33. If the amendment is still not in conformity with the provisions after the applicant makes observations or rectification, the examiner may make a decision of rejection according to the provisions of Article 33 and Rule 44.2.

Rule 51.4

### 10.3 Amendment Made by Examiner *Ex Officio*

During the preliminary examination, the examiner may amend *ex officio* the obvious defects in the documents of the patent application mentioned in Sections 4.1, 4.2 and 4.3 of this Chapter, and notify the applicant accordingly. The contents which may be amended *ex officio* by the examiner mainly refer to the following:

(1) obvious mistake in the name of the product;

(2) obvious mistake in the title of the view;

(3) obvious mistake in the direction of the view;

(4) the lines describing the product in the drawings include lines which shall be deleted, such as shadow lines, indicating lines, central lines, dimension lines, dotted lines, etc.;

(5) the descriptions in the brief explanation are obviously not the contents which may be allowed therein. For example, description of the internal structure, description of technical effect, or words concerning promotion and advertising of the product;

(6) the drawing or photograph in the brief explanation designated by the applicant to best show the essential features of the design is obviously improper; and

(7) missing, misspelling and repeating of province (autonomous region and municipality), city, postal code and other information concerning the address of applicant or contact person in the request.

The contents which are amended *ex officio* by the examiner shall be recorded in the file and be notified to the applicant.

## 11. Examination According to Article 9

In accordance with Article 9.1, for any identical invention-creation, only one patent right shall be granted. According to Article 9.2, where two or more applicants file applications for patent for the identical invention-creation, the patent right shall be granted to the applicant whose application was filed first.

During the preliminary examination of a patent application for design, the examiner normally does not take the initiative to search and

examine as to whether or not a patent application for design can be granted the patent right according to the provisions of Article 9. However, where the examiner knows that one or more applicants have filed patent applications for the identical design, the examination shall be conducted.

### 11.1 Principles of Judgment

In the judgment of whether or not two or more designs constitute "identical invention-creation" stated in Article 9, it shall be determined on the basis of the designs of the products as shown in the drawings or photographs of the two patent applications for design or patents for design. Identical designs mean that the two designs are identical or substantially identical. In respect of the judgment principles of the identical or substantially identical designs, the provisions of Chapter 5 of Part IV of these Guidelines shall apply.

### 11.2 Method of Handling

The provisions of Chapter 3, Section 6.2 of Part Ⅱ of these Guidelines shall apply.

## 12. Classification of Design

The Patent Office uses the International Classification for Industrial Designs (Locarno Classification) to classify patent applications for design. The latest published Chinese version of the International Classification for Industrial Designs is the working document.

The objectives of design classification is to:

(1) determine the category of product incorporating the design;

(2) manage design patents by categories;

(3) enable search of design patents; and

(4) compile and publish design patent documents according to sequence of classification number.

Classification of design is working on product incorporating the design. A classification number consists of LOC (version number), Cl. and class number-subclass number (classification numbers referring below are class number-subclass number), for example LOC(9) Cl. 06-04. In the case of multiple classification numbers, each classification number is separated by a semicolon, for example LOC(9) Cl. 06-04; 23-02.

### 12.1 Basis of Classification

Classification of design is on the basis of the name of the product, drawings or photographs and the use of the product stated in the brief explanation.

### 12.2 Methods of Classification

Classification of design normally follows the principle of purpose of use, disregarding the material making the product. The use of the product may be known from name of product, drawings or photographs, intention of use of the product, field of use, method of use and other information provided by the applicant.

Determination of classification shall go by the order of class and then subclass. The classification of a product incorporating design shall belong to a class including its purpose of use and a subclass under the class. If there is no subclass including the purpose of use of the product under the class, the product shall be classified in subclass 99 under the class, namely miscellaneous.

With regard to component of a product, if there is a specific class, it shall be classified in that specific class. For example, tires of automobiles shall be classified into 12-15. If there is no specific class and the component does not belong to other products, it shall be classified into the class to which its higher-hierarchy product belongs to, for example, flint wheel of lighter shall be classified into 27-05. Determining whether there are specific classes for the components of product shall not be limited to matching with specific product items in the classification table, for example, outer shell of counterfeit money detector shall be classified into 10-07.

With regard to products with new use derived from developments, the product shall remain in the class of its traditional use. For example, lantern, though it has evolved from mere lighting device to ornamental product, it shall still be classified into class 26, lighting devices.

### 12.3 Determination of the Class and Subclass Numbers

#### 12.3.1 Classification of Product of Single Use

(1) Where a design application includes only a design of one product and the product has a single use, one class and subclass num-

ber shall be accorded.

(2) Where a design application includes multiple designs of the same product and the product has a single use, one class and subclass number shall be accorded.

(3) Where a design application includes designs of multiple products and the products have the same and single use. For example, one design patent application includes three pieces of bedding products, pillow case, bedspread and quilt cover, the classification number shall be 06-13.

### 12.3.2 Classification of Product of Multiple Uses

(1) Where a design application includes a design of one product and the product is a combination of products of two or more different uses, multiple classification numbers consistent with these uses shall be accorded, except for combination of furniture. For example, a photo frame with a thermometer has two uses in measuring temperature and placing photo, its classification numbers shall be 06-07 and 10-04. Another example, a desk-chair is a combination of furniture, its classification number shall be 06-05.

(2) Where a design application includes multiple designs of the same product and the product is a combination of products of two or more uses, multiple classification numbers consistent with these uses shall be accorded.

(3) Where a design application includes designs of multiple products and each product has a different use, multiple classification numbers consistent with these uses shall be accorded. For example, a design patent application includes two products in bowl and spoon, its classification numbers shall be 07-01 and 07-03.

### 12.3.3 Notification to Rectify in Classification Procedure

In accordance with Rule 28, the brief explanation shall state the use of the product incorporating the design.

Where the follow circumstances occur during classification procedure, *Notification to Rectify* shall be issued:

(1) the use of the product cannot be determined according to the name of product, drawings or photographs of the design and there is no statement about the use of the product in the brief explanation or the statement is not clear; and

(2) the use of the product determined from the name of product,

drawings or photographs of the design is obviously not in conformity with that stated in the brief explanation.

Applicant shall respond within two months after the receipt of the notification, furnishing the replacement sheet of the brief explanation of the design. The application will be deemed withdrawn where response could not be made after expiry of the above time limit.

# Chapter 4 Patent Classification

## 1. Introduction

The Patent Office adopts the International Patent Classification to conduct the classification for a patent application for invention and a patent application for utility model. The latest Chinese version of the "International Patent Classification (IPC, including the Guide to the IPC)" shall be the working text. Where there is discrepancy in interpretation, the same version of English or French shall prevail.

The purposes of classification are as follows:

(1) establishment of patent application files which are advantageous to patent search;

(2) distribution of patent applications for invention or for utility model to the corresponding examination departments; and

(3) classifying the patent applications for invention or for utility model according to the classification symbols so as to make them published or announced in a systematical way.

This Chapter only involves the classification for patent applications for invention and utility model. The classification for design shall follow the provisions in Chapter 3, Section 12 of this Part.

## 2. Contents of Classification

When the technical subject of each patent application for invention or utility model is classified, the complete classification symbols which represent the invention information of an invention or a utility model shall be provided. It is desirable that any additional information be classified. The classification symbol which most adequately represents the invention information shall be listed first.

Invention information is technical information in the whole text of a patent application (for example, the claims, description and drawings) that represents contribution to the prior art. The technical information contributing to the prior art means all novel and nonobvious technical information specially disclosed in a patent application.

Additional information does not in itself represent contribution to the prior art, but it might be useful to the search. The additional information includes the technical information which is identified by the in-

dexing code. The additional information complements the invention information. For example, the components of a composition or mixture, elements or components of a process or structure, or features of use or application of a classified technical subject.

## 3. Technical Subject

### 3.1 Category of Technical Subject

Technical subjects of inventions-creations may refer to processes, products, apparatus or materials, including the way these are used or applied. The scope of these technical subjects shall be interpreted in their widest sense.

(1) Processes, such as polymerization, fermentation, separation, shaping, conveying, treating of textiles, transfer and transformation of energy, building, preparation of foodstuffs, testing, methods of operating equipments and ways in which they work, processing and transmitting information.

(2) Products, such as chemical compounds, compositions, fabrics, articles of manufacture.

(3) Apparatus, such as installations used in chemical or physical processes, tools, implements, machines, devices for performing operations.

(4) Materials, such as ingredients of mixtures.

Material includes any substance, intermediate product, or composition for making product. The examples of material are as follows:

[Example 1]

Concrete. Its component materials are cement, sand, rock and water.

[Example 2]

Plywood used for manufacturing furniture. It is a material composed of multiple layers that are of even thickness, in more or less continuous contact with one another, and bonded together.

It shall be noted that an apparatus may be regarded as a product, since it is produced by a process. The term "apparatus" is associated with an intended use or purpose, e. g. , apparatus for generating gases, apparatus for cutting. However, the term "product" is only used to denote the result of a process regardless of the function of the product, e. g. , the endproduct of a chemical or manufacturing process. Materials per se may constitute products.

### 3.2 Determination of Technical Subject

The technical subject shall be determined according to the whole text of a patent application (for example, the claims, description and drawings). When the technical subject is determined on the basis of the claims, the unclaimed technical subject shall also be determined on the basis of the description and drawings.

#### 3.2.1 Circumstances in Which Technical Subject is Determined on the Basis of Claims

Where the technical subject is determined on the basis of the claims, the technical contents described in the claims shall be construed as a whole. For example, when the technical subject is determined by the independent claim, the technical features indicated in the preamble portion shall be combined with the technical features indicated in the characterizing portion.

Furthermore, the contents of the description and drawings shall be combined to correctly construe or clarify the technical features constituting the claimed technical solution indicated in the claims.

(1) Generally, the technical features in the preamble portion of the independent claim shall be the major technical features, while the technical features in the characterizing portion shall be regarded as restriction to the preamble portion.

[Example 1]

A building board used for wall or roof, characterized in that it consists of sheets, each of which is rectangle and comprises four parts, the surface shape of each part is hyperbolic paraboloid.

The technical subject is a sheet building board, used for wall or roof, and characterized in shape.

[Example 2]

A crude oil composition with an improved pour-point which comprises wax-bearing crude oil and an effective amount of pour-point depressant additive, wherein the additive consists of polymer of ethene and acrylonitrile and tripolymer.

The technical subject is: a crude oil composition characterized in an additive consisting of the polymer of ethene and acrylonitrile and tripolymer.

[Example 3]

A mechanical shock absorber of cotton textile machine, character-

ized in that viscoelastic materials are stuck on the steel plate so that the two combine as one entire piece.

The technical subject is: a mechanical shock absorber of cotton textile machine with viscoelastic materials stuck on steel plate combined as one entire piece.

[Example 4]

A loudspeaker, the piezoelectric ceramic sheet being connected at one end of the tubular shell by press, and the loudspeaker opening being at the other end, with two metal contacts being on the piezoelectric ceramic sheet, characterized in that a layer of vibration shell is installed on the outside of the loudspeaker shell, being connected with the edge of the loudspeaker opening, and there is an interval between the two shells to comprise a twin shell.

The technical subject is: a piezoelectric ceramic sheet loudspeaker, characterized in twin shell.

[Example 5]

An active dye compound, characterized in that the process of synthesis is by means of enzyme…

The technical subject is: an active dye compound synthesized with the use of enzyme…

(2) Where the subject matter described in the preamble portion of the independent claim has no specific place in the Classification, the determination of the technical subject shall be made mainly on the basis of the technical features described in the characterizing portion, and the technical features described in the preamble portion shall be regarded as the restriction to the characterizing portion.

[Example 1]

A switch, comprises a shell, the control device, wire tunnel, and open/close contact being equipped in the shell cover, characterized in that a light transmitting board made of transparent materials and a glow bulb indicating switch position are equipped under the opening of the shell cover.

The technical subject is: a device of a switch capable of indicating the position of the switch.

[Example 2]

A timing clock comprising of a shell and a cassette mechanism, characterized in that the shell is made of ceramic material, its appearance is…

The technical subject is: the shell of a timing clock made of ce-

ramic material…

### 3.2.2 Circumstances in Which Technical Subject Can Not Be Determined on the Basis of Claims

Where the technical subject cannot be determined on the basis of the claims, the determination shall be made on the basis of the technical problems solved by the invention or utility model, the technical solutions, technical effects or embodiments described in the description.

### 3.2.3 Unclaimed Technical Subject to Be Determined on the Basis of Description and Drawings

If the contents of the contribution to the prior art are described in the description and drawings, even though the contents have not been claimed, the technical subject of the contents shall also be determined.

## 4. Method of Classification

For a patent application, the invention information and additional information related to the technical subject shall be determined first, then the classification symbols corresponding to the invention information and the additional information shall be assigned.

### 4.1 Classification in Whole

The technical subject shall be classified, as far as possible, as a whole and not by separate classification of constituent parts.

However, if some constituent part of a technical subject represents contribution to the prior art, the constituent part constitutes invention information and shall be classified. For example, when classifying a larger system as a whole, if the parts or components of the system are novel and nonobvious, both the system and these parts or components shall be classified respectively.

[Example 1]

A tumbler auto-control bridge telescopic slot device consisting of middle girder, elastic sealing element, transverse-joist, supporting spring, transverse-joist sealing box and so on, characterized in that each transverse-joist…

To classify the bridge telescopic slot device as a whole, it is to be classified into E01D 19/06.

If the transverse-joist is novel and nonobvious, it is to be classified into E04C 3/02.

[Example 2]

A solid waste disposal system consists of import device and apparatuses of sorting, smashing, metal retrieving, plastic retrieving, fertilizer making and so on.

To classify the solid waste disposal system as a whole, it is to be classified into B09B3/00.

If the apparatus of smashing is novel and nonobvious, it is also to be classified into B02C 21/00.

## 4.2 Determination of Function Classification or Application Classification

### 4.2.1 Classification According to Function

If the technical subject is characterized by the intrinsic nature or function of a thing, and is not limited by a particular field of use, the technical subject shall be classified according to its function.

If the technical subject relates to a particular application, but not specifically disclosed or fully identified, the classification shall be made according to the function if the place of functional classification exists in the Classification or if several applications are broadly mentioned.

[Example 1]

The valves characterized by structural or functional aspects that do not depend on the nature of the particular fluid (e.g., oil) passing therethrough or any system including the valve are classified according to the function and to be classified into F16K.

[Example 2]

The organic chemical compounds characterized by their chemical structure are classified according to function and to be classified into C07.

[Example 3]

A cutting machine with a disk cutter turned around sliding shaft is classified according to its function and to be classified into B26D1/157.

### 4.2.2 Classification According to Application

If the technical subject is as follows, classification shall be made according to application.

(1) The technical subject concerns a thing which is “specially

adapted for" a particular use or purpose.

[Example]

A mechanical valve specially adapted for insertion into a human heart is classified according to its application and to be classified into A61F 2/24.

(2) The technical subject concerns the particular use or application of a thing.

[Example]

Filters specially adapted for cigarette are classified according to their application and to be classified into A24D 3/00.

(3) The technical subject concerns the incorporation of a thing into a larger system.

[Example]

The incorporation of a leaf spring into the suspension of a vehicle wheel is classified according to application and to be classified into B60G 11/02.

### 4.2.3 Classification According to Both Function and Application

If the technical subject relates both to the intrinsic nature or function of a thing and to its particular use or purpose, or its special application of incorporation into a larger system, the classification shall be made according to both function and application.

If the circumstances mentioned in proceeding Sections 4.2.1 and 4.2.2 are not applicable, the technical subject classification is made according to both function and application.

[Example 1]

A coating composition concerns both its ingredient and its particular use. It is classified not only into the appropriate place of C09D 101/00 to 201/00 according to its function, but also into C09D 5/00 according to its application.

[Example 2]

A leaf spring arranged in the suspension of a vehicle, if the leaf spring itself is novel and nonobvious, is classified into F16F 1/18 according to its function. If the arrangement of the leaf spring in the suspension of a vehicle is also novel and nonobvious, it is also classified into B60G 11/02 according to its application.

### 4.2.4 Special Circumstances

(1) Where the technical subject should be classified according to

function, if there is no such place of functional classification in the Classification, the classification shall be made according to appropriate application.

[Example]

Covering flux stripper for cable.

Since there is no place of functional classification for a covering flux stripper in the Classification, it is to be classified into H02G1/12 according to its application, i. e. , mainly for removing insulation or armouring from cable.

(2) Where the technical subject should be classified according to application, if there is no such place of application classification in the Classification, the classification shall be made according to appropriate function.

[Example]

A refrigerator protection device for overload, overvoltage and time delay startup.

If there is no place of application classification for an emergency protective-circuit specially adapted for a refrigerator in the Classification, it is to be classified into subclass H02H according to its function, i. e. , an emergency protective-circuit device.

(3) Where the technical subject should be classified according to both function and application, if there is no such place of functional classification in the Classification, it is to be classified only according to application; if there is no such place of application classification in the Classification, it is to be classified only according to function.

[Example]

A generator suited for illumination for animal-drawn cart is equipped with a gear-ratio-adjustable gearbox and can be easily coupled with the wheel.

If there is no place of application classification for a generator specially adapted for illumination for animal-drawn cart in the Classification, it is to be classified in H02K7/116 only according to its function.

### 4.3 Multiple Classifications

The primary purpose of classification is for search. Multiple classification symbols may be assigned on the basis of the contents of the technical subject.

Where the patent application concerns different categories of sub-

ject matters which constitute the invention information, multiple classification shall be made according to the related subject matters. For example, where the subject matters concern a product and its manufacturing process, if there are classification places of the product and process in the Classification, the product and process shall be classified respectively.

Where the technical subject concerns classification according to both function and application, the classification shall be made according to both function and application.

The multiple classification or classification in combination with indexing codes shall also be used as much as possible when the additional information is useful for the search.

### 4.3.1 Multiple Aspects Classification of Technical Subject

Multiple aspects classification of the technical subject represents a special type of multiple classification. Multiple aspects classification is applied to the technical subject which, by its nature, is characterized by several aspects, for example, by its intrinsic structure and its particular use or function. Classifying of such subject matter according to only one aspect would lead to incomplete search information.

The classification places in the Classification are indicated with note to show the use of multiple aspects classification.

[Example]

G11B 7/24 · record carriers characterized by the selection of the material or by the structure or form

G11B 7/241 · · characterized by the selection of the material

G11B 7/252 · · · of layers other than recording layers

Note:

In subgroup G11B 7/252, multiple aspects classification is applied, so that if the technical subject is characterized by aspects covered by more than one of its subgroups, the subject matter shall be classified in each of those subgroups.

G11B 7/253 · · · · Base layers

G11B 7/254 · · · · Protective topcoat layers

When the technical subject concerns both the base layers and protective topcoat layers of layers other than recording layers, the base layers and protective topcoat layers shall be classified into G11B 7/253 and G11B 7/254 respectively.

### 4.3.2 Secondary Classification

Secondary classification is used for obligatory supplementary classification for the technical subject already classified in other classification places. Examples of such secondary classification are A01P, A61P, A61Q and C12S.

The symbols in secondary classification shall not be used as the first place classification symbols.

### 4.3.3 Hybrid System and Indexing Code

The hybrid system consists of classification symbols and indexing codes used together with it.

Indexing codes can only be applied in combination with classification symbols. Indexing codes have a format similar to classification symbols but usually use a unique numbering system.

The note in the Classification indicates the classification place where the indexing code may be used. Correspondingly, a note, title or heading before the indexing codes indicates with which classification symbols those indexing codes are used.

### 4.4 Special Classification for Technical Subject

(1) Technical subject may have different classification. If the classification place is not provided for the technical subject of a certain category, the most appropriate technical subject of other category shall be used for classification, see Section 8 of this Chapter for details.

(2) If the classification place adequately covering the technical subject can not be found, the technical subject shall be classified in the special remaining group 99/00.

[Example]

Section A

A99Z 99/00 Subject matter not otherwise provided for in this section.

Section F subclass F02M

F02M 99/00 Subject matter not otherwise provided for in this subclass.

## 5. Summary of Rules for Classification Places

In some places of the classification, the reference or note indicates how to use priority rules (the first place rule and the last place rule)

and special rules. Attention shall be paid to the usage of these classification place rules.

The note is applicable only to the relevant place and its further divided places, and shall prevail over the general rules if it conflicts with the general rules.

## 6. Classification Steps

The classification is made in order of hierarchy, i. e. , section, class, subclass, group and subgroup, until the appropriate group of the lowest level is found.

## 7. Classification for Patent Applications at Different Publication Levels

### 7.1 Classification of Unsearched Patent Applications

All claimed subject matter that is potentially novel and unobvious, any potentially novel and unobvious constituents or components of the claimed subject matter, and any unclaimed subject matter in the description and drawings that is potentially novel and unobvious shall be classified as invention information.

It is desirable to classify or index all the claimed and non-claimed additional information if it is useful for search.

### 7.2 Classification of Searched and Examined Patent Applications

All claimed subject matter that is novel and unobvious, any novel and unobvious constituents or components of the claimed subject matter, and any unclaimed subject matter in the description and drawings that is novel and unobvious shall be classified as invention information.

It is desirable to classify or index all the claimed and non-claimed additional information if it is useful for search.

## 8. Classification of Specific Technical Subject

### 8.1 Chemical Compounds

When the subject matter concerns a chemical compound per se, e. g. , organic, inorganic or macromolecular compound, it shall be classified in section C. When it also concerns a specific field of use, it shall also be classified in the place provided for that field of use, if

such field of use constitutes contribution to the prior art. However, where the chemical compound is known and the subject matter concerns only the application of the compound, it shall be classified only in the place covering the field of use.

### 8.2 Chemical Mixtures or Compositions

When the subject matter concerns a chemical mixture or composition per se, it shall be classified in a place according to its chemical composition, e. g. , the glass is classified into C03C, the cements or ceramics are classified into C04B, the compositions of macromolecular compounds are classified into C08L, and the alloys are classified into C22C. If such a place does not exist in the Classification, it shall be classified according to its use or application. If the use or application also constitutes contribution to the prior art, a mixture or composition shall be classified according to both its chemical composition and its use or application. However, when the chemical mixture or composition is known and the subject matter concerns only its use or application, it shall be classified only in the place covering the field of use or application.

### 8.3 Preparation or Treatment of Compounds

When the subject matter concerns a process of preparation or treatment of a chemical compound, it shall be classified in the place for the process of preparation or treatment of the compound concerned. If such a place does not exist, it shall be classified in the place of the compound. When the compound resulting from the preparation process is also novel, the compound shall also be classified. Subject matter concerned with general processes for the preparation, or treatment, of a plurality of compounds shall be classified in the place for the processes employed.

### 8.4 Apparatus or Processes

When the subject matter concerns an apparatus, it shall be classified in the place for the apparatus. When such a place does not exist, the apparatus shall be classified in the place for the process performed by that apparatus. When the subject matter concerns a process for making or treatment of products, it shall be classified in the place for the process performed. When such a place does not exist, it shall be classified in the place for the apparatus performing the process. If no

place exists for the apparatus performing the process, it shall be classified in the place covering the product.

### 8.5 Articles of Production

When the subject matter concerns an article, it shall be classified in the place for the article. If no place exists for the article itself, it shall be classified in the appropriate place according to the function performed by the article. If no classification place exists according to the function, the classification shall be made according to the field of use.

### 8.6 Multistep Processes, Industrial Plants

When the subject matter concerns a multistep process or an industrial plant that consists, respectively, of a combination of process steps or apparatus, it shall be classified as a whole, i. e. , in a place provided for such combination, e. g. , subclass B09B. If no such place exists in the Classification, it shall be classified in the place for the product obtained by the process or plant. When the subject matter concerns also an element of the combination, e. g. , an individual step of the process or machine of the plant, the element shall also be separately classified.

### 8.7 Elements, Structural Parts

When the subject matter concerns structural or functional elements or parts of a product or an apparatus, the following rules shall apply.

Elements or parts only applicable to, or specially adapted for, one kind of product or apparatus, shall be classified in the elements or parts places of the product or apparatus. If such places do not exist, these elements or parts shall be classified in the place for the product or apparatus.

Elements or parts applicable to more than one of different kinds of product or apparatus shall be classified in the elements or parts places of more general nature. If such places of more general nature do not exist, these elements or parts shall be classified according to all of the kinds of product or apparatus to which they explicitly apply.

### 8.8 General Chemical Formula

A general formula is often used to express one or more genus of compound, wherein at least one group of the formula is variable,

e. g., "Markush"type compound. When an enormous number of compounds are within the scope of general formula and are separately classifiable in a large number of classification places respectively, only the individual chemical compounds most useful for search shall be classified. If the chemical compounds are specified using a general chemical formula, the following classifying procedure shall be applied:

Step 1: All "fully identified" compounds that are novel and unobvious are classified. A compound is considered to be "fully identified" where:

(1) the structure is given by the exact chemical name or formula, or can be deduced from its preparation from specified reactants, not more than one of which is selected from a list of alternatives; and

(2) the compound is characterized by a physical property, for example, its melting point, or its preparation is described in one embodiment giving practical elements.

Compounds identified only by an empirical formula are not considered to be "fully identified."

Step 2: If no "fully identified" compounds are disclosed, the general formula shall be classified in the most specific groups that cover all or most of the potential embodiments. The classification of general chemical formula shall be limited to a single or a very small number of groups.

Step 3: In addition to the above classification according to steps 1 and 2, the classification may be made when other compounds within the scope of the general formula are important.

When classification of all the "fully identified" compounds into their most specific classification places would lead to a number of classification symbols (e. g., more than twenty), the classifier may reduce the number of symbols. This may only be done when the classification of the "fully identified" compounds would lead to the assignment of a number of subgroups under a single group at the next hierarchically higher level. Classification of these compounds may then be made in the higher group only. Otherwise, classification of the compounds shall be made in all of the more specific subgroups.

### 8.9 Combinatorial Libraries

Collections composed of many chemical compounds, biological entities or other substances may be presented in the form of "libraries". The library as a whole shall be classified in an appropriate

group in subclass C40B. At the same time, the individual members which are considered "fully identified" shall be classified into the most specific places, e. g. , the library of nucleotides as a whole shall be classified into an appropriate group in subclass C40B. At the same time, the "fully identified" nucleotide shall be classified into appropriate places in section C.

# Part II

# Substantive Examination

# Chapter 1 Inventions-Creations for Which No Patent Right shall be Granted

Art. 1

## 1. Introduction

Granting patent right for an invention-creation shall be favorable to advance the application of the invention-creation, enhance innovation capability, and promote the progress of science and technology, and the development of economy and society. Thus, Article 2 provides for subject matters for which patent right may be granted. Considering the interests of the State and the society, certain restrictions are also made in the Patent Law to the extent of patent protection. On one hand, Article 5 provides that no patent right shall be granted for any invention-creation that is contrary to the laws or social morality or that is detrimental to public interest; no patent right shall be granted for any invention-creation where acquisition or use of the genetic resources, on which the development of the invention-creation relies, is not consistent with the provisions of the laws and administrative regulations. On the other hand, Article 25 provides for a list of subject matters for which no patent right shall be granted.

Art. 2.2

## 2. Subject Matters Not Complying with Article 2.2

"Invention" in the Patent Law refers to any new technical solution concerning a product, a process or improvement thereof. This is a general definition to the subject matters for which patent protection may be sought, rather than a specific examination criterion for the determination of novelty or inventive step.

A technical solution is an aggregation of technical means applying the laws of nature to solve a technical problem. Usually, technical means are embodied as technical features.

A solution that does not adopt technical means to solve a technical problem and thereby does not achieve any technical effect in compliance with the laws of nature does not constitute a subject matter as defined in Article 2.2.

Smell, signal such as sound, light, electricity, magnetism, and wave, or energy does not constitute a subject matter as provided in Article 2.2. However, patent applications in which its nature is utilized to

solve a technical problem cannot be excluded as above.

Art. 5

## 3. Inventions-Creations Excluded from Patent Protection under Article 5

According to Article 5.1, no patent right shall be granted for any invention-creation if its disclosure, use or manufacture is contrary to the laws or social morality or detrimental to public interest.

According to Article 5.2, no patent right shall be granted for any invention-creation where acquisition or use of the genetic resources, on which the development of the invention-creation relies, is not consistent with the provisions of the laws and administrative regulations.

The connotation of the laws, administrative regulations, social morality and public interest is quite broad, which may vary with time and from region to region. Sometimes certain restrictions may be added or removed because of enactment and implementation of a new law or administrative regulation or amendment to or abolishment of a preceding law or administrative regulation. Therefore, the examiner shall pay special attention to this point in conducting examination according to Article 5.

Art. 5.1

## 3.1 Inventions-Creations Excluded from Patent Protection under Article 5.1

### 3.1.1 Inventions-Creations Contravening the Laws

The laws refer to the laws formulated and promulgated by the National People's Congress or its Standing Committee following the legislative procedure. They do not include administrative regulations made by the State Council or its departments or local governments.

Where an invention-creation is contrary to the laws, it cannot be granted for a patent right. For example, gambling facilities, devices or instruments, drug-taking appliances, apparatus for counterfeiting banknotes, bills, official documents, certificates, seals, and historic relics are all inventions-creations contravening the laws and no patent rights shall be granted for them.

Where an invention-creation is not contrary to the laws but its abuse may be contrary to the laws, it shall not be excluded from patent protection as above. Examples of such include the various toxicants, anesthetics, sedatives, and analeptics used for medical treatment, and playing cards and chesses used for entertainment.

Rule 10 provides that inventions-creations that are contrary to the laws referred to in Article 5 shall not include an invention-creation merely because the exploitation of which is prohibited by the laws. It means that, where the laws merely restrict or limit the manufacture, sale or use of the product of an invention-creation, the product per se and the processes of its manufacture do not belong to the inventions-creations that are contrary to the laws. For example, although the manufacture, sale or use of the various weapons used for national defense are restricted by the laws, these weapons per se and its processes of manufacture are still patentable subject matters.

### 3.1.2 Inventions-Creations Contrary to Social Morality

"Social morality" refers to ethical or moral norms and rules generally recognized as justifiable and accepted by the public. Its connotation is based on certain cultural background, continuously changes with time and social progress, and varies from region to region. Social morality referred to in the Chinese Patent Law indicates that within the territory of China.

Where an invention-creation is contrary to social morality, it shall not be granted a patent right. For example, inventions-creations such as a design with drawings or photographs of violence, murder or obscenity, an artificial sexual organ or its substitute not for medical use, or a method of mating a human-being with an animal, a process for modifying the germ line genetic identity of human beings or a human being thus modified, a process for cloning human beings or a cloned human being, use of human embryos for industrial or commercial purposes, and a process for modifying the genetic identity of animals which is likely to cause them suffering without any substantial medical benefit to human-beings or animals, are contrary to social morality and thus shall not be granted patent rights.

### 3.1.3 Inventions-Creations Detrimental to Public Interest

The expression "detrimental to public interest" means that the exploitation or use of an invention-creation may cause detriment to the public or the society or may disrupt the normal order of the State and the society.

[Examples]

Where an invention-creation employs the means of disabling or injuring a person or damaging property, such as an anti-theft device or

process by causing blindness to the thief, it shall not be granted a patent right.

Where the exploitation or use of an invention-creation may seriously pollute the environment, seriously waste energy or resources, disrupt ecological balance, or impair the health of the public, the invention-creation shall not be granted a patent right.

Where a patent application has words or pictures concerning an important political event of the State or a religious belief, hurting the sentiments of the people or of an ethnic group, or advocating superstition, it shall not be granted a parent right.

However, if an invention-creation is possibly detrimental to public interest in its abuse, or has certain defects despite positive effects, such as a pharmaceutical product with side effects on human body, it shall not be refused to grant a patent right on the ground that it is detrimental to public interest.

### 3.1.4 Inventions-Creations Partially Contravening Article 5.1

A patent application is considered partially contravening Article 5.1 if a part of the application contains certain content that is contrary to the laws or social morality or that is detrimental to public interest and the rest part of the application is not. In respect of such an application, the examiner during examination shall notify the applicant to amend his application and delete the part contravening Article 5.1. If the applicant refuses to delete the part that is contrary to the laws, it cannot be granted a patent right.

For example, concerning an invention-creation of "a slot marbles game machine", which will eject a certain amount of money when the player achieves a certain amount of points, the examiner shall notify the applicant to delete or amend the part involving ejection of money and make it a mere slot marbles game machine. Otherwise, even if it is a new technical solution involving an inventive step, it cannot be granted a patent right.

Art. 5.2

### 3.2 Inventions-Creations Excluded from Patent Protection under Article 5.2

According to Article 5.2, no patent right shall be granted for any invention-creation where acquisition or use of the genetic resources, on which the development of the invention-creation relies, is not consistent with the provisions of the laws and administrative regulations.

According to Rule 26. 1, the genetic resources referred to in the Patent Law mean the material obtained from such as human body, animal, plant, or microorganism which contains functional units of heredity and is of actual or potential value. The invention-creation is developed relying on the genetic resources referred to in the Patent Law means that the invention-creation is developed relying on the use of the heredity function of the genetic resources.

In the above-mentioned provisions, heredity function refers to the ability of organism to pass on traits or characteristics from an ancestor to a descendent through reproduction, or allow the entire organism to be reproduced.

Functional unit of heredity refers to a gene, or a DNA or RNA fragment having heredity function of an organism.

"Material obtained from such as human body, animal, plant or microorganism which contains functional units of heredity" refers to carrier of functional units of heredity, which includes not only a whole organism, but also a part of it, such as organ, tissue, blood, body fluid, cell, genome, gene, DNA or RNA fragment, etc.

With regard to an invention-creation, using the heredity function of the genetic resources refers to, for example, isolating, analyzing and/or processing the functional units of heredity to develop the invention-creation and to realize the value of the genetic resources.

"Acquisition or use of the genetic resources is not consistent with the provisions of the laws and administrative regulations" means that the acquisition or use of the genetic resources is not beforehand approved by relevant administrative departments or licensed by relevant right holder in accordance with the provisions of relevant laws and administrative regulations of China. For example, in accordance with the provisions of "Animal Husbandry Law of the People's Republic of China" and "Measures for Examination and Approval in respect of the Entry and Exit of Genetic Resources of Livestock and Poultry and in respect of Research in Their Utilization in Cooperation with Foreign Entities", in the case of exporting abroad the genetic resources that have been included in the directory for protection of the genetic resources of livestock and poultry in China, relevant formalities for examination and approval shall be gone through. Where certain genetic resources that have been included in the directory for protection of livestock and poultry are exported abroad from China, but no formality for examination and approval has been gone through, no patent right

shall be granted for any invention-creation developed relying on such genetic resources.

Art. 25

**4. Subject Matters Excluded from Patent Protection under Article 25**

Where a patent application claims a subject matter belonging to the subject matters excluded from patent protection under Article 25. 1, it shall not be granted a patent right.

Art. 25. 1(1)

**4. 1 Scientific Discoveries**

"Scientific discoveries" refer to the revelations of substances, phenomena, transformation processes and their features and laws, which objectively exist in the nature. Scientific theories are the generalization of understandings of the nature, and are discoveries in a broader sense. All of these are the extension of the cognition of human beings. Because these discovered substances, phenomena, processes, features and laws are different from the technical solutions of reforming the objective world, they are not inventions-creations as referred to in the Patent Law and therefore cannot be granted patent rights. For example, discovery of the photosensitive property of a silver halide under illumination cannot be granted a patent right. However, patent right may be granted for the photographic film and the process to produce the film in accordance with this discovery. For another example, finding in the nature a previously unknown substance existing in its natural state is merely a discovery, and cannot be granted a patent right (for examination of patent applications concerning substance separated or extracted from the nature for the first time, Chapter 10, Section 2. 1 of this Part shall apply).

It should be noted that, although invention and discovery are different in substance, they are closely interrelated. Usually, many inventions are made on the basis of discoveries. In turn, inventions promote discoveries. Such close relationship between invention and discovery is especially prominent in "use invention" of chemical substances. When a special property of a certain substance is discovered, usually a use invention utilizing this property will be made accordingly.

Art. 25. 1(2)
Art. 2. 2

**4. 2 Rules and Methods for Mental Activities**

"Mental activities" refer to human's thinking movements. They originate from human's thinking, and produce abstract results through inference, analysis and judgment, or, via human's thinking movement,

produce results by indirectly acting on the nature. Rules and methods for mental activities are rules and methods governing people's thinking, expression, judgment, and memorization. Because they do not use technical means or apply the laws of nature, nor do they solve any technical problem or produce any technical effect, they do not constitute technical solutions. Rules and methods for mental activities not only fail to comply with Article 2. 2, but also fall to be the circumstance as provided in Article 25. 1(2). Therefore, rules and methods instructing people on how to perform this kind of activities cannot be granted patent rights.

In determining whether or not a claimed subject matter in a patent application involving rules and methods for mental activities is a patentable subject matter, the following principles shall be followed.

(1) If a claim concerns only rules and methods for mental activities, it shall not be granted a patent right.

If a claim, except for the title of the subject matter, is defined by rules and methods for mental activities in the whole contents, in substance it concerns only rules and methods for mental activities, and it shall neither be granted a patent right.

Examples include the following:

methods of examining patent applications;

methods and systems of managing organization, production, commercial activities, or economy, etc. ;

traffic rules, schedules, competition rules;

methods of deduction, inference, or operations;

rules of classifying books, methods of editing dictionary, methods of searching information, methods of classifying patents;

rules and methods of editing calendar;

operating instructions of an instrument or an apparatus;

grammar of various languages, rules of coding Chinese characters;

computer languages, computing rules;

short-cut arithmetic methods and relevant pithy formulae;

mathematical theories and methods of conversion;

methods of psychological test;

methods of teaching, lecturing, training, and beast training;

rules and methods of various games or entertainment;

methods of statistics, accounting, or bookkeeping;

music books, food recipes, or chess manuals;

methods of keeping fitness;

methods of disease survey and methods of population census;

methods of presenting information; and

computer programs per se.

(2) Except the cases described above in point (1), if a claim in its whole contents contains not only matter of rule or method for mental activities but also technical features, then the claim, viewed as a whole, is not a rule or method for mental activities, and shall not be excluded from patentability under Article 25.

Art. 25.1(3)

### 4.3 Methods for Diagnosis or for Treatment of Diseases

"Methods for diagnosis or for treatment of diseases" refer to the processes of identifying, determining, or eliminating the cause or focus of diseases which are practiced directly on living human or animal bodies.

For humanity and ethical reasons, it is acknowledged that a doctor shall be given the freedom to choose any means in the course of diagnosis or treatment of diseases. Moreover, this kind of methods are not susceptible of industrial application because they are practiced directly on living human or animal bodies, and are not inventions-creations in the context of the Patent Law. Therefore, methods for diagnosis or for treatment of diseases shall not be granted patent rights.

However, instruments or apparatus for implementing these methods of diagnosis or treatment, or substances or materials for use in such methods are subject matters for which patent right may be granted.

#### 4.3.1 Diagnostic Methods

Diagnostic methods refer to the processes of identifying, studying, and determining the cause or focus of diseases on living human or animal bodies.

##### 4.3.1.1 Inventions Belonging to Diagnostic Methods

Where a method involving diagnosis of a disease complies with the following two requirements, it is a diagnostic method and cannot be granted a patent right:

(1) it is practiced on a living human or animal body; and

(2) its immediate purpose is to obtain the diagnostic result of a disease or health condition.

If an invention, as viewed from its description, is practiced on

samples *in vitro*, but its immediate purpose is to obtain the diagnostic result of a disease or health condition for the same subject, it shall not be granted a patent right.

If a method claimed in a patent application includes diagnostic steps, or includes testing steps if no diagnostic steps, and the diagnostic result of a disease or health condition can be reached immediately based on the diagnostic or test information thus obtained according to the medical knowledge in the prior art and the disclosure of the application, then the method can be regarded as satisfying the above requirement (2).

The following are examples of diagnostic methods for which no patent right shall be granted:

method of measuring blood pressure, method of taking pulse, feet diagnostic method, X-ray diagnostic method, ultrasonic diagnostic method, gastrointestinal radiography diagnostic method, endoscopy diagnostic method, isotope tracing diagnostic method, infrared noninvasive diagnostic method, method of evaluating the risk of suffering diseases, method of predicting the therapeutic efficacy for diseases, and gene screening diagnostic method.

#### 4.3.1.2 Inventions Not Belonging to Diagnostic Methods

The following are examples which do not belong to diagnostic methods:

(1) method of pathological anatomy practiced on a dead human or animal body;

(2) method the immediate purpose of which is only to obtain information from the living human or animal body as an intermediate result rather than to obtain the diagnostic result or health condition, or method of processing such information (e.g., physique and body parameters, physiological parameters, or other parameters); and

(3) method the immediate purpose of which is only to treat or test the body tissues, body fluids, or excrements that have been removed from the human or animal body in order to obtain information as an intermediate result rather than to obtain the diagnostic result or health condition, or method of processing such information.

As for the above items (2) and (3), it should be noted that only if the diagnostic result of a disease and health condition cannot be reached immediately based on the obtained information per se in accordance with the medical knowledge in the prior art and the disclo-

sure of the application, can the information be regarded as an intermediate result.

### 4.3.2 Methods of Treatment for Diseases

Methods of treatment for diseases refer to the processes of intercepting, relieving, or eliminating the cause or focus of diseases so that the living human or animal bodies may recover or gain health or relieve pain.

Methods of treatment for diseases include the various methods which serve treatment purpose or which are of treatment nature. Prophylactic methods and methods of immunization are regarded as methods of treatment for diseases.

For a method both possibly serving treatment purpose and possibly serving non-treatment purpose, unless it is clearly stated that the method serves non-treatment purpose, it cannot be granted a patent right.

#### 4.3.2.1 Inventions Belonging to Methods of Treatment for Diseases

The following are examples that belong to or shall be regarded as methods of treatment for diseases and thus shall not be granted patent rights:

(1) methods of treatment by surgery, methods of treatment by pharmaceutical therapy, or psychotherapeutics;

(2) methods of acupuncture, anesthesia, manipulation, massage, Gua Sha (scraping therapy), qigong, hypnosis, medicated bath, air bath, sunbath, forest bath, and nursing care for the purpose of treatment;

(3) methods of stimulating or irradiating a human or animal body by radiation of electricity, magnetism, sound, light, or heat etc. for the purpose of treatment;

(4) methods of coating, freezing, or diathermy etc. for the purpose of treatment;

(5) various immunization methods for prevention of diseases;

(6) methods auxiliary to a surgery treatment and/or pharmaceutical therapy, such as method of processing cells, tissues, or organs that will be returned to the same subject, method of hemodialysis, method of monitoring the depth of anesthesia, method of taking medicines, method of injecting medicines, or method of applying medicines exter-

nally;

(7) methods of fertilization, contraception, increasing the number of sperm, adosculation, or embryonic transfer etc. for the purpose of treatment;

(8) methods of cosmetic surgery, stretching limbs, losing weight, or increasing height for the purpose of treatment;

(9) methods of treating human or animal wounds, such as method of disinfecting or bandaging a wound; and

(10) other methods such as method of artificial respiration and method of oxygen supply for the purpose of treatment.

It shall be noted that although methods of treatment for diseases by using medicines are not patentable, medicines per se can be granted patent rights. For examination of patent applications concerning medical use of substances, Chapter 10, Sections 2.2 and 4.5.2 of this Part shall apply.

#### 4.3.2.2 Inventions Not Belonging to Methods of Treatment for Diseases

The following methods are examples which do not belong to methods of treatment for diseases, and shall not be excluded from patentability under Article 25.1(3):

(1) methods of making artificial limbs or other prostheses, and methods of measurement in making such artificial limbs or prostheses. Take for example a method of making dental prosthesis, including the step of making tooth mould in the oral cavity of the patient and the step of making dental prosthesis outside the oral cavity. Although the ultimate aim is for treatment, the purpose of the method in itself is to make suitable dental prosthesis;

(2) methods of stockbreeding by treating animal bodies by a non-surgery means to change their growing trait, such as methods of applying certain electromagnetic stimulation to live lambs in order to accelerate their growth speed, improve the quality of mutton, or increase the output of wool;

(3) methods of butchering animals;

(4) methods of treating dead human or animal bodies, such as methods of anatomy, beautification, antisepsis, or making specimen;

(5) methods of purely cosmetic nature, i. e. , methods of cosmetic nature which are not invasive to human body or do not produce wounds, including methods of deodorization, protection, decoration, or

beautification for non-treatment purpose practiced partially on such directly visible parts as skin, hair, nail, and teeth externals;

(6) methods for making a human or animal not in a diseased state feel comfortable or pleased, or methods for supplying oxygen, negative oxygen ions, or moisture under a special condition such as for diving or for shielding from toxic gas; and

(7) methods of killing bacteria, viruses, lice, or fleas on a human or animal body (on the skin or in the hair, excluding wounds and infected sites).

#### 4.3.2.3 Methods of Surgery

Methods of surgery refer to the methods of traumatic or invasive treatment such as incision, resection, stitching, and tattooing practiced on living human or animal bodies with the aid of instruments. Such methods cannot be granted patent rights. However, a method of treatment such as incision, resection, stitching, and tattooing practiced on a dead human or animal body may be patentable in so far as it does not violate Article 5.1.

Methods of surgery are divided into one kind for the purpose of treatment and the other kind for the purpose of non-treatment.

A method of surgery for the purpose of treatment belongs to methods of treatment for diseases, for which no patent right shall be granted in accordance with Article 25.1(3).

For examination of methods of surgery for non-treatment purposes, Chapter 5, Section 3.2.4 of this Part shall apply.

Art. 25.1(4)

### 4.4 Animal and Plant Varieties

Animal and plant are living things. According to Article 25.1(4), no patent rights shall be granted for animal and plant varieties. Animal referred to in the Patent Law does not include human being, and it refers to the life form which cannot synthesize carbohydrate and protein by itself but maintains its life only by absorbing natural carbohydrate and protein. Plant mentioned in the Patent Law refers to the life form which maintains its life by synthesizing carbohydrate and protein from the inorganics, such as water, carbon dioxide, and inorganic salt, through photosynthesis, and usually is immovable. Animal and plant varieties can be protected under other laws and regulations other than the Patent Law. For example, new plant varieties can get protection under the *Regulations on the Protection of New Varieties of*

*Plants*.

Moreover, according to Article 25.2, patent right may be granted for processes used in producing animal and plant varieties. The processes of production herein refer to non-biological processes, and do not include those for the production of animals or plants through essentially biological processes.

Whether or not a process is an "essentially biological process" depends on the degree of human technical involvement in the process. If the human technical involvement is the controlling or decisive factor for achieving the result or effect of that process, the process is not essentially biological. For example, the method of raising high yield dairy cattle through irradiation and the method of producing lean meat pigs by improving raising approach are patentable subject matters.

Microorganism inventions refer to those relating to producing a chemical substance (such as an antibiotics) or decomposing a substance by means of microorganisms such as various bacteria, fungi, and viruses. Microorganisms and microbial processes are all patentable. For examination of patent applications for invention concerning microorganisms, the relevant provisions of Chapter 10 of this Part shall apply.

Art. 25.1(5)

### 4.5 Methods of Nuclear Transformation and the Substances Obtained Therefrom

Methods of nuclear transformation and the substances obtained therefrom are of much concern with national interests in economy, defense, scientific research, and public order, and shall not be monopolized by individuals or entities. Therefore they cannot be granted patent rights.

#### 4.5.1 Methods of Nuclear Transformation

Methods of nuclear transformation refer to the processes of one or more atomic nucleus forming one or more new atomic nucleus through fission or fusion, such as the method of magnetic mirror traps and the method of close traps for realizing nuclear fusion reaction and the various methods for realizing nuclear fission reaction. Such methods cannot be granted patent rights. However, particle acceleration methods for increasing particle energy to realize nuclear transformation (such as electron traveling wave acceleration method, electron standing wave acceleration method, electron collision method, electron circular acceleration method and so on) are not methods of nuclear transformation, and

are thus patentable subject matters.

The various apparatus and devices used for realizing nuclear transformation, and the components thereof, are all patentable subject matters.

#### 4.5.2 Substances Obtained by Means of Nuclear Transformation

Substances obtained by means of nuclear transformation mainly refer to various radioisotopes manufactured or produced by accelerators, reactors, or other nuclear reaction apparatus. Such radioisotopes cannot be granted patent rights.

However, use of those isotopes and the apparatus and devices used therefor are subject matters for which patent rights may be granted.

# Chapter 2 Description and Claims

## 1. Introduction

According to Article 26. 1, any invention application shall include a description (if necessary, appended drawings are required) and its abstract, and claims. Any utility model application shall include a description (appended drawings are required) and its abstract, and claims.

The description and the claims are legal documents for setting forth an invention or utility model and for determining the extent of protection thereof.

Art. 26. 3

The description and the drawings are mainly used to set forth the invention or utility model in a manner sufficiently clear and complete, so as to enable a person skilled in the art to understand and carry out the invention or utility model.

Art. 26. 4

The claims shall be supported by the description and shall define the extent of patent protection sought for in a clear and concise manner.

According to Article 59. 1, the extent of protection of the patent right for invention or utility model shall be determined by the terms of the claims, and the description and the appended drawings may be used to interpret the content of the claims.

This Chapter is made to set forth general provisions applicable to all technical fields as to the main contents of the description and the claims and the drafting requirements thereof. For special issues concerning the description and the claims of patent applications relating to computer programs and in the field of chemistry, Chapters 9 and 10 of this Part shall apply respectively.

## 2. Description

Article 26. 3 and Rule 17 provide for the substantial contents and drafting manner of the description respectively.

### 2. 1 Requirements that the Description shall Satisfy

Article 26. 3 provides that the description shall set forth the invention or utility model in a manner sufficiently clear and complete so as to enable a person skilled in the art to carry out the invention or utility

model.

The description shall set forth the invention or utility model in a manner sufficiently clear and complete to such an extent that a person skilled in the art can carry it out. In other words, the description shall comply with the requirement of disclosing the invention or utility model sufficiently.

For the definition of the "person skilled in the art", Chapter 4, Section 2.4 of this Part shall apply.

Art. 26.3

### 2.1.1 Clarity

The contents of the description shall be clear, and specifically shall meet the following requirements:

(1) the subject matter shall be clear. The description shall, starting from the prior art, clearly set forth what the invention or utility model wants to do and how to do so as to enable a person skilled in the art to precisely understand the subject matter of the invention or utility model for which protection is sought. In other words, the description shall disclose the technical problem the invention or utility model aims to solve and the technical solution adopted to solve the problem; and state, with reference to the background art, the advantageous effects of the invention or utility model. Said technical problem, technical solution, and advantageous effects shall be adapted to one another and free of contradiction or irrelevancy; and

(2) the expression shall be precise. The description shall use terms of the technical field to which the invention or utility model pertains. The description shall precisely express the technical contents of the invention or utility model without any ambiguity or equivocation that may prevent a person skilled in the art from understanding the invention or utility model clearly and properly.

Art. 26.3

### 2.1.2 Completeness

A complete description shall include all the technical contents that are necessary for understanding and carrying out the invention or utility model.

A complete description shall include the following contents:

(1) the contents which are indispensable for the understanding of the invention or utility model, such as the description of the relevant technical field and the state of the background art and the brief description of the drawings if any;

(2) the contents that are needed for determining whether or not the invention or utility model possesses novelty, inventive step and practical applicability, such as the technical problem to be solved by the invention or utility model, the technical solution adopted to solve the problem, and the advantageous effects of the invention or utility model; and

(3) the contents that are needed for carrying out the invention or utility model, such as the mode for carrying out the technical solution adopted to solve the technical problem of the invention or utility model.

For an invention or utility model that overcomes a technical prejudice, the description shall explain why the invention or utility model is said to have overcome the technical prejudice, the difference between the new technical solution and the technical prejudice, and the technical means adopted to overcome the technical prejudice.

It should be noted that all the relevant contents that a person skilled in the art cannot obtain directly or solely from the prior art shall be described in the description.

Art. 26. 3

### 2.1.3 Enablement

The description shall enable a person skilled in the art to carry out the invention or utility model. It means that the person skilled in the art can, in accordance with the contents of the description, carry out the technical solution of the invention or utility model, solve the technical problem, and achieve the expected technical effects.

The description shall clearly set forth the technical solution of the invention or utility model, describe in detail the specific modes for carrying out the invention or utility model, and entirely disclose the technical contents necessary for understanding and carrying out the invention or utility model, to such an extent that a person skilled in the art can carry out the invention or utility model. If the examiner can reasonably doubt that the invention or utility model does not meet the requirement of sufficient disclosure, he shall invite the applicant to make a clarification.

The following are examples of the circumstances in which the technical solution described in the description is regarded as unable to be carried out due to lack of technical means to solve the technical problem:

(1) the description sets forth only a task and/or an assumption, or

simply expresses a wish and/or a result, providing no technical means that a person skilled in the art can implement;

(2) the description sets forth a technical means, but the means is so ambiguous and vague that a person skilled in the art cannot concretely implement it according to the contents of the description;

(3) the description sets forth a technical means, but a person skilled in the art cannot solve the technical problem of the invention or utility model by adopting said means;

(4) the subject matter of an application is a technical solution consisting of several technical means, but one of the means cannot be implemented by a person skilled in the art according to the contents of the description; and

(5) the description sets forth a concrete technical solution but without experimental evidence, while the solution can only be established upon confirmation by experimental result. For example, in general, the invention of a new use for a known compound requires experimental evidence in the description to validate the new use and effects thereof; otherwise, the requirement of enablement cannot be met.

Rule 17.1

### 2.2 Manner and Order of the Description

According to Rule 17, the description of a patent application for invention or utility model shall state the title of the invention or utility model, which shall be the same as appears in the request. The description shall include the following parts:

(1) technical field: specifying the technical field to which the claimed technical solution pertains;

(2) background art: indicating the background art which can be regarded as useful for the understanding, searching, and examination of the invention or utility model, and when possible, citing the documents reflecting such art;

(3) contents of the invention (or utility model): disclosing the technical problem to be solved by the invention or utility model and the technical solution adopted to solve the problem; and stating, with reference to the prior art, the advantageous effects of the invention or utility model;

(4) description of figures: where the description has appended drawings, briefly describing each figure in the drawings; and

(5) specific mode for carrying out the invention (or utility model): describing in detail the preferable mode contemplated by the ap-

plicant for carrying out the invention or utility model; where appropriate, this shall be done in terms of examples, and with reference to the drawings, if any.

Rule 17.2 The description of a patent application for invention or utility model shall be presented in the above manner and order, and each of the parts shall be preceded by a heading, unless, because of the nature of the invention or utility model, a different manner or order would result in a better understanding and a more economical presentation.

Rule 17.3 The description of the invention or utility model shall use standard terms and be in clear wording, and shall not contain such references to the claims as: "as described in claim …", nor shall it contain commercial advertising.

Rule 17.4 Where an invention application contains disclosure of one or more nucleotide or amino acid sequences, the description shall contain a sequence listing in compliance with the prescribed standard. For the submission of the sequence listing, see Chapter 1, Section 4.2 of Part I of these Guidelines.

The following is a detailed explanation of the manner and order mentioned above.

Rule 17.1

#### 2.2.1 Title

The title of the invention or utility model shall be clear and brief. It shall appear at the middle top of the first page of the main text of the description.

The title of the invention or utility model shall be made in accordance with the following requirements:

(1) the title of the invention or utility model in the description shall be the same as appears in the request. Normally a title shall contain no more than 25 Chinese characters; in particular cases, for example, for some applications in the field of chemistry, the title can be allowed to contain 40 Chinese characters at the most;

(2) it shall use technical terms generally adopted in the technical field to which the invention or utility model pertains, preferably technical terms used in the International Patent Classification, and non-technical terms shall not be used;

(3) it shall clearly, concisely, and comprehensively reflect the subject matter and the kind (product or process) of the invention or utility model for which protection is sought so as to facilitate the classification of the application. For example, if an application contains two in-

ventions, a product of zipper and a process of making the zipper, the title shall be stated as "zipper and the process for making the same"; and

(4) the title shall not contain name of person, name of place, trademark, model, name of goods, or the like, nor shall it contain commercial advertising.

Rule 17.1(1)

### 2.2.2 Technical Field

The technical field of an invention or utility model shall be the specific technical field to which the claimed technical solution of the invention or utility model pertains or is directly applied, rather than a general or adjacent technical field or the invention or utility model per se. The specific technical field usually relates to the lowest position in which the invention or utility model may be classified according to the International Patent Classification. For example, as for an invention relating to an excavator cantilever, the inventive feature of which is a change from rectangular section in the background art to elliptic section for the cantilever, the technical field to which the invention pertains may be written as "the invention relates to an excavator, especially to an excavator cantilever" (specific technical field), rather than "the invention relates to a building machine" (general technical field), or "the invention relates to elliptic section in an excavator cantilever" or "the invention relates to an excavator cantilever of an elliptic section" (the invention per se).

Rule 17.1(2)

### 2.2.3 Background Art

This part shall indicate the background art which can be regarded as useful for the understanding, searching, and examination of the invention or utility model, and when possible, cite the documents reflecting such art, especially the prior art documents which contain the technical features stated in the preamble portion of the independent claim of the invention or utility model, that is, the closest prior art documents. The documents cited in the description may be either patent documents or non-patent literature, such as periodicals, magazines, manuals, books etc. Where a patent document is cited, at least the country of origin and the publication number, and preferably the publication date, of the patent document shall be clearly indicated. Where a non-patent document is cited, the title and the detailed source of the document shall be clearly indicated.

Moreover, in this part, the problems and defects existing in the background art shall also be objectively described; however, this requirement is limited only to the problem and defect to be solved by the technical solution of the invention or utility model. Where appropriate, the reason why such problem exists and the difficulties encountered in solving the problem may also be explained.

Citation of documents shall further comply with the following requirements:

(1) the documents cited shall be publications, either in paper form, or in electronic form;

(2) for non-patent documents and foreign patent documents, the publication date shall be earlier than the filing date of the application; for Chinese patent documents, the publication date shall be no later than the publication date of the application; and

(3) where the cited document is a foreign patent or non-patent document, the source and relevant information of the cited document shall be indicated in the original language as used for its publication. If necessary, Chinese translation thereof shall be provided, and put in parentheses.

If the citation of a document satisfies the above requirements, the description of the application shall be regarded as having set forth the contents of the document. For examination as to whether such a citation meets the requirement of sufficient disclosure, see Section 2. 2. 6 of this Chapter.

Rule 17. 1(3)

### 2. 2. 4 Contents of the Invention or Utility Model

This part shall clearly and objectively describe the following contents.

(1) The technical problem to be solved

The technical problem to be solved by the invention or utility model refers to the technical problem existing in the prior art that the invention or utility model aims to solve. The technical solution set forth in a patent application for invention or utility model shall be able to solve the problem.

The technical problem that the invention or utility model aims to solve shall be described in accordance with the following requirements:

(i) directing against the defect or deficiency existing in the prior art; and

(ii) describing objectively, in positive and concise words and with good grounds, the technical problem which the invention or utility model aims to solve. The technical effect of the invention or utility model may also be mentioned.

No commercial advertising shall be used in describing the technical problem that the invention or utility model aims to solve.

The description of an application may contain one or more technical problems which the invention or utility model aims to solve, but meanwhile the technical solutions to solve these technical problems shall also be set forth in the description. Where one application contains more than one invention or utility model, all the technical problems to be solved described in the description shall be related to a single general inventive concept.

(2) Technical solution

The core of a patent application for invention or utility model is the technical solution set forth in the description.

The requirement of disclosing the technical solution adopted to solve the technical problem as provided in Rule 17.1(3) means that the technical features of the solution adopted by the invention or utility model to solve the technical problem shall be described clearly and completely. This part shall reflect at least the technical solution as in the independent claim that contains all the essential technical features, and may also reflect preferable solutions containing other additional technical features.

The technical solutions set forth in the description shall be consistent in presentation with the corresponding technical solutions defined in the claims.

Generally, this part shall first state the technical solution as in the independent claim, in terms similar to or same as those used in the independent claim, so as to express the essence of the invention or utility model in the form of aggregation of its essential technical features, and if necessary, explain the relations between the aggregation of essential technical features and the technical effects of the invention or utility model.

Then, this part may reflect preferable technical solutions with further improvements as in the dependent claims by describing the additional technical features of the invention or utility model.

Where one application contains more than one invention or utility model, the technical solution of each invention or utility model shall be

described separately.

(3) Advantageous effects

The description shall clearly and objectively state the advantageous effects of the invention or utility model as compared with the prior art.

Advantageous effects mean the effects which directly result from the technical features constituting the invention or utility model, or the effects which these technical features are bound to produce.

Advantageous effects are an important criterion for determining whether an invention represents a "notable progress", or a utility model represents a "progress".

Usually, advantageous effects may take the form of improvement in productivity, quality, precision, or efficiency, saving of energy consumption, raw material, or working procedures, simplification or convenience in processing, operation, control, or use, reparation or cure of environment pollution, or emergence of useful function, etc.

Advantageous effects may be described by way of analysis of the structural features of the invention or utility model in combination with theoretical explanation, or illustrated with reference to experimental data, rather than by just assertion that the invention or utility model possesses the advantageous effects.

However, no matter which approach is applied to explain the advantageous effects, the invention or utility model shall be compared with the prior art and the difference between the invention or utility model and the prior art shall be pointed out.

The advantageous effects of an invention or utility model in the field of mechanics or electricity may, under certain circumstances, be explained by analysis of the structural features of the invention or utility model in conjunction with their operation mode. However, for an invention in the field of chemistry, under most circumstances, it is appropriate to explain the advantageous effects with reference to experimental data rather than in the above way.

For those matters measurement of which is not available at present and the judgment of which has to rely on human sensory organs, such as taste and smell, the advantageous effects may be described by means of statistical experimental results.

Where the advantageous effects are explained by citing experimental data, necessary experimental conditions and methods shall be provided.

Rule 17.1(4)

### 2.2.5 Description of Figures

Where the description has appended drawings, it shall state the title of each figure in the drawings and briefly describe the contents as illustrated. Where there are many components or parts, the names of the specific components or parts in the drawings may be provided in the form of a list.

Where there is more than one figure in the drawings, all of the figures shall be briefly described.

For example, for a patent application entitled "an energy-saving system for coal-fired boiler", the description of which contains four figures, the figures may be described as follows:

Fig. 1 is the front view of the energy-saving system for coal-fired boiler;

Fig. 2 is a side view of said energy-saving system in Fig. 1;

Fig. 3 is the view along the direction A as shown in Fig. 2; and

Fig. 4 is the sectional view along the line B-B as shown in Fig. 1.

Rule 17.1(5)

### 2.2.6 Specific Mode for Carrying Out the Invention or Utility Model

The preferred mode for carrying out the invention or utility model is an important part of the description, which is extremely important for sufficiently disclosing, understanding, and carrying out the invention or utility model, as well as for supporting and interpreting the claims. Therefore, the description shall describe in detail the preferred mode contemplated by the applicant for carrying out the invention or utility model. Where appropriate, this shall be done in terms of examples, and with reference to the drawings, if any.

The preferred mode for carrying out the invention or utility model shall embody the technical solution adopted in the application for solving the technical problem, and shall also describe the technical features of the claims in detail so as to support the claims.

The preferred mode for carrying out the invention or utility model shall be described in such detail as to enable a person skilled in the art to carry out the invention or utility model.

Embodiments are exemplification of the preferred modes for carrying out the invention or utility model. The number of embodiments shall be determined in accordance with the nature of the invention or utility model, the technical field to which the invention or utility model

pertains, the state of the prior art, and the claimed extent of patent protection.

The description may give only one example if the example is sufficient to support the technical solution as summarized in the claims. Where a claim (especially an independent claim) covers a broad protection extent and the generalization cannot be supported by only one example, the description shall give at least two different examples to support the claimed extent of patent protection. Where the improvement of a claim compared to the background art involves a numerical range, the description shall usually give examples for the values near the both ends (preferably the both end values), and, where the range is broad, at least one example for an intermediate value.

Where the technical solution of an invention or utility model is simple, if the part of description concerning technical solution has given a clear and complete explanation of the claimed subject matter, it is not necessary to repeat the explanation in the part of description concerning specific mode for carrying out the invention or utility model.

For an invention or utility model for product, the embodiment or example shall describe the mechanical structure, electro-circuit structure, or chemical composition of the product, and illustrate the interrelations among the various parts of the product. In the case of operational product, if mere description of the structure is not sufficient to enable a person skilled in the art to understand and carry out the invention or utility model, the action process or operation steps thereof shall also be described.

For a process invention, the embodiment or example shall describe the steps of the process, including technological conditions which may be expressed by different parameters or parameter ranges.

In this part, generally the closest prior art or the technical features of the invention or utility model in common with the closest prior art may not be described in detail, but the technical features by which the invention or utility model is distinguished from the prior art and the additional technical features in the dependent claims shall be described in detail sufficient to enable a person skilled in the art to carry out the technical solutions. It should be noted that, for the convenience of examination and straightforward understanding of the invention or utility model by the public, those contents which are indispensable for the description to comply with the requirement of Article 26. 3 cannot be described by only reference to other documents, but shall be substantially

described in the description.

In description of the preferred mode for carrying out an invention or utility model with reference to the drawings, the reference numbers or symbols used shall be consistent with those appearing in the drawings and be placed after the corresponding technical terms without parenthesis. For example, a description for a circuit connection may be written as "resistor 3 is connected with capacitor 5 via the collector of transistor 4", but shall not be written as "3 is connected with 5 via 4".

Rules 17.3 &3.1

### 2.2.7 Other Requirements on Drafting of the Description

The description shall use normal terms and be clear in wording. In other words, the contents of the description shall be clear and definite and without any ambiguity, vagueness, or self-contradiction so as to facilitate the understanding by a person skilled in the art.

The description shall use the technical terms as recognized in the technical field to which the invention or utility model pertains. As for terms of natural science, where there is national standard, the standard terms shall be used. Where there is no national standard, the terms generally accepted in the art may be used, and little known or newly emerging technical terms, or the terms in loan word (in Chinese transliteration or free translation) may also be used, provided that their meanings are clear to a person skilled in the art and are not misleading. If necessary, specially formulated technical terms may be used, in which case they shall be clearly and adequately defined or explained. Generally, terms already having an established meaning in the art shall not be used to mean something different so as to avoid misunderstanding and confusion. Technical terms and symbols used in the description shall be consistent throughout.

The description shall use Chinese. However, subject to the condition that no ambiguity is caused, some particular words in a language other than Chinese may also be used. Technical term in a foreign language shall be annotated with Chinese translation or explained in Chinese where it is used in the description for the first time.

For example, expressions not in Chinese may be used under the following circumstances:

(1) for technical terms in a foreign language which are well known in the art, expression not in Chinese is accepted. For example, "EPROM" is used to mean "erasable and programmable read-only memory", and "CPU" is used to mean "central processing unit".

However, it is not allowed to use foreign technical terms continuously in one sentence which may cause the sentence difficult to understand; and

(2) for measuring units, mathematic symbols, mathematic formulas, various programming languages, computer programs, symbols with special meaning (such as GB, the abbreviation of Chinese National Standard) etc., expression not in Chinese is allowed.

Moreover, the source and title of a foreign patent document, patent application, or non-patent literature cited in the description shall be in the original language, followed by the Chinese translation put in parenthesis if necessary.

Measuring units in the description shall use the legal measuring units, including SI units and other selected units. If necessary, other measuring units well recognized in the art may be indicated in the parentheses at the same time.

Where the name of goods is inevitable in the description, the model, specification, function, and manufacturer of the same shall follow it.

The description shall avoid defining a substance or product by use of a registered trademark.

Rule 18

### 2.3 Drawings

Art. 26.3

The drawings are a component part of the description.

The function of drawings is to supplement the explanation in the text of the description with figures to enable a person to intuitively and visually understand each technical feature and the whole technical solution of the invention or utility model. For patent applications in the field of mechanics or electricity, the function of drawings is particularly outstanding. Therefore, the drawings shall clearly reflect the contents of the invention or utility model.

The description of an invention application may contain no drawings if the text of the description can set forth the technical solution of the invention in a manner sufficiently clear and complete.

Rule 17.5

The description of a utility model application shall include drawings.

Rule 18.2

Where more than one figure is included in an application, throughout the figures indicating the same embodiment, the reference sign indicating the same composite part (the same technical feature or the same object) shall be the same. The same reference sign used in the

text of the description and the drawings shall indicate the same composite part. Reference signs not mentioned in the text of the description shall not appear in the drawings. Reference signs not appearing in the drawings shall not be mentioned in the text of the description either.

Rule 18.3

The drawings shall not contain any other explanatory notes, except words which are indispensable. For drawings like flow sheets and block schematics, the necessary words or signs shall be provided in the blocks.

For requirements concerning the making of drawings, Chapter 1, Section 4.3 of Part I shall apply.

Rule 23

## 2.4 Abstract

The abstract is a summary of the contents set forth in the description. It is just a sort of technical information with no legal effect.

The contents of the abstract do not form a part of the initial disclosure of the invention or utility model. Therefore, they shall not serve as a basis for subsequent amendments to the description or claims, nor shall they be used to interpret the extent of protection of the patent right.

The abstract shall comply with the following requirements:

Rule 23.1 &.2

(1) the abstract shall indicate the title of the invention or utility model and the technical field to which the invention or utility model pertains, and shall be drafted in a way which allows the clear understanding of the technical problem, the gist of the technical solution to that problem, and the principal use(s) of the invention or utility model, wherein the main concentration shall be on the technical solution. The abstract may contain a chemical formula which best characterizes the invention;

Rule 23.2

(2) for applications with drawings, a figure which best characterizes the main technical features of the technical solution of the invention or utility model shall be provided by the applicant or designated by the examiner as the figure accompanying the abstract, and the figure accompanying the abstract shall be one of the figures in the appended drawings;

Rule 23.2

(3) the scale and the distinctness of the figure accompanying the abstract shall be as such that a reproduction with a linear reduction in size to 4cm × 6cm would still enable all details to be clearly distinguished; and

Rule 23.2

(4) the whole text (including punctuation marks) of the abstract

shall contain no more than 300 Chinese characters, and no commercial advertising shall be presented in the abstract.

Moreover, reference signs appearing in the text of the abstract shall be put in parentheses.

The above sections of this Chapter set forth detailed provisions on the substantial contents of the description and the drafting requirements thereof. It should be noted that, in substantive examination, the description being inconformity with Article 26. 3 due to insufficient disclosure is a ground for rejection according to Rule 53, while the description having mere defects of inconformity with Rule 17 is not a ground for rejection according to Rule 53. If the description has the defect of non-standard words and unclear wording which cannot prevent the invention from being carried out, the defect belongs to those set forth in Rule 17, and the examiner shall not reject the application on this ground. Furthermore, the grounds for rejection as provided in Rule 53 do not include the failure of the abstract to meet the requirements.

## 3. The Claims

Art. 26. 4

The claims shall be supported by the description and shall define the extent of patent protection sought for in a clear and concise manner.

The claims shall describe the technical features of the invention or utility model, and the technical features may be either component elements that constitute the technical solution of the invention or utility model, or the interrelations between the elements. Article 26. 4 and Rules 19-22 set forth provisions on the contents and drafting of claims.

Rule 20. 1

The claims in a patent application shall contain at least one independent claim, and may also contain dependent claims.

### 3. 1 Claims

#### 3. 1. 1 Kinds of Claims

According to their nature, claims are divided into two basic kinds, namely, claims to a physical entity and claims to an activity, which are simply referred to as product claims and process claims respectively. The first basic kind of claim includes any physical entity (product, apparatus) that is produced by a person's technical skill. The second basic kind of claim includes any activity with element of time

or process (process, use). Claims to a physical entity include claims to articles, substances, materials, tools, apparatus, and equipment etc. Claims to an activity include claims to manufacturing processes, methods of use, communication methods, processing methods, and methods of applying a product for a specific purpose, etc.

The purpose of identifying the kind of a claim is to help determine the extent of patent protection thereof. In the determination of the extent of patent protection of a claim, generally all the features in the claim shall be taken into account; however, the actual definitive effect of each feature shall finally be reflected on the subject matter of the claim. For example, where one or more technical features of a product claim cannot be clearly defined by either features of structure or features of parameter, it is allowed to define the technical features by virtue of features of process. However, the subject matter of the product claim defined by the features of process is still the product, and the actual definitive effect of the features of process depends on what impact they may impose on the claimed product per se.

For a product claim the subject matter title of which contains definition by use, the definition by use shall be taken into account in determining the extent of patent protection of the product claim. However, the actual definitive effect of the use definition shall depend on the impact it imposes on the claimed product per se. For example, a claim the subject matter title of which is a "mould for molten steel", wherein the use definition "for molten steel" has definitive effect on the subject matter "mould". Therefore "a plastic ice cube tray" with a melting point much lower than that of "mould for molten steel" would not come within the claim, because it is impossible to be used as a mould for molten steel. However, if the definition such as "used for …" has no impact on the claimed product or device per se and is only a description of the use or manner of use of the product or device, then it has no influence in determining for example whether the product or device has novelty or involves an inventive step. Another example is a "compound X for use in …". If the phrase "for use in …" has no influence on the compound X per se, then the use definition "for use in …" has no definitive effect in the determination of whether or not the compound X has novelty or involves an inventive step.

### 3.1.2 Independent Claims and Dependent Claims

Rule 20.2

An independent claim shall outline the technical solution of an

invention or utility model and state the essential technical features necessary for the solution of its technical problem.

"Essential technical features" refer to the technical features of an invention or utility model that are indispensable in solving the technical problem and the aggregation of which is sufficient to constitute the technical solution of the invention or utility model and distinguish the same over the technical solutions described in the background art.

In determining whether a certain technical feature is an essential technical feature, the examiner shall start from the technical problem to be solved and take account of the whole contents of the description, rather than simply take the technical features of an embodiment as the essential technical features.

Among the claims of a patent application, the extent of patent protection of an invention or utility model as defined in the independent claim is the broadest.

Rule 20. 3

Where one claim contains all the technical features of another claim of the same kind, and further defines the technical solution of the latter, it is a dependent claim. Since the dependent claim further defines the claim on which it depends with additional technical features, its extent of patent protection falls within that of the claim on which it depends.

An additional technical feature of a dependent claim may be a feature that further defines the technical features of the claim on which it depends, or a feature newly introduced.

The claims of a patent application shall have at least one independent claim. Where there are two or more independent claims, the one that appears first is called the first independent claim, and the others are called parallel independent claims. The examiner shall note that sometimes a parallel independent claim may also refer to a preceding independent claim, for example, "An apparatus for carrying out the process of claim 1, …", "A process for making the product of claim 1, …", "A device containing the component of claim 1, …", or "A plug for cooperation with the socket of claim 1, …". The claim of this kind is a parallel independent claim, and shall not be regarded as a dependent claim even it refers to another independent claim. In the determination of extent of patent protection for such an independent claim containing reference to another claim, all the features of the claim referred to shall be taken into account, and their actual definitive effect shall depend on what final impact they may impose on the claimed subject

matter of the independent claim.

Under some circumstances, a claim appearing in the form of dependent claim (i. e., including a reference portion as of a dependent claim) is not necessarily a dependent claim in substance. For example, claim 1 reads, "A machine tool having feature X". A following claim reads, "A machine tool according to claim 1, characterized in that feature X is replaced by feature Y". Here, the following claim is also an independent claim. The examiner shall not take a following claim as a dependent claim just from its form of drafting.

### 3.2 Requirements that the Claims shall Satisfy

Article 26.4 provides that the claims shall be supported by the description and shall define the extent of patent protection sought for in a clear and concise manner. Moreover, Rule 19.1 provides that the claims shall describe the technical features of the invention or utility model.

Art. 26.4

#### 3.2.1 Support in the Description

"The claims shall be supported by the description" means that the technical solution for which protection is sought in each of the claims shall be a solution that a person skilled in the art can reach directly or by generalization from the contents sufficiently disclosed in the description, and shall not go beyond the scope of the contents disclosed in the description.

Claims are usually generalizations from one or more embodiments or examples as set forth in the description. The generalization of a claim shall not go beyond the scope of the contents disclosed in the description. If the person skilled in the art can reasonably predict that all the equivalents or obvious variants of the embodiments set forth in the description have the same properties or uses, then the applicant shall be allowed to generalize the protection extent of the claim to cover all the equivalents or obvious variants. In determining whether the generalization of a claim is appropriate, the examiner shall refer to the relevant prior art. An invention which opens up a whole new field of technology is entitled to more generality in the claims than one that is concerned with advances in a known technology.

For claims generalized in generic terms or by parallel options, the examiner shall examine whether the generalization can be supported by the description. Where the generalization of a claim includes contents

speculated by the applicant and the effect thereof is difficult to determine or evaluate beforehand, the generalization shall be regarded as going beyond the scope of the contents disclosed in the description. If the generalization of a claim is such that the person skilled in the art can reasonably doubt that one or more specific terms or options included in the generic terms or parallel options cannot solve the technical problem aimed to be solved by the invention or utility model and achieve the same technical effects, then it shall be taken that the claim is not supported by the description. In these cases, the examiner shall raise an objection of lack of support on the ground of Article 26.4 and invite the applicant to amend the claim.

For example, considering such a broadly generalized claim as "a method of affecting substances with high frequency electric energy", if the description contains only one embodiment of "eliminating dust from gas with high frequency electric energy" without any description of methods for affecting other substances with high frequency electric energy, and a person skilled in the art is unable to determine or evaluate beforehand the effect of affecting other substances with high frequency electric energy, then the claim shall be taken as lacking support in the description.

For another example, considering another broadly generalized claim "a method for treating seeds of plant by controlling the freezing time and depth", if the description contains only method for treating the seeds of one kind of plant without involving any other kind of plant, and an artisan in horticulture is unable to determine or evaluate beforehand the effect of treating seeds of other kinds of plant by such a method, then the claim shall also be taken as lacking support in the description. Only when the general relationship between the seeds of this kind of plant and those of other kinds of plant has been indicated in the description, or sufficient embodiments have been described, so that an artisan in horticulture can understand how to use this method to treat the seeds of all kinds of plant, can the claim be regarded as having support in the description.

As for a broadly generalized claim relating to the whole class of products or machines, if it is fairly supported by the description, and there is no reason to suppose that the invention or utility model cannot be worked through the whole of the field claimed, then the claim may be acceptable even if its extent of protection is broad. However, if the information given in the description is insufficient to enable a person

skilled in the art to extend the teaching of the description to the extent of protection claimed in the claim by using routine methods of experimentation or analysis, the examiner shall invite the applicant to explain and establish that a person skilled in the art can readily extend the invention or utility model to the extent of protection claimed in the claim on the basis of the information given in the description; otherwise, the examiner shall invite the applicant to restrict the claim. For example, concerning the claim "a method for treating synthetic resin mouldings to obtain changes in characteristics", if the examples described in the description relate only to thermoplastic resins, and the applicant cannot establish that this method is also applicable to thermosetting resins, then the applicant shall restrict the claim to thermoplastic resins.

Usually, for product claims, features of function or effect shall be avoided as far as possible to be used in defining the invention. It is only when a certain technical feature cannot be defined by a structural feature, or it is more appropriate to be defined by a feature of function or effect than by a structural feature, and the function or effect can be directly and affirmatively verified by experiments or operations as stated in the description or by customary means in the art, that definition by features of function or effect in a product claim can be permissible.

Technical feature defined by function in a claim shall be construed as embracing all the means that are capable of performing the function. For claim containing a feature defined by function, whether the definition by function can be supported by the description shall be examined. If the function is carried out in a particular way in the embodiments of the description, and the person skilled in the art would not appreciate that the function could be carried out by other alternative means not described in the description, or the person skilled in the art can reasonably doubt that one or more means embraced in the definition by function cannot solve the technical problem aimed to be solved by the invention or utility model and achieve the same technical effect, then the definition by function as embracing the other alternative means or means incapable of solving the technical problem shall not be allowed in the claim.

Furthermore, if the description merely states in vague terms that other alternative means may be adopted, but the person skilled in the art cannot understand what they might be or how they might be used, then definition by function in the claims is not permitted. In addition, claim of pure functional definition cannot be supported by the description,

and therefore is not permitted.

When determining whether a claim is supported by the description, the examiner shall take into account the whole contents of the description, rather than merely the contents in the part of specific mode for carrying out the invention or utility model. If other parts of the description also include contents concerning embodiments or examples, and it can be established the generalization of the claim is appropriate viewed from the whole contents of the description, then the claim shall be considered to have support in the description.

For the claims including both independent and dependent claims or different kinds of claims, each of the claims shall be examined as to whether it is supported by the description. That an independent claim is supported by the description does not mean its dependent claims are necessarily supported by the description; that a process claim is supported by the description does not mean the product claim is necessarily supported by the description.

Where part or all of the contents of the claimed technical solution are described in the claims of the application as filed but not described in the description, the applicant is permitted to add those contents into the description. However, that the technical solution in a claim has the same wording as that in the description does not mean the claim is necessarily supported by the description. It is only when the technical solution as defined in a claim can be reached directly or by generalization by a person skilled in the art from the contents sufficiently disclosed in the description that the claim defining that technical solution can be regarded as having support in the description.

Art. 26. 4

### 3.2.2 Clarity

The clarity of the claims is of the utmost importance for the determination of the extent for which protection is sought by an invention or utility model.

The requirement that the claims shall be clear means, on the one hand, individual claims shall be clear, and on the other hand, the claims as a whole shall be clear as well.

Firstly, the category of each claim shall be clear. The title of the subject matter of a claim shall indicate clearly whether the claim is a product claim or a process claim. It is not permissible to use a vague title of subject matter, such as "A technique …", or to include both product and method in the title of subject matter of a claim, such as "A

product … and a process for making the same".

On the other hand, the title of subject matter of a claim shall also be adaptive to the technical contents of the claim.

A product claim is suitable for an invention or utility model of product, and shall usually be defined in terms of the structural features of the product. In particular cases, where one or more technical features in a product claim cannot be clearly expressed in terms of structural features, it is permissible to express them with the aid of physical or chemical parameters. Where the features cannot be clearly expressed in terms of either structural features or parameter features, it is permissible to express them with the aid of process features. When parameters are used for the expression, the parameters used must be those which can be clearly and reliably determined by a person skilled in the art according to the teachings of the description or by customary means of the relevant art.

A process claim is suitable for an invention of process, and shall usually be defined in terms of such technical features as technological process, operational conditions, steps, and procedures.

A use claim belongs to the category of process claim. However, the examiner shall pay attention to distinguishing a use claim from a product claim from the wording thereof. For example, a claim in such a form as "using compound X as an insecticide" or "the use of compound X as an insecticide" is a use claim, and belongs to process claim, while a claim in such a form as "an insecticide made of compound X" or "an insecticide containing compound X" is not a use claim but a product claim.

Secondly, the extent of protection as defined by each claim shall be clear. The extent of protection of a claim shall be construed according to the meaning of the words used in the claim. Generally, the words used in a claim shall be understood as having the meaning that they normally have in the relevant art. In particular cases, where the description explicitly gives a certain word a special meaning and, by virtue of the definition to the word in the description, the extent of protection of the claim using the word is defined sufficiently clearly, such a case is also allowed. However, in this case the examiner should also invite the applicant to amend as far as possible the claim whereby the meaning is clear from the wording of the claim alone.

Any term whose meaning is indefinite, such as "thick", "thin", "strong", "weak", "high temperature", "high pressure", "very broad

scope", etc. , shall not be used in a claim, unless the term has a well-recognized definite meaning in the particular art, such as "high frequency" in relation to an amplifier. Where the term has no well-recognized meaning, it should, if possible, be replaced by a more precise wording selected from the description.

Such expressions as "for example", "such as", "had better …", "particularly", "if necessary", and the like shall not be used in a claim, since they will define different extents of protection in a single claim, making the extent of protection thereof unclear. Where in a claim there exists a generic term being followed by a specific term introduced by one of the above expressions, the examiner shall invite the applicant to amend the claim, and it is allowed to maintain in the claim either of the terms or to define the different extents of protection in two claims with the terms respectively.

Generally, such terms as "about", "approximately", "etc. ", "or the like", and the like shall not be used in a claim, since they are likely to make the protection extent of the claim unclear. Where in a claim there exists such a term, the examiner shall make a judgment as to whether use of such term makes the claim unclear according to the specific situation, and if not, the use of such term is permitted.

Except for being used with reference signs, chemical formulae, or mathematical formulae, use of parentheses in a claim, such as "(concrete) moulded brick", shall be avoided as far as possible so as to prevent the claim from being unclear. However, bracketed expressions with a generally accepted meaning are allowable, for example "(meth) acrylate", "containing A of 10% -60% (weight)".

Finally, the claims as a whole shall be clear as well. This means that the reference relations between the claims shall be clear (see Sections 3. 1. 2 and 3. 3. 2 of this Chapter).

Art. 26. 4

### 3. 2. 3 Conciseness

The requirement that the claims shall be concise means, on the one hand, individual claims shall be concise, and on the other hand, the claims as a whole shall be concise as well. For example, in one application there should not exist two or more claims that have substantially the same extent of protection.

The number of claims shall be reasonable. It is permitted to have a reasonable number of dependent claims in the claims to define those preferable technical solutions of the invention or utility model.

The expression of the claims shall be concise. Except for the technical features, a claim shall neither contain unnecessary explanations as to the cause or reason, nor shall it contain commercial advertising.

In order to avoid undue repetition of the same content between one claim and another, where possible, the claims shall be drafted in the manner of referring to a preceding claim to the largest extent.

### 3.3 Requirements on Drafting of Claims

Each claim shall have only one full stop at its end, since the extent of protection of a claim is defined by the contents therein as a whole.

Rule 19.2

If there are several claims, the claims shall be numbered consecutively in Arabic numerals.

Rule 19.3

The technical terms used in the claims shall be consistent with those used in the description. The claims may contain chemical formulae or mathematical formulae but shall contain no drawings. Unless absolutely necessary, the claims shall not contain such expressions as "as described in … of the description", or "as shown in figure …" or the like. The situation "absolutely necessary" refers to the situation where a specific shape involved in an invention or utility model cannot be defined with words but only by drawings, in which case the phrase "as shown in figure …" or the like can be used in the claims.

Usually, a claim shall not contain table, unless using table can define the subject matter of an invention or utility model more clearly.

Rule 19.4

Technical features in a claim may cite corresponding reference signs in the drawings to facilitate the understanding of the solution as in the claim. Such reference signs shall be placed in parentheses and after the corresponding technical features. Reference signs shall not be construed as limiting the extent of protection of the claim.

Generally, a claim shall be presented in one paragraph. However, where there are many technical features, the contents and the interrelations are complicated, and it is difficult to clarify the relations by punctuation, a claim may also be presented in separate lines or several paragraphs.

Usually, an open claim should use the transition phrase of "containing", "including", or "consisting essentially of …", which shall be interpreted as including additional components or process steps non-recited in the claim is permitted. A closed claim should use the transition phrase of "consisting of …", which shall normally be interpreted as

not including any component or process step other than those set forth in the claim.

Where a claim involves a numerical range, generally the range shall be presented as far as possible in mathematical expression, such as "$\geqslant 30℃$", "$> 5$", etc. Normally, "more than", "less than", "exceed" and the like shall not be construed as including the number itself; "no less than", "no more than", "within" and the like shall be construed as including the number itself.

It is permissible to define an invention or utility model in the claims by generalization, provided that the claims are supported by the description. Generalization could be done by the following two means:

(1) by means of generic terms. For example, "gas laser" may be used to generalize over He-Ne laser, Argon ion laser, carbon monoxide laser, and carbon dioxide laser etc., "$C_1$-$C_4$ alkyl" to methyl, ethyl, propyl, and butyl groups, and "belt drive" to flat belt drive, vee belt drive, and odontoid belt drive etc.; or

(2) by means of parallel options, i. e., by connecting several parallel features with the conjunction word "or" or "and", among which at least one option must be chosen. Examples include "feature A, B, C, or D", and "a substance selected from the group consisting of A, B, C, and D".

In generalization by means of parallel options, the specific options being put in parallel shall be comparable with each other in content. A generic term cannot be connected in parallel with a specific term by the conjunction "or". Moreover, the meaning of the parallel options shall be clear. For example, in the expression "A, B, C, D, or the like (equipment, process, substance)", the meaning of the option "the like" is unclear, therefore it cannot be placed in parallel with the specific products or processes (A, B, C, D).

### 3.3.1 Requirements on Drafting of Independent Claims

In accordance with Rule 21.1, an independent claim of an invention or utility model shall contain a preamble portion and a characterizing portion, and be presented in the following form:

(1) a preamble portion: indicating the title of the claimed subject matter of the technical solution of the invention or utility model, and those technical features which are necessary for the definition of the claimed subject matter but which, in combination, are part of the most related prior art; and

(2) a characterizing portion: stating, in such words as "characterized in that ..." or in similar expressions, the technical features of the invention or utility model which distinguish it from the most related prior art. Those features, in combination with the features stated in the preamble portion, serve to define the extent of protection of the invention or utility model.

Rule 21. 3 provides that an invention or utility model shall have only one independent claim, which shall precede all the dependent claims relating to the same invention or utility model. The intention of this provision is to make the claims as a whole clearer and more concise.

In the preamble portion of an independent claim, the "technical features which are necessary for the definition of the claimed subject matter but which, in combination, are part of the most related prior art" refer to those technical features which are necessary for the definition of the claimed subject matter but which, in combination, are part of a single document of the most related prior art. Where appropriate, it is preferable to select a prior art document that is the closest to the invention or utility model to "draw a line of demarcation".

In the preamble portion of an independent claim, in addition to the title of the claimed subject matter of the technical solution of the invention or utility model, only those necessary technical features which are closely related to the technical solution of the invention or utility model and in common with the prior art need to be stated. For example, for an invention of photographic camera which substantial point is an improvement to the cloth shutter of the camera, in the preamble portion of the independent claim it needs only state "a photographic camera, including a cloth shutter ...", and there is no need to state such other common features as lens, viewfinder, or other parts of a camera. In the characterizing portion of the independent claim, the essential technical features that are distinct from those in the closest prior art shall be stated. Those distinct technical features in combination with the technical features described in the preamble portion constitute the whole essential technical features of the invention or utility model and thereby define the extent of protection of the independent claim.

The purpose for drafting an independent claim in a two-part form is to help the public understand more clearly, among all the technical features, which are the common technical features of the invention or

utility model and the closest prior art, and which are the distinct technical features of the invention or utility model from those of the closest prior art.

In accordance with Rule 21. 2, where the two-part formulation mentioned above is not appropriate to be followed because of the nature of the invention or utility model, an independent claim may be drafted not in the two-part form. Examples of this kind of invention or utility model are:

(1) an invention which opens up a whole new field;

(2) an invention of combination of several known integers of equal status, the gist of the invention lying solely in the combination;

(3) an invention of improvement over a known process, the improvement lying in omitting a certain substance or material, or substituting one substance or material for another, or omitting a certain step; and

(4) improvement over known inventions, the improvement lying in substituting a part of the known system for another or changing the interrelations thereof.

### 3.3.2 Requirements on Drafting of Dependent Claims

In accordance with Rule 22. 1, any dependent claim of an invention or utility model shall contain a reference portion and a characterizing portion, and be presented in the following form:

(1) a reference portion: indicating the serial number(s) of the claim(s) referred to and the title of the subject matter;

(2) a characterizing portion: stating the additional technical features of the invention or utility model.

Rule 22. 2

Any dependent claim shall only refer to the preceding claim or claims. Any multiple dependent claim, which refers to two or more claims, shall refer to the preceding claims in the alternative only, and shall not serve as a basis for any other multiple dependent claim, i. e. a subsequent multiple dependent claim shall not refer to a preceding multiple dependent claim.

The reference portion of a dependent claim shall indicate the serial number(s) of the claim(s) referred to, followed by the title of the subject matter of the same. For example, the reference portion of a dependent claim may be written as: “A metal fiber drawing system according to claim 1, ...”.

A multiple dependent claim is a dependent claim that refers to

two or more claims. A multiple dependent claim may refer to the preceding independent claim and dependent claims, or refer to two or more preceding dependent claims.

Where a dependent claim is a multiple dependent claim, the word "or" or a word synonymous with "or" shall be used between the serial numbers of the claims referred to in order to show the claims are referred to in the alternative. For example, the reference portion of a dependent claim may be drafted as: "… according to claim 1 or claim 2 …", "… according to claim 2, 4, 6, or 8 …"; or "… according to any one of claims 4-9 …".

A multiple dependent claim, which refers to two or more claims, shall not serve as a basis for any other multiple dependent claim. For example, if claim 3 states: "A zoom system for video camera according to claim 1 or 2, …", then a multiple dependent claim 4 as "A zoom system for video camera according to claim 1, 2, or 3 …" is not allowable, since it referred to claim 3 which is a multiple dependent claim.

The characterizing portion of a dependent claim may define the technical features of the preceding claim ( independent claim or dependent claim). Where the preceding independent claim is drafted in the two-part form, a subsequent dependent claim may further define the technical features either in its characterizing portion or in its preamble portion.

All the dependent claims that depend directly or indirectly on a certain independent claim shall be grouped together after the independent claim and before another independent claim.

# Chapter 3 Novelty

## 1. Introduction

In accordance with Article 22. 1, any invention or utility model for which patent right may be granted must possess novelty, inventive step, and practical applicability. Therefore, novelty is one of the essential requirements to be satisfied for an invention or utility model application to be granted a patent right.

Art. 22. 2

## 2. Concept of Novelty

Novelty means that, the invention or utility model does not form part of the prior art, nor has any entity or individual filed previously before the date of filing with the Patent Office an application relating to the identical invention or utility model disclosed in patent application documents published or patent documents announced on or after said filing date.

### 2.1 Prior Art

According to Article 22. 5, the prior art means any technology known to the public before the date of filing in China or abroad. The prior art includes any technology which has been disclosed in publications in China or abroad, or has been publicly used or made known to the public by any other means in China or abroad, before the date of filing (or the priority date where priority is claimed).

The prior art shall be the technical contents that are available to the public before the date of filing. In other words, the prior art shall be in such a state that it is available to the public before the date of filing and shall contain such contents from which the public can obtain substantial technical knowledge.

It should be noted that technical contents in the state of secrecy are not part of the prior art. The state of secrecy includes not only the situation where the obligation to keep secret arises from regulations or agreements regarding confidences but also the situation where the obligation to keep secret arises from social customs or commercial practices, that is, from implicit agreements or understandings.

However, if a person having the obligation to keep secret

breaches the regulation, agreement, or implicit understanding, rendering the technical contents disclosed and making the technologies available to the public, these technologies shall form part of the prior art.

### 2.1.1 Temporal Demarcation

As regards an invention or utility model application, the temporal demarcation of prior art is its filing date or the priority date where applicable. Broadly speaking, all of the technical contents disclosed before the filing date are within the scope of prior art; however, those disclosed on the filing date are not.

### 2.1.2 Means of Disclosure

The means of disclosure of prior art includes disclosure by publications, disclosure by use, and disclosure by other means, without limitation on territory.

#### 2.1.2.1 Disclosure by Publications

Publications in the context of the Patent Law mean the independently existing disseminating carriers of technical or designing contents, which shall indicate or have other evidence to prove the date of public issue or publication.

Publications of the above definition can be various printed or typed paper documents, such as patent documents, scientific and technological magazines and books, academic theses, specialized documents, textbooks, technical manuals, officially published proceedings or technical reports, newspapers, sample books, product catalogues, and advertisement brochures etc. They can also be audio or video materials made by electric, optic, magnetic, or photographic means, such as microfiches, films, negative films, videotapes, tapes, gramophone records, CD-ROMs, etc. Furthermore, they can be materials in other forms, such as those on the Internet or in other online databases.

The determination of whether a document is a publication shall not be affected by the place or language of issue, the manner of acquisition, or its age. The amount of distribution, whether it has been read, or whether the applicant is aware of it is of no relevance either.

As for the publications with the words "Internal Materials" or "Restricted Publication" or other similar wording, if they were really distributed in a restricted scope and required to be kept confidential, they are not regarded as publications in the context of the Patent Law.

The printing date of a publication is regarded as the date of disclosure, except where the date of disclosure can be evidenced otherwise. Where only a specific month or year is indicated as the printing date, the last day of the month or year shall be regarded as the date of disclosure.

If the examiner doubts the date of disclosure of a publication, he may invite the person who submitted the publication to furnish evidence.

#### 2.1.2.2 Disclosure by Use

Disclosure by use means that by use the technical solution is disclosed or placed in the state of being available to the public.

Means of disclosure by use include making, using, selling, importing, exchanging, presenting, demonstrating, exhibiting and the like that can make the technical content available to the public. So long as by the above means the relevant technical content is placed in such a state that the public can know it if they wish, disclosure by use can be established, and it is of no relevance whether the public had actually known it. However, if at an exhibition or demonstration of a product no explanation of the technical contents thereof is provided so that the structure and function or composition of the product is not known to a person skilled in the art, the exhibition or demonstration does not constitute a disclosure by use.

Where disclosure by use is concerned with a product, it can be established even if the product or device used needs to be destroyed to get its structure and function known. Moreover, disclosure by use also includes disclosure on an exhibition stand or in a shop window of informative materials that are readable by the public or directly visible materials, such as posters, drawings, photographs, specimens, and samples.

The date on which the product or process is available to the public shall be regarded as the date of disclosure by use.

#### 2.1.2.3 Disclosure by Other Means

Disclosure by other means mainly refers to oral disclosure etc.. Examples include talking, reporting, speaking at symposium, broadcasting, televising, and cinematographing that make the technical contents known to the public. For contents of talking, reporting, or speaking at symposium, the date of action shall be regarded as the date of disclosure.

For contents of broadcasting, televising, or cinematographing that can be received by the public, the date of broadcast or showing shall be regarded as the date of disclosure.

### 2.2 Conflicting Applications

In accordance with Article 22.2, when novelty of an invention or utility model application is examined, the applications relating to the identical invention or utility model which have been filed by any entity or individual prior to the filing date of the application being examined with the Patent Office and published or announced on or after said filing date, will take away the novelty of the application being examined. During examination of novelty, for the sake of convenience, this kind of application that are prejudicial to the novelty of the application being examined are called "conflicting applications".

When conducting a search to determine whether there exists a conflicting application, the examiner shall note that not only the claims but also the description (including drawings) of the earlier patent or patent application shall be consulted, that is, the whole contents thereof shall be taken into account.

A conflicting application can also be an international application entering the Chinese national phase that was filed previously by any entity or individual, published or announced by the Patent Office on or after the filing date of the application being examined, and is for an identical invention or utility model.

It should be noted that conflicting applications refer to the applications for the identical invention or utility model filed previously before but not on the filing date of the application being examined.

### 2.3 Reference Documents

The relevant documents cited for determining whether an invention or utility model has novelty or inventive step, including patent and non-patent documents, are generally called "reference documents".

Since in the substantive examination stage the examiner normally does not know the technologies disclosed by use or made known to the public by other means in China or abroad, the reference documents cited in this stage are mainly publications.

The reference documents cited may be either one document or several documents. The contents cited may be either the whole contents of each document, or partial contents thereof.

Reference documents are objectively existing technical materials. When a reference document is cited to judge novelty and inventive step of an invention or utility model, the technical contents disclosed in the reference document shall be based upon. Said technical contents include not only those technical contents expressly described in the reference document but also those implied technical contents that can be derived directly and unambiguously from the disclosure by a person skilled in the art. However, it is not allowable to broaden or narrow the contents of the reference document at will. Where a reference document has drawings, the drawings may also be cited. However, when citing the drawings, the examiner shall note that only those technical features that can be derived directly and unambiguously from the drawings belong to the contents of disclosure. The contents inferred from the drawings, and the dimensions with their relations measured from the drawings without any written description cannot be taken as the contents of disclosure.

## 3. Examination of Novelty

The determination of whether an invention or utility model application has novelty needs to be made only after its practical applicability has been confirmed.

### 3.1 Principles of Examination

The following principles shall be complied with during the examination of novelty.

(1) Identical inventions or utility models

Comparing the application being examined with the relevant contents of the prior art or of the applications for invention or utility model filed previously by any entity or individual with the Patent Office and published or announced on or after the filing date of the application being examined (hereafter "previously filed and later published or announced" application), if their technical fields, technical problems to be solved, technical solutions, and their expected effects are substantially the same, they shall be regarded as identical inventions or utility models. It should be noted that, in determining the novelty of an application, the examiner shall first of all determine whether the technical solution of the application being examined is substantially the same as that of the reference document. When an application is compared with the contents disclosed in a reference document, if the technical solution

defined in a claim therein and the technical solution disclosed in the reference document are substantially the same, and the person skilled in the art from the solutions can conclude that both of them can be applied to the same technical field, solve the same technical problem, and have the same expected effects, then they can be regarded as identical inventions or utility models.

(2) Separate comparison

When determining novelty, the examiner shall compare each claim of the application separately with the relevant technical contents disclosed in each item of the prior art or each previously filed and later published or announced invention or utility model, rather than with a combination of the contents disclosed in several items of the prior art or several previously filed and later published or announced applications or with a combination of several technical solutions disclosed in one reference document. That is, the principle of separate comparison shall be applied in the determination of novelty of an invention or utility model application, which is different from the approach to the determination of inventive step of an invention or utility model application (see Chapter 4, Section 3.1 of this Part).

### 3.2 Criterion for Examination

Article 22.2 shall serve as the criterion for judging whether an invention or utility model possesses novelty.

Several circumstances that often arise in the judgment of novelty are provided here to facilitate the understanding of this criterion.

#### 3.2.1 Invention or Utility Model with Identical Contents

Where the claimed invention or utility model is completely identical with the technical contents disclosed in a reference document, or there are only simple changes in wording between them, the invention or utility model does not possess novelty. Furthermore, the meaning of "identical contents" shall be construed as including the technical content directly and unambiguously derivable from the reference document. For example, a claim of an invention application is "a core of a motor rotor made of Nd-Fe-B permanent magnet alloy having a tetragonal crystal structure and a main phase of $Nd_2Fe_{14}B$ intermetallic compound". If a reference document discloses "a core of a motor rotor made of Nd-Fe-B magnet", the claim will lose novelty, since it is well known to a person skilled in the art that the so-called "Nd-Fe-B

magnet" means the Nd-Fe-B permanent magnet alloy having a main phase of $Nd_2Fe_{14}B$ intermetallic compound and a tetragonal crystal structure.

### 3.2.2 Specific (Lower Level) Term and Generic (Upper Level) Term

If, when the claimed invention or utility model is compared with a reference document, the difference between them lies merely in the fact that a technical feature of the same nature is defined in a generic (upper level) term in the former and in a specific (lower level) term in the latter, then the disclosure in the specific (lower level) term takes away the novelty of the invention or utility model defined in the generic (upper level) term. For example, a product "made of copper" disclosed in a reference document takes away the novelty of an invention or utility model for the same product "made of metal". However, the disclosure of the product made of copper does not take away the novelty of an invention or utility model for the same product made of other specific metal.

On the other hand, the disclosure in generic (upper level) term does not take away the novelty of an invention or utility model defined in specific (lower level) term. For example, a product "made of metal" disclosed in a reference document does not take away the novelty of an invention or utility model for the same product "made of copper". For another example, if the difference between the claimed invention or utility model and a reference document lies merely in that "chlorine" is used in the invention or utility model to replace "halogen" or another specific halogen "fluorine" in the reference document, the disclosure of "halogen" or "fluorine" in the reference document does not take away the novelty of the invention or utility model which is defined by "chlorine".

### 3.2.3 Direct Substitution of Customary Means

If the difference between the claimed invention or utility model and a reference document is merely a direct substitution of customary means employed in the art, the invention or utility model does not possess novelty. For example, if a reference document disclosed a device using screw fastening, and the claimed invention or utility model only replaces the screw fastening with bolt fastening, the invention or utility model does not possess novelty.

### 3.2.4 Numerical Value and Numerical Range

If the claimed invention or utility model has a technical feature defined by numerical values or a continuous numerical range, such as the dimensions of a component, temperature, pressure, and the content of components in a composition, while all other technical features are identical with those in the reference document, then the determination of novelty shall be conducted according to the following rules.

(1) Where the values or numerical range disclosed in the reference document fall entirely within the range of the above-defined technical feature, the reference document deprives the claimed invention or utility model of novelty.

Example 1: the application claims a copper-based shape memory alloy, comprising 10-35% (weight) zinc, 2-8% (weight) aluminum, and copper as the remainder. If the reference document discloses a copper-based shape memory alloy comprising 20% (weight) zinc and 5% (weight) aluminum, it takes away the novelty of said claim.

Example 2: the application claims a trolley oven for heat treatment, wherein its arch liner has a thickness of 100-400 mm. If the reference document disclosed a trolley oven for heat treatment in which the arch liner has a thickness of 180-250 mm, it takes away the novelty of said claim.

(2) Where the numerical range disclosed in the reference document and the numerical range of the above-defined technical feature partially overlap with each other or have at least a common end point, the reference document deprives the claimed invention or utility model of novelty.

Example 1: the application claims a process for making silicon nitride ceramics, wherein the calcination time is 1-10 hours. If the reference document disclosed a process for making silicon nitride ceramics wherein the calcination time is 4-12 hours, since the two ranges overlap each other in the calcination time of 4-10 hours, the reference document takes away the novelty of said claim.

Example 2: the application claims a process for plasma-sprayed coating, wherein the power of the spray gun is 20-50 kW during coating. If the reference document disclosed a plasma-sprayed coating process wherein the power of the spray gun is 50-80 kW during coating, since the two ranges have a common end point 50 kW, the reference document takes away the novelty of said claim.

(3) The two end points of the numerical range disclosed in the reference document take away the novelty of the invention or utility model in which the above-defined technical feature has discrete numerical values including one of said two end points, but does not take away the novelty of the invention or utility model in which the above-defined technical feature is a numerical value at any point between said two end points.

Example: the application claims a process for making titanium dioxide photocatalyst, wherein the drying temperature is 40℃, 58℃, 75℃, or 100℃. If the reference document disclosed a process for making titanium dioxide photocatalyst wherein the drying temperature is 40-100℃, it takes away the novelty of said claim in the case that the drying temperature is 40℃ or 100℃, but does not take away the novelty of said claim in the case that the drying temperature is 58℃ or 75℃.

(4) Where the numerical values or numerical range of the above-defined technical feature fall within the range disclosed in the reference document and do not have any common end point with it, the reference document dose not take away the novelty of the claimed invention or utility model.

Example 1: the application claims a piston ring for internal combustion engine, wherein the diameter of the piston ring is 95 mm. If the reference document disclosed a piston ring of 70-105 mm in diameter used in internal combustion engine, it does not take away the novelty of said claim.

Example 2: the application claims an ethylene-propylene copolymer, wherein the polymerization degree is 100-200. If the reference document disclosed an ethylene-propylene copolymer in which the polymerization degree is 50-400, it does not take away the novelty of said claim.

For amendments to numerical ranges, Chapter 8, Section 5. 2 of this Part shall apply. For examination of novelty of compounds described by formula, Chapter 10, Section 5. 1 of this Part shall apply.

### 3. 2. 5 Product Claims Including Feature of Performance, Parameters, Use, or Manufacturing Process

For examination of novelty of the product claims including feature of performance, parameters, use, or manufacturing process, the following rules shall be followed.

(1) Product claims including feature of performance or parameters

For this kind of claims, the examiner shall consider whether the feature of performance or parameters in a claim implies that the claimed product has a certain particular structure and/or composition. If the performance or parameters implies that the claimed product has a structure and/or composition distinct from that of the product disclosed in the reference document, the claim has novelty. On the other hand, if the person skilled in the art from the performance or parameters cannot distinguish the claimed product from that disclosed in the reference document, it can be presumed that the claimed product is identical with the product in the reference document and accordingly the claim does not have novelty, unless the applicant can, based on the application or the prior art, prove that the claimed product having the feature of performance or parameters is distinct from the product in the reference document in structure and/or composition. For example, an application claims a compound A in a crystalline state defined by a variety of parameters including X-diffraction data, and the reference document also disclosed a compound A in a crystalline state. If the crystalline state of the both cannot be distinguished from each other based on the disclosure of the reference document, it can be presumed that the claimed product is identical with the product in the reference document and accordingly the claim does not have novelty as compared with the reference document, unless the applicant can, based on the application or the prior art, prove that the claimed product is actually distinct in crystalline state from the product disclosed in the reference document.

(2) Product claims including feature of use

For this kind of claims, the examiner shall consider whether the feature of use in a claim implies that the claimed product has a certain particular structure and/or composition. If the use is fully determined by the inherent property of the product and does not imply any change in the structure and/or composition of the product, the product claim defined by this use feature does not have novelty as compared with the product in the reference document. For example, comparing an invention of antiviral compound X with compound X as a catalyst disclosed in a reference document, although the use of compound X has been changed, the chemical formula which determines its inherent property has no change, therefore the invention of antiviral compound X does not have novelty. However, if the use implies that the claimed product has a certain particular structure and/or composition, that is, the use

indicates that the structure and/or composition of the product has changed, then the use as a definitive feature of the structure and/or composition of the product must be considered. For example, "a hook for crane" means a hook having the structure specifically suitable for a crane in size and strength. It is distinct in structure from "a hook for angling" which has the same shape but is used for fishing. Therefore they shall be considered as different products.

(3) Product claims including feature of manufacturing process

For this kind of claims, the examiner shall consider whether the feature of manufacturing process results in a certain particular structure and/or composition of the product. If the person skilled in the art can conclude that the process will necessarily result in a product having a particular structure and/or composition different from that of the product in the reference document, the claim has novelty. On the other hand, if the claimed product, as compared with the product in the reference document, has the same structure and composition despite the different manufacturing process, the claim does not have novelty, unless the applicant can, based on the application or the prior art, prove that the process results in a product having a different structure and/or composition, or having a different performance thereby indicating that its structure and/or composition has changed. For example, an application claims a glass cup made by process X, and a reference document disclosed a glass cup made by process Y. If the glass cups made by the both processes respectively have the same structure, shape, and constituent material, the claim does not have novelty. On the other hand, if the process X comprises a step of annealing at a particular temperature not disclosed in the reference document, which considerably increases the breaking resistance of the glass cup so made as compared with that in the reference document, then it indicates the claimed glass cup has a different microstructure due to the different manufacturing process, and has an internal structure different from that in the reference document, therefore the claim has novelty.

The rules in the above Sections 3.2.1 to 3.2.5 also apply to the determination of whether these kinds of features are identical during the examination of inventive step.

## 4. Right of Priority

According to Article 29, where, within twelve months from the date on which any applicant first filed in a foreign country an

invention or utility model application, he files in China an application for the same subject matter, he may, in accordance with any agreement concluded between said foreign country and China, or in accordance with any international treaty to which both countries are party, or on the basis of the principle of mutual recognition of the right of priority, enjoy a right of priority. Such kind of right of priority is called right of foreign priority.

Art. 29. 2; Rule 32

Where, within twelve months from the date on which any applicant first filed in China an invention or utility model application, he files with the Patent Office an invention or utility model application for the same subject matter on the basis of the previous invention application, or he files with the Patent Office a utility model or invention application for the same subject matter on the basis of the previous utility model application, he may enjoy a right of priority. Such kind of right of priority is called right of domestic priority.

Art. 29. 1

## 4. 1 Right of Foreign Priority

### 4. 1. 1 Conditions of Entitlement to Right of Foreign Priority

A patent application that can enjoy a right of foreign priority shall meet the following conditions:

(1) after having for the first time filed in a foreign country a patent application for an invention-creation (hereinafter first foreign application), the applicant files in China a patent application for the same subject matter (hereinafter subsequent application filed in China);

(2) so far as an invention or utility model is concerned, the filing date of the subsequent application filed in China shall be no later than twelve months from the filing date of the first foreign application; and

(3) the foreign country or intergovernmental organization where the applicant first filed the application has an agreement concerning priority with China, or is a party to an international treaty governing priority to which China is also a party, or recognizes the right of priority from China.

The entitlement of an invention-creation to a foreign priority right has no relevance with the final examination result of the first foreign application. So long as the filing date of the first foreign application has been established in the relevant foreign country or intergovernmental organization, that application can be used as the basis for claiming foreign priority.

### 4.1.2 Definition of Invention-Creation for the Same Subject Matter

An invention or utility model for the same subject matter as referred to in Article 29 means an invention or utility model of which the technical field, technical problem to be solved, technical solution, and prospective effect are the same as those of the first application respectively. It should be noted that the term "same" herein does not mean that the wording or manner of description is exactly the same.

The examiner shall note that the technical solution defined in the claims of the subsequent application filed in China may enjoy the right of priority of the first foreign application so long as it has been described in that foreign application. It is not necessary for said technical solution to be contained in the claims of that first foreign application (for verification of right of priority, Chapter 8, Section 4.6 of this Part shall apply).

### 4.1.3 Effect of Right of Foreign Priority

Where, after having filed for the first time an application in a foreign country, the applicant files in China a patent application for an invention-creation of the same subject matter within the prescribed priority period, the subsequent application filed in China will be regarded as if it had been filed on the same date as the first foreign application. Consequently, the subsequent filing in China shall not be invalidated by reason of such acts accomplished in the priority period, that is, the period between the filing date of the first foreign application and that of the subsequent application filed in China, as another filing for the same subject matter by any entity or individual, or the publication or exploitation of the invention-creation.

Furthermore, during the priority period, any entity or individual may file a patent application for the same subject matter. Because of the effect of the right of priority, no patent right shall be granted to such an application. That is to say, due to the existence of the first foreign application which is the basis of foreign priority, the patent application for the same subject matter filed by any entity or individual between the filing date of the first foreign application and that of the subsequent application filed in China cannot be granted for a patent right because of lack of novelty.

### 4.1.4 Foreign Multiple Priorities and Foreign Partial Priority

In accordance with Rule 32.1, an applicant may claim one or more priorities in one application. Where multiple priorities are claimed, the priority period for the application shall be calculated from the earliest priority date.

The rules governing foreign multiple priorities and foreign partial priority are illustrated in the following.

(1) Any patent application claiming multiple priorities shall meet the requirement of unity as provided for in Article 31 and Rule 34.

(2) The first foreign applications serving as bases of the multiple priorities might be filed in different countries or inter-governmental organizations. For example, a subsequent application filed in China sets forth two technical solutions A and B, wherein solution A was described in an application first filed in France, solution B was described in an application first filed in Germany, and both the applications were filed within twelve months before the filing date of the subsequent application filed in China. Under such circumstance, the subsequent application filed in China may enjoy multiple priorities, i. e., solution A may enjoy the priority date of the French application and solution B may enjoy the priority date of the German application. If the solutions A and B are in the alternative and connected by the word "or" and claimed in one claim of the subsequent application filed in China, the subsequent application filed in China may also enjoy the multiple priorities, that is, having different priority dates. However, if the technical solution described in the subsequent application filed in China is a combination of different technical features described respectively in two or more first foreign applications, the subsequent application filed in China cannot enjoy a right of priority. For example, the technical solution described in the subsequent application filed in China is a combination of technical feature C described in one first foreign application and technical feature D described in another first foreign application, and the technical solution containing both features C and D has never been described in the two first foreign applications, the subsequent application filed in China cannot enjoy the right of foreign priority on the basis of the each first foreign application.

(3) The application claiming right of foreign priority may, in addition to the technical solutions described in the application as the basis of the right of foreign priority, contain one or more new technical

solutions as well. For example, in a subsequent application filed in China, in addition to the technical solution described in the first foreign application, a new technical solution which further improves or perfects said solution has also been described, such as by adding a dependent claim which reflects a new embodiment or example in the description, or by adding an independent claim meeting the requirements of unity. Under such circumstance, the examiner shall not deny the right of priority or reject the application just on the ground that the technical solution added in the claims of the subsequent application filed in China was not described in the first foreign application, but acknowledge the right of priority for the invention-creation on the same subject matter as in the first foreign application, taking the filing date of the first foreign application (i. e., the priority date) as the filing date, and for other inventions-creations, take the filing date of the subsequent application filed in China as the filing date. Because parts of the technical solutions of the subsequent application filed in China are entitled to the right of foreign priority, it is called foreign partial priority.

Art. 29. 2

## 4.2 Right of Domestic Priority

### 4.2.1 Conditions of Entitlement to Right of Domestic Priority

A patent application that can enjoy the right of domestic priority shall meet the following conditions:

(1) the application shall be an invention or utility model application;

(2) after having filed for the first time an invention or utility model application in China (hereinafter first Chinese application), the applicant files another patent application for the same subject matter with the Patent Office (hereinafter subsequent application filed in China); and

(3) the filing date of the subsequent application filed in China shall be no later than twelve months from the filing date of the first Chinese application.

Rule 32. 2

However, if the subject matter of the first Chinese application falls into any of the following circumstances, it cannot be taken as the basis for claming domestic priority:

(1) where the applicant has claimed foreign or domestic priority, unless the claim for foreign or domestic priority was not successful;

(2) where it has been granted a patent right;

(3) where it is the subject matter of a divisional application filed under Rule 42.

It should be noted that where a domestic priority is claimed, the first Chinese application as the basis of the domestic priority shall be deemed withdrawn as from the date on which the subsequent application is filed.

### 4.2.2 Definition of Invention or Utility Model for the Same Subject Matter

In this regard, Section 4.1.2 of this Chapter shall apply.

### 4.2.3 Effect of Right of Domestic Priority

In this regard, the relevant provisions of Section 4.1.3 of this Chapter shall apply *mutatis mutandis*.

### 4.2.4 Domestic Multiple Priorities and Domestic Partial Priority

Rule 32.1 is applicable not only to foreign but also to domestic multiple priorities. The rules governing domestic multiple priorities and domestic partial priority are illustrated in the following.

(1) Any patent application claiming multiple priorities shall meet the requirement of unity as provided for in Article 31 and Rule 34.

(2) If the subsequent application filed in China describes several technical solutions, for example, it describes three technical solutions A, B, and C which have been described respectively in three first Chinese applications, then the subsequent application filed in China may claim multiple priorities, that is, the technical solutions A, B, and C may respectively take the filing dates of the three first Chinese applications as their priority dates.

(3) If the subsequent application filed in China describes technical solution A and embodiments $a_1$, $a_2$ and $a_3$, wherein only embodiment $a_1$ has been described in the first Chinese application, then in the subsequent application filed in China only embodiment $a_1$ may enjoy the domestic priority, while technical solution A and embodiments $a_2$ and $a_3$ cannot enjoy the domestic priority.

(4) If the subsequent application filed in China describes technical solution A and embodiments $a_1$ and $a_2$, wherein technical solution A and embodiment $a_1$ have been described in the first Chinese application, then in the subsequent application filed in China technical

solution A and embodiment $a_1$ may enjoy the domestic priority, while embodiment $a_2$ cannot enjoy the domestic priority.

It should be noted that the above paragraph refers to the situation where the extent of protection for technical solution A cannot be fully supported by only embodiment $a_1$ and thus the applicant may supplement embodiment $a_2$ to support solution A. However, if embodiment $a_2$ forms part of the prior art when the subsequent application is filed in China, then it shall be deleted and the extent of protection for technical solution A shall be limited to the extent that can be supported by only embodiment $a_1$.

(5) If, after a first subsequent application was filed in China following the first Chinese application, the applicant filed a second subsequent application in China, and the first Chinese application describes only technical solution $A_1$, the first subsequent application describes technical solutions $A_1$ and $A_2$ wherein $A_1$ enjoys the priority of the first Chinese application, and the second subsequent application describes technical solutions $A_1$, $A_2$, and $A_3$, then, in the second subsequent application, technical solution $A_2$ may enjoy the priority of the first subsequent application, and technical solution $A_1$ cannot claim the priority of the first subsequent application since the latter has already enjoyed a right of priority, but it may nevertheless claim the priority of the first Chinese application.

**5. Grace Period for Non-Prejudicial Disclosures**

Article 24 provides that an invention-creation for which a patent application is applied does not lose its novelty where, within six months before the date of filing, one of the following events occurred:

Rules 30.1 & .2

(1) where it was first exhibited at an international exhibition sponsored or recognized by the Chinese Government;

(2) where it was first made public at a prescribed academic or technological meeting;

(3) where it was disclosed by any person without the consent of the applicant.

For examination regarding the above three circumstances, Chapter 1, Section 6.3 of Part I shall apply.

An invention-creation for which a patent application is applied does not lose its novelty where, within six months before the date of filing, any of the events prescribed in Article 24 occurred. In other words, even if any of these events occurred, the relevant

inventioncreation does not form part of the prior art to said application. That period of six months is called the "grace period".

The effect of grace period is different from the effect of priority. The grace period means that some kinds of disclosure are merely regarded as non-prejudicial to the novelty and inventive step of the application, including some disclosure by the applicant (including inventor) and some disclosure by a third person who got knowledge of the invention-creation from the applicant or inventor by legal or illegal means. Actually, an invention-creation will form part of the prior art once it was disclosed, but the above kinds of disclosure in a certain period are regarded as non-prejudicial to the application, that is, not forming part of the prior art that may affect the novelty and inventive step of the application. Nevertheless, it does not mean the date of disclosure of the invention-creation is regarded as the filing date of the application. Therefore, if any third person makes an identical invention-creation independently during the period from the date of disclosure to the date of filing and files a patent application earlier than the application by the applicant, then, according to the principle of first-to-file, the applicant cannot get the patent right. On the other hand, the application by the third person does not have novelty and cannot be granted patent right, due to the disclosure of the invention-creation by the applicant (including inventor) which makes the invention-creation form part of the prior art to the application by the third person.

If, within six months from the date on which any of the events described in Article 24 occurred and before the applicant files the application, the invention-creation was disclosed once again, provided that the disclosure does not belong to any of the prescribed events, the later disclosure will take away the novelty of the application. If the later disclosure also falls into any of the three prescribed events, the application does not lose novelty because of this later disclosure, but the grace period shall be calculated from the date of the first disclosure.

Rule 30.4

Where a patent application falls into the circumstance as prescribed in Article 24(3), the Patent Office may, when it deems necessary, require the applicant to submit relevant certifying documents to prove the date on which the event occurs and the substantial contents of the disclosure.

Rule 30.5

Where the applicant fails to make a declaration and submit certifying documents as required in Rule 30.3 (see also Chapter 1, Section

6.3 of Part Ⅰ), or fails to submit certifying documents within the specified time limit as required in Rule 30.4, the application cannot enjoy the grace period of novelty as provided for in Article 24.

When a dispute arises as to the application of Article 24, the party claiming for its applicability shall bear the burden of proof or make a convincing explanation.

Art. 9

## 6. Handling of Identical Inventions-Creations

Article 9 provides that, for any identical invention-creation, only one patent right shall be granted. Where two or more applicants have separately filed patent applications for an identical invention- creation, the patent right shall be granted to the applicant whose application was filed first.

These provisions thus establish the principle of non-double-patenting. The purpose of preventing duplicate patent rights being granted to an identical invention-creation is to prevent interference between patent rights.

As for invention or utility model, "identical invention-creation" referred to in Article 9 and Rule 41 means claims which exist in two or more applications or patents, and have the same extent of patent protection.

Where there is an earlier application constituting a conflicting application or, after disclosure, constituting part of the prior art, the later application (or patent) shall be examined in accordance with Article 22.2 or Article 22.3, rather than in accordance with Article 9.

### 6.1 Principles of Determination

Article 59.1 provides that the extent of protection of the patent right for invention or utility model patent shall be determined by the terms of the claims. The description and the appended drawings may be used to interpret the content of the claims. For avoidance of double patenting, in determining whether two invention or utility model applications or patents are identical, the examiner shall compare the contents of the claims thereof with each other, rather than compare the claims of one with the complete disclosure of the other.

In the determination of identical inventions-creations, if the extent of protection of a claim in one application or patent is identical with that of a certain claim in the other application or patent, it shall be concluded that the both are identical inventions-creations.

Where the contents of the descriptions of two applications or patents are identical, but the extents of protection of their claims are different, it shall be concluded that the two claimed inventions-creations are not identical. For example, where the same applicant filed two applications the descriptions of which all contain a product and a process to produce the product, if the claims of one application claim the product and the claims of the other claim the process, the inventions-creations claimed in the two applications shall be regarded as different. It shall be noted that, where the extents of protection of the claims of two inventions-creations partially overlap with each other, the inventions-creations shall not be regarded as identical. For example, where the claim of an application includes a technical feature defined by continuous numerical range, if the continuous numerical range is not completely the same as that in the claim of another invention or utility model application or patent, the two applications shall not be regarded as identical inventions-creations.

### 6.2 Method of Handling

#### 6.2.1 Handling of Two Applications

##### 6.2.1.1 By the Same Applicant

Where, during examination, it is found that the same applicant has filed two patent applications for an identical invention-creation on the same day (the date of filing, or the priority date where priority is claimed), and these two applications have met all the other conditions for patentability, the examiner shall notify the applicant of making a choice or amendments with respect to the two applications respectively. If the applicant fails to make any response within the specified time limit, the corresponding application shall be deemed to have been withdrawn. If the applications are still not in conformity with Article 9.1 after the applicant has made observations or amendments, both of the applications shall be rejected.

##### 6.2.1.2 By Different Applicants

Where, during examination, it is found that different applicants have separately filed a patent application for an identical invention-creation on the same day (the date of filing, or the priority date where priority is claimed), and these applications have met all the other

conditions for patentability, the examiner shall notify, in accordance with Rule 41. 1, the applicants to carry on negotiations among themselves to decide who shall be the applicant. If an applicant fails to make any response within the specified time limit, the corresponding application shall be deemed to have been withdrawn. If no agreement is made after the negotiation, or, after the applicants have made their observations or amendments, the applications are still not in conformity with Article 9. 1, all of the applications shall be rejected.

### 6. 2. 2 Handling of One Application and One Patent

Where, during the examination of a patent application, it is found that another patent application filed by the same applicant for the identical invention-creation on the same day (the date of filing, or the priority date where priority is claimed) has been granted a patent right, and the application being examined has met all the other conditions for patentability, the applicant shall be notified to make amendments. If the applicant fails to make any response within the specified time limit, the application shall be deemed to have been withdrawn. If the application is still not in conformity with Article 9. 1 after the applicant has made observations or amendments, it shall be rejected.

Art. 9. 1 & Rule 41. 2

However, where an applicant files on the same day (means the date of filing) applications for both patent for utility model and patent for invention relating to the identical invention-creation, if the patent for utility model has been granted and does not terminate, and the applicant has stated the fact respectively upon filing the applications, double patenting may be avoided by amending the invention application, or alternately by abandoning the patent for utility model. Therefore, during the examination of the invention application mentioned above, if the invention application has met all the other conditions for patentability, the applicant shall be notified to make a choice or make amendments. Where the applicant chooses to abandon the patent for utility model which has been granted, he shall submit a written declaration to abandon the patent for utility model at the time of making response to the Office Action. In this case, the examiner shall issue *Notification to Grant Patent Right* regarding the invention application which has met all the conditions for patentability but has not been granted yet, and transfer the written declaration of abandoning the patent for utility model mentioned above to the relevant examination departments for registration and announcement by the Patent Office. In the

announcement, it shall be indicated that the patent right for utility model mentioned above ceases from the date of the announcement of grant of the patent for invention.

# Chapter 4 Inventive Step

## 1. Introduction

In accordance with Article 22. 1, any invention or utility model for which patent right may be granted must possess novelty, inventive step, and practical applicability. Therefore, involving an inventive step is one of the essential requirements to be satisfied for an invention or utility model application to be granted a patent right. This Chapter provides guidelines for the examination of inventive step for invention applications only.

## 2. Concept of Inventive Step of Invention

Art. 22. 3

Inventive step of an invention means that, as compared with the prior art, the invention has prominent substantive features and represents notable progress.

### 2. 1 Prior Art

The prior art referred to in Article 22. 3 means the prior art as defined in Article 22. 5 and Chapter 3, Section 2. 1 of this Part.

The contents of a patent application filed by any entity or individual with the Patent Office previously before the filing date of the application being examined, and published or announced after said filing date, as referred to in Article 22. 2, do not fall within the prior art, and therefore shall not be taken into account when inventive step of the application is assessed.

### 2. 2 Prominent Substantive Features

That an invention has prominent substantive features means that, having regard to the prior art, it is non-obvious to a person skilled in the art. If the person skilled in the art can obtain the invention just by logical analysis, inference, or limited experimentation on the basis of the prior art, the invention is obvious and therefore has no prominent substantive feature.

### 2. 3 Notable Progress

That an invention represents notable progress means that the

invention can produce advantageous technical effect as compared with the prior art. For instance, the invention has overcome the defects and deficiencies in the existing technology, or has provided a different technical solution to solve a certain technical problem, or represents a certain new trend of technical development.

### 2.4 Person Skilled in the Art

Whether or not an invention involves an inventive step shall be evaluated on the basis of the knowledge and capability of the person skilled in the art. The person skilled in the art refers to a fictional "person" who is presumed to be aware of all the common technical knowledge and have access to all the technologies existing before the filing date or the priority date in the technical field to which the invention pertains, and have capacity to apply all the routine experimental means before that date. However, he is not presumed to have creativity. If the technical problem to be solved impels that person to seek technical means in other technical field, he should also be presumed to have access to the relevant prior art, common technical knowledge, and routine experimental means in the other technical field before the filing date or the priority date.

The purpose of establishing such a concept is to unify the standard of examination and to avoid subjectivity as far as possible.

## 3. Examination of Inventive Step of Invention

The determination as to whether or not an invention involves an inventive step shall be considered only when the invention has novelty.

### 3.1 Principles of Examination

In accordance with Article 22.3, when the inventive step of an invention is examined, the examiner shall examine whether or not the invention has prominent substantive features and whether or not it represents notable progress.

When evaluating whether or not an invention involves an inventive step, the examiner shall consider not only the technical solution itself, but also the technical field to which the invention pertains, the technical problem solved, and the technical effects produced by the invention. The invention shall be considered as a whole.

In the examination of inventive step, it is permissible to combine

together different technical contents disclosed in one or more prior art documents to assess the claimed invention, which is different from the principle of "separate comparison" in the examination of novelty (see Chapter 3, Section 3.1 of this Part).

If an independent claim involves an inventive step, there is no need to examine the inventive step of its dependent claims.

### 3.2 Criterion for Examination

When the inventive step of an invention is assessed, Article 22.3 shall be the governing criterion for examination. In order to facilitate the understanding of this criterion, the typical approach to the assessment of prominent substantive features and the criterion for determining notable progress are respectively provided in the following.

#### 3.2.1 Assessment of Prominent Substantive Features

To determine whether an invention has prominent substantive features is to determine, to the person skilled in the art, whether the claimed invention is non-obvious as compared with the prior art.

If the claimed invention is obvious as compared with the prior art, it does not have prominent substantive features. On the contrary, if the result of comparison shows that the claimed invention is non-obvious as compared with the prior art, it has prominent substantive features.

##### 3.2.1.1 Approach to Assessment

Usually the following three steps are followed to determine whether a claimed invention is obvious as compared with the prior art.

(1) Determining the closest prior art

The closest prior art refers to a technical solution in the prior art that is the most closely related to the claimed invention, which shall be the basis for determining whether or not the claimed invention has prominent substantive features. The closest prior art may, for example, be an existing technology in the same technical field as the claimed invention, and its technical problem to be solved, technical effects, or intended use are the closest to the claimed invention, and/or has disclosed the greatest number of technical features of the claimed invention; or be an existing technology which, despite being in a different technical field from the claimed invention, is capable of performing the function of the invention and has disclosed the greatest number of

technical features of the invention. It should be noted that, when determining the closest prior art, account shall be first taken of the prior art in the same or similar technical fields.

(2) Determining the distinguishing features of the invention and the technical problem actually solved by the invention

During examination, the examiner shall objectively analyze and determine the technical problem actually solved by the invention. For this purpose, the examiner shall first determine the distinguishing features of the claimed invention as compared with the closest prior art and then determine the technical problem that is actually solved by the invention on the basis of the technical effect of the distinguishing features. The technical problem actually solved by the invention, in this sense, means the technical task in improving the closest prior art to achieve a better technical effect.

In the course of examination, because the closest prior art identified by the examiner may be different from that asserted by the applicant in the description, the technical problem actually solved by the invention, which is redetermined on the basis of the closest prior art, may not be the same as that described in the description. Under such circumstance, the technical problem actually solved by the invention shall be redetermined on the basis of the closest prior art identified by the examiner.

The redetermined technical problem may depend on the particular situations of each invention. As a principle, any technical effect of an invention may be used as the basis to redetermine the technical problem, as long as the technical effect could be recognized by a person skilled in the art from the contents set forth in the description.

(3) Determining whether or not the claimed invention is obvious to a person skilled in the art

At this step, the examiner shall make a judgment, starting from the closest prior art and the technical problem actually solved by the invention, as to whether or not the claimed invention is obvious to a person skilled in the art. In the course of judgment, what is to be determined is whether or not there exists such a technical motivation in the prior art as to apply said distinguishing features to the closest prior art in solving the existing technical problem (that is, the technical problem actually solved by the invention), where such motivation would prompt a person skilled in the art, when confronted with the technical problem, to improve the closest prior art and thus reach the claimed

invention. If there exists such a technical motivation in the prior art, the invention is obvious and thus fails to have prominent substantive features.

Under the following circumstances, it is usually thought there exists such a technical motivation in the prior art.

(i) The said distinguishing feature is a common knowledge, such as a customary means in the art to solve the redetermined technical problem, or a technical means disclosed in a textbook or reference book to solve the redetermined technical problem.

Example: the claimed invention concerns a building component made of aluminium, and the problem to be solved is to reduce the weight of the building component. A reference document discloses a building component of the same structure and indicates that it is made of lightweight material but does not mention the use of aluminium. In the architecture standard, aluminium is expressly pointed out to be a lightweight material and can be used as building element. Obviously the claimed invention has applied the well-known property of lightweight in aluminium. Therefore it can be concluded that there exists the technical motivation in the prior art.

(ii) The said distinguishing feature is a technical means related to the closest prior art, such as a technical means disclosed in other part of the same reference document, the function of which in the other part is the same as the function of the distinguishing feature in the claimed invention in solving the redetermined technical problem.

Example: the invention claims a device for detecting helium leakage, comprising a general leakage detector for detecting whether a vacuum box leaks generally, a recycle means for recycling any leaked helium, and a helium mass spectrographic leakage detector for detecting specific points of leakage, wherein the helium mass spectrographic leakage detector has a vacuum suction gun.

Reference document 1 discloses in one part an automatic helium leakage detection device, comprising a general leakage detector for detecting whether a vacuum box leaks generally and a recycle means for recycling any leaked helium. In another part, reference document 1 discloses a helium leakage point detector having a vacuum suction gun, and expressly states that said leakage point detector can be a helium mass spectrographic leakage detector for detecting specific leakage points, and the helium mass spectrographic leakage detector herein has the same function as that in the claimed invention. Based on the

teachings of the second part of reference document 1, a person skilled in the art can readily combine the two technical solutions in reference document 1 to reach the solution of the claimed invention. Therefore it can be concluded that there exists the technical motivation in the prior art.

(iii) The said distinguishing feature is a relevant technical means disclosed in another reference document, the function of which in that reference document is the same as the function of the distinguishing feature in the claimed invention in solving the redetermined technical problem.

Example: the invention claims a graphite disc brake having a water discharge recess for discharging the water used to clean the surface of the brake. The problem to be solved by the invention is to remove the graphite powder on the surface of the brake that is caused by friction and prejudicial to braking. Reference document 1 describes a graphite disc brake. Reference document 2 discloses a metal disc brake on which a water discharge recess is provided for discharging the water used to rinse the dust attached on the surface of the brake.

The claimed invention is distinct from reference document 1 in that a recess is provided on the surface of the graphite disc brake, which feature is disclosed in reference document 2. The graphite disc brake described in reference document 1 would produce abrasive powder on its surface because of friction, and thus impair braking. As for the metal disc brake disclosed in reference document 2, the dust attached on its surface would impair braking. In order to solve the technical problem of braking impairment, the former has to remove abrasive powder, and the latter has to remove dust, which are of the same nature. In order to solve the braking problem in a graphite disc brake, the person skilled in the art according to the teachings of reference document 2 can readily envisage using water to rinse it and thus providing a recess thereon for discharging the rinsing water. Since the function of the recess in reference document 2 is the same as that of the recess in the claimed invention, a person skilled in the art has motivation to combine reference documents 1 and 2 and thereby reach the technical solution of the claimed invention. Therefore it can be concluded that there exists the technical motivation in the prior art.

#### 3.2.1.2 Example of Assessment

The claim of a patent application relates to an improved exhaust valve for internal combustion engine, the exhaust valve comprising a

body made of heat resistant nickel-based alloy A and a valve head part, characterized in that said valve head part is coated with a cladding of nickel-based alloy B. The invention is to solve the technical problem for improving resistance to corrosion and high temperature for the valve head part.

Reference document 1 discloses an exhaust valve for internal combustion engine, comprising a body and a valve head part. The body is made of heat resistant nickel-based alloy A, and an alloy different from that of the body is used for the cladding of the valve head part. Reference document 1 further indicates that, in order to adapt to a high temperature and erosive environment, an alloy having resistance to high temperature and erosion may be used for the cladding.

Reference document 2 discloses technical contents regarding the material of nickel-based alloy. It states that nickel-based alloy B has high resistance to extremely erosive environment and to high temperature, and can be used for exhaust valve of an engine.

Among these two reference documents, since reference document 1 falls in the same technical field and has the same problem to be solved as the application, and shares the most common technical features with the application, it can be taken as the closest prior art.

Comparing the claim of the application with reference document 1, it can be seen that the difference between the solution of the application and that of reference document 1 lies in that the application specifically uses nickel-based alloy B for the cladding of the valve head part in order to adapt to high temperature and erosive environment. Therefore the problem actually solved by the application can be determined as how to better adapt the exhaust valve of an engine to high temperature and erosive environment.

Based on reference document 2, a person skilled in the art can clearly recognize that nickel-based alloy B is suitable for the exhaust valve of an engine and can effectively improve its resistance to erosion and to high temperature, which functions in the same way as the alloy functions in the present invention. Therefore it can be concluded that reference document 2 has given a technical motivation to use nickel-based alloy B for the cladding of the valve heads that need to resist to erosion and high temperature, and thus prompts the person skilled in the art to combine reference documents 1 and 2 and thereby reach the technical solution of the claim in the present application. Consequently, the solution claimed in the application is obvious as compared with

the prior art.

### 3.2.2 Assessment of Notable Progress

When evaluating whether or not an invention represents notable progress, the examiner shall primarily consider whether or not the invention produces advantageous technical effects. Usually, an invention shall be regarded as producing advantageous technical effects and therefore representing notable progress in any of the following circumstances:

(1) where, as compared with the prior art, the invention produces a better technical effect, such as quality improved, output increased, energy saving, and environmental pollution prevented or controlled;

(2) where the technical solution provided by the invention is of a different inventive concept and can produce a technical effect of substantially the same level as in the prior art;

(3) where the invention represents a new trend of technical development; or

(4) where, despite negative effect in some respect, the invention produces outstanding positive technical effects in other respects.

## 4. Determination of Inventive Step of Several Types of Invention

It should be noted that the division of types of invention in this Section is mainly based on the nature of the distinguishing features of the invention from the closest prior art, and is for reference only. During examination, the examiner shall make an objective determination based on the specific conditions of each case rather than applying the examples mechanically.

The following are examples to illustrate the determination of inventive step for several types of invention.

### 4.1 Invention Opening up a Whole New Field

An invention opening up a whole new field refers to a totally new technical solution which is unprecedented in the history of technology and ushers in a new epoch for the development of science and technology in a certain period of time.

As compared with the prior art, an invention opening up a whole new field has prominent substantive features and represents notable progress, and therefore involves an inventive step. China's four great inventions of compass, paper, printing technique and gunpowder are

typical examples of this type. In addition, examples of invention opening up a whole new field also include steam engine, filament lamp, radio receiver, radar, laser, process of inputting Chinese in computer, etc.

### 4.2 Invention by Combination

An invention by combination refers to a new technical solution made by combining certain known technical solutions to solve a technical problem objectively existing in the prior art.

In determining the inventive step of an invention by combination, usually the following factors need to be taken into account: whether those combined technical features functionally support each other, the difficulty or easiness of combination, any technical motivation to make the combination in the prior art, and the technical effect of the combination, etc.

(1) Obvious combination

If a claimed invention is merely an aggregation or juxtaposition of certain known products or processes, each functioning in its routine way, and the overall technical effect is just the sum of the technical effects of each part without any functional interaction between the combined technical features, that is, the claimed invention is just a mere aggregation of features, then the invention by combination does not involve an inventive step.

Example: the invention concerns a ballpoint pen with electronic watch, wherein the solution is merely to fix a known electronic watch on a known ballpoint pen. After combination, the electronic watch and the ballpoint pen still function as usual, without any functional interaction between them, and thus the invention is just a mere aggregation and does not involve an inventive step.

Moreover, if the combination is just a variation of a known structure, or it falls into the scope of regular development of routine technology without any unexpected technical effect, then the invention does not involve an inventive step.

(2) Non-obvious combination

If the combined technical features functionally support each other and produce a new technical effect, or in other words, if the technical effect after combination is greater than the sum of the technical effects of the individual features, then such combination has prominent substantive features and represents notable progress, and thus the invention

involves an inventive step. Whether or not any of the technical features itself in the invention by combination is completely or partially known to the public does not affect the assessment of inventive step of said invention.

Example: the invention of "a process of deep refrigerating treatment and chemical plating of Ni-P-rare earth" resides in the combination of the known processes of deep refrigerating treatment and chemical plating. In the prior art, after deep refrigerating treatment, the work piece needs tempering treatment to eliminate stress and stabilize its structure and property. However, in the present invention, after deep refrigerating treatment the work piece does not undergo tempering or ageing treatment but is subject to chemical plating in a plating liquid of 80℃ ±10℃, thereby not only saving the step of tempering or ageing treatment, but also making the work piece having a stable structure and a coating with abrasion resistance, erosion resistance and good adhesion with the matrix. This technical effect of the invention by combination cannot be expected by the person skilled in the art in advance. Therefore, the invention involves an inventive step.

### 4.3 Invention by Selection

An invention by selection refers to an invention made by selecting for purpose a smaller range of options or individual option not mentioned in the prior art from a larger range of options disclosed in the prior art (a selection invention).

In determining the inventive step of a selection invention, the main factor to be considered is whether the selection can bring about unexpected technical effect.

(1) If the invention consists merely in choosing among a number of known possibilities, or merely in choosing from a number of equally likely alternatives, and the selected solution does not produce any unexpected effect, it does not involve an inventive step.

Example: while it is known in the prior art many processes of heating have been disclosed, the invention resides in selecting a known electrically heating process for a known chemical reaction requiring heating, and the selection does not produce any unexpected technical effect. Therefore, the invention does not involve an inventive step.

(2) If the invention resides in the choice of particular dimensions, temperature ranges, or other parameters from a limited range of possibilities, while such choice can be made by the person skilled in the art

through normal design procedures and does not produce any unexpected technical effect, the invention does not involve an inventive step.

Example: the invention relates to a process for carrying out a known reaction and is characterized by a specified flow rate of an inert gas. Since the person skilled in the art can make the determination of the flow rate through conventional calculations, the invention does not involve an inventive step.

(3) If the invention can be arrived at merely by a simple extrapolation in a straightforward way from the known art, it does not involve an inventive step.

Example: the invention is to improve the thermal stability of a composition Y, characterized by the use of a specified minimum content of a component X in the composition Y, while in fact the specified minimum content of component X can be derived from the relation curve between the content of component X and the thermal stability of composition Y. Therefore, the invention does not involve an inventive step.

(4) If the invention is made by selection producing unexpected technical effect, the invention has prominent substantive features and represents notable progress, and thus involves an inventive step.

Example: in a prior art document disclosing the production of thiochloroformic acid, the proportion of catalytic agent of carboxylic acid amide and/or urea to 1 mol raw material mercaptan is more than 0 and less than or equal to 100% (mol). In the given example, the amount of the catalytic agent is 2-13% (mol), and it is indicated that the productivity starts to increase from 2% (mol) of the amount of catalytic agent. Moreover, the skilled person generally turns to increase the amount of catalytic agent in order to improve productivity. In the selection invention concerning a process for producing thiochloroformic acid, less amount of catalytic agent is used [0.02-0.2% (mol)], but the productivity is increased by 11.6-35.7%, greatly exceeding the expected productivity, and moreover, the processing of reactant is also simplified. All of these show that the technical solution selected by this invention has produced unexpected effects and thus the invention involves an inventive step.

## 4.4 Invention by Diversion

An invention by diversion refers to an invention of applying a known technology in one technical field to another technical field.

In determining the inventive step of an invention by diversion, usually the following factors need to be taken into account: the proximity of the diverted technical field to the previous technical field, whether there exists the corresponding technical motivation, the difficulty or easiness of the diversion, any technical difficulties to be overcome, and the technical effect of the diversion, etc.

(1) If the diversion is made between similar or close technical fields, and no unexpected technical effect is produced, the invention by diversion does not involve an inventive step.

Example: applying the supporting structure of a cabinet to support a table does not involve an inventive step.

(2) If the diversion produces an unexpected technical effect or overcomes a difficulty that has never been encountered in the previous technical field, the invention by diversion has prominent substantive features and represents notable progress, and thus involves an inventive step.

Example: the invention relates to submarine ailerons. In the prior art, a submarine stays at an arbitrary place under water by the balance between its deadweight and buoyancy of water and goes up by operating horizontal cabin to increase buoyancy. An airplane flies in the air by the buoyant force of air completely produced by the main wings. The invention learns from the technical measures in airplane and applies the idea of main wings for airplane to submarine. As a result, under the buoyant or sinking force created by the movable boards as ailerons of the submarine, the up and down performance of the submarine is greatly improved. Because many technical difficulties have been overcome in applying the aerial technology to underwater, and the invention produces extremely good effects, it involves an inventive step.

### 4.5 Invention of New Use of Known Product

An invention of new use of known product refers to the invention of using a known product for a new purpose.

In determining the inventive step of an invention of new use of known product, usually the following factors need to be taken into account: the proximity of the technical field of the new use to that of the prior use, and the technical effect of the new use, etc.

(1) If the new use merely utilizes a known property of a known material, the invention of new use does not involve an inventive step.

Example: use of a known composition as a cutting agent in the

same technical field as the prior art use as a lubricant does not involve an inventive step.

(2) If the new use utilizes a newly found property of the known product and can produce an unexpected technical effect, then the invention of use has prominent substantive features and represents notable progress, and thus involves an inventive step.

Example: use of pentachlorophenol preparation as herbicide, as compared with the prior art use as wood bactericide, produces unexpected technical effect, and therefore involves an inventive step.

### 4.6 Invention by Changing Elements

Inventions by changing elements include inventions by changing relations between elements, inventions by replacing elements, and inventions by omitting elements.

In determining the inventive step of an invention by changing elements, usually the following factors need to be taken into account: whether there exists technical motivation for the change in relations between elements or the replacement or omission of elements, and whether the technical effect can be expected, etc.

#### 4.6.1 Invention by Changing Relations between Elements

An invention by changing relations between elements means that, as compared with the prior art, the shape, size, proportion, position, operational relationship or the like has been changed.

(1) If the change in relations between elements does not lead to a change in effect, function, or use of the invention, or the change in effect, function, or use of the invention can be expected, the invention does not involve an inventive step.

Example: in the prior art a measuring instrument having a fixed dial and a rotatable hand is disclosed, and the invention is a similar measuring instrument but having a fixed hand and a rotatable dial. The difference between the invention and the prior art only lies in the change in the relation between elements, that is, the reversal between motion and station. This kind of reversal does not produce any unexpected effect, and therefore the invention does not involve an inventive step.

(2) If the change in relations between elements produces an unexpected technical effect, the invention has prominent substantive features and represents notable progress, and thus involves an inventive

step.

Example: the invention relates to a grass mower which is characterized in that its oblique angle of blade is different from that in the traditional mower, that is, the oblique angle of the invention enables the blade to be sharpened automatically, while the angle of blade in the prior art has no such effect. The invention produces an unexpected effect through the change in the relation of elements, so it involves an inventive step.

### 4.6.2 Invention by Replacing Elements

An invention by replacing elements refers to an invention that is made by substituting a certain element of a known product or process with another known element.

(1) If the invention is just an equivalent alteration between known measures of the same function, or, in solving the same technical problem, a substitution of a recently developed known material with the same function for the corresponding material in a known product, or a substitution of a certain known material for the corresponding material in a known product while the similar use of the known material is already known, and it does not produce any unexpected technical effect, then the invention does not involve an inventive step.

Example: the invention relates to a pump which differs from the prior art in that the motive power in the invention is provided by a hydraulic motor instead of an electric motor. Such an invention of equivalent alteration does not involve an inventive step.

(2) If the replacement of elements confers unexpected technical effect on the invention, then the invention has prominent substantive features and represents notable progress, and thus involves an inventive step.

### 4.6.3 Invention by Omitting Elements

An invention by omitting elements refers to an invention in which one or more elements of a known product or process are omitted.

(1) If, after the omission of one or more elements, the corresponding function disappears accordingly, the invention does not involve an inventive step.

Example: the invention of a painting composition differs from the prior art in that it does not comprise antifreezing agent. Since the antifreezing effect of the painting composition loses accordingly after the

omission of the antifreezing agent, the invention does not involve an inventive step.

(2) If, as compared with the prior art, after the omission of one or more elements( such as the omission of one or more parts in a product invention, or the omission of one or more steps in a process invention), all the corresponding functions can still be preserved, or unexpected technical effects are brought about, then the invention has prominent substantive features and represents notable progress, and thus involves an inventive step.

## 5. Other Factors to be Considered in the Examination of Inventive Step

Usually, whether or not an invention involves an inventive step shall be examined according to the criterion set forth in Section 3.2 of this Chapter. It should be stressed that where an application falls into one of the following circumstances, the examiner shall take the corresponding factors into account and avoid making a rash determination that the invention does not involve an inventive step.

### 5.1 Solving a Long-Felt but Unsolved Technical Problem

Where the invention has solved a technical problem which was desired to be solved for a long time but not successfully solved, the invention has prominent substantive features and represents notable progress, and thus involves an inventive step.

Example: the problem of permanently marking farm animals such as cows without causing pain to the animals or damage to the hide has existed since farming began. An inventor has successfully solved this technical problem by a solution of freeze branding on the basis of the discovery that freezing can permanently pigment the hide. That invention involves an inventive step.

### 5.2 Overcoming a Technical Prejudice

Technical prejudice refers to the understanding of technicians in the art of a certain technical problem in a technical field during a certain period of time that departs from the objective facts, leads the technicians to believe that there is no other possibility and hinders the research and development in that technical field. If an invention is made by overcoming such technical prejudice and adopting the technical means which was abandoned by the technicians due to the prejudice,

and hereby has solved a technical problem, then the invention has prominent substantive features and represents notable progress, and thus involves an inventive step.

Example: it was generally believed that in an electric motor the smoother the interface of the commutator and the brush is, the better the contact is and the smaller the current consumption is. The invention produces coarse microgrooves on the surface of the commutator, and the current consumption is even smaller than that with a smooth surface. Because the invention has overcome the technical prejudice, it involves an inventive step.

### 5.3 Producing Unexpected Technical Effect

An invention produces an unexpected technical effect means that, as compared with the prior art, the technical effect of the invention represents a "qualitative" change, that is, new performance; or represents a "quantitative" change which is unexpected. Such a qualitative or quantitative change cannot be expected or inferred by the person skilled in the art in advance. If an invention produces an unexpected effect, it means the invention represents notable progress on the one hand, and it also means that the technical solution of the invention is non-obvious and thus has prominent substantive features on the other hand. Therefore the invention involves an inventive step.

### 5.4 Achieving Commercial Success

Where an invention achieves commercial success, if the technical features of the invention directly bring about such success, it means that the invention has advantageous effect on the one hand and it is non-obvious on the other hand. Such kind of invention has prominent substantive features and represents notable progress, and thus involves an inventive step. However, if the success is brought about by other factors, such as an advance in selling techniques or advertising, it shall not be used as a basis for assessing inventive step.

## 6. Points to be Noted in the Examination of Inventive Step

The following points shall also be noted in the examination of inventive step of an invention.

### 6.1 How an Invention is Accomplished

The way in which an invention is accomplished, no matter how

arduous or easy it is, shall not affect the evaluation of the inventive step of the invention. Most inventions are the outcome of the inventor's creative work and the result of long time scientific research and working experience. However, there are some inventions that were accomplished just accidentally.

Example: the tyre of motor vehicles has high strength and good abrasion resistance, which was invented by a technician mistaking addition of 30% for 3% of carbon black in preparing materials for producing black rubber. Facts show that the rubber with 30% carbon black has high strength and abrasion resistance which cannot be expected beforehand. Although the invention was attained just because of the technician's negligence, it does not deny the inventive step of the invention.

### 6.2 Avoiding *Ex Post Facto* Analysis

When evaluating the inventive step of an invention, the examiner is apt to underestimate the inventive step of the invention since he has already known the contents of the invention, and hence a mistake of *ex post facto* analysis is likely to be made. Therefore, the examiner shall always bear in mind that, in order to reduce and avoid the influence of subjectivity, the evaluation shall be presumed to be made by a person skilled in the art on the basis of comparison between the invention and the prior art before the filing date thereof.

### 6.3 Consideration of Unexpected Technical Effect

During the determination of inventive step, considering the technical effect will help evaluate appropriately the inventive step of the invention. As provided in Section 5.3 of this Chapter, if the invention produces an unexpected technical effect as compared with the prior art, the examiner may determine that the invention involves an inventive step without the need to question whether its technical solution has prominent substantive features. However, it is noted that if the examiner can determine with the approach as described in Section 3.2 of this Chapter that the technical solution of invention is non-obvious to the person skilled in the art and can produce advantageous technical effect, then the invention has prominent substantive features and represents notable progress, and thus involves an inventive step. Under such circumstance, whether the invention produces unexpected technical effect shall not be overemphasized.

### 6.4 Examination on the Claimed Invention

The determination of whether an invention involves an inventive step shall be directed to the claimed invention, and therefore the evaluation of inventive step shall concern the technical solutions as defined in the claims. The technical features by which the invention makes contribution over the prior art, such as the technical features bringing about unexpected technical effects for the invention, or the technical features reflecting how the invention overcomes a technical prejudice, shall be included in the claims; otherwise, they shall not be taken into account in evaluating the inventive step of the invention, even if they have been set forth in the description. Moreover, the evaluation of inventive step shall be directed to the whole of each technical solution defined in the claims, that is, it is the technical solution as a whole, rather than the individual technical features, that shall be evaluated as to whether involving an inventive step.

# Chapter 5 Practical Applicability

## 1. Introduction

In accordance with Article 22. 1, any invention or utility model for which patent right may be granted must possess novelty, inventive step, and practical applicability. Therefore, possessing practical applicability is one of the indispensable requirements for an invention or utility model application to be granted a patent right.

Art. 22. 4

## 2. Concept of Practical Applicability

Practical applicability means that the subject matter of a patent application for invention or utility model must be one which can be made or used in an industry and can produce effective results.

An invention or utility model for which a patent right may be granted shall be one that can solve a technical problem and can be put into practice. In other words, if the application relates to a product (subject matter for invention or utility model), the product shall be able to be made industrially and solve a technical problem; if it relates to a process (subject matter for invention only), the process shall be able to be used industrially and solve a technical problem. Only when a patent application for a product or process satisfies such conditions, can it be granted a patent right.

The "industry" herein includes the industries of manufacturing industry, agriculture, forestry, fishery, animal husbandry, communication and transportation, culture and sports, articles of daily use, and medical equipment, etc.

A technical solution that can be made or used in an industry refers to any technical solution that conforms with the laws of nature, has technical features, and thus can be implemented. It does not have to involve use of a machine or manufacture of a product, but may be, for example, a process for dispersing fog, or a process for converting energy from one form to another.

That the subject matter of a patent application for invention or utility model can "produce effective results" means that, on the date of filing the application, the economic, technical, or social effects produced by the invention or utility model can be expected by a person

skilled in the art. These effects shall be positive and advantageous.

## 3. Examination of Practical Applicability

The determination as to whether an invention or utility model application has practical applicability shall be made before the examination on novelty and inventive step.

### 3.1 Principles of Examination

The following principles shall be followed when practical applicability of an invention or utility model application is examined:

(1) the examination shall base on the entire technical contents disclosed in the description (including the drawings) and claims submitted on the date of filing, rather than merely the contents described in the claims; and

(2) practical applicability is irrelevant to how the invention or utility model was created or whether it has been implemented.

### 3.2 Criterion for Examination

The expression "can be made or used" referred to in Article 22.4 means that it is possible for the technical solution of an invention or utility model to be made or used industrially. A technical solution that satisfies the requirement of practical applicability shall not violate the laws of nature and shall be reproducible. Lack of practical applicability because of not being able to be made or used is owing to the inherent defect of the solution, and is irrelevant to the extent of disclosure of the description.

In the following some typical situations in which the subject matter does not have practical applicability are described.

#### 3.2.1 Non-Reproducibility

The subject matter of an invention or utility model application having practical applicability shall be reproducible. Accordingly, the subject matter of an invention or utility model application unable to be reproduced does not have practical applicability.

Reproducibility means that, according to the technical contents disclosed, the technical solution adopted in the patent application to solve a technical problem can be implemented repeatedly by a person skilled in the art. Such repeated implementation shall not rely on any random factors and shall have the same result.

However, the examiner shall note that, for an invention or utility model application concerning a product, low rate of finished products and non-reproducibility are substantially different. The former indicates the situation where the product can be made repeatedly but the rate of finished products is low due to the failure of satisfying some technical conditions (such as the environmental cleanliness, temperature, etc.) in the course of manufacture, whereas the latter indicates the situation where even all the necessary technical conditions for implementing the invention or utility model are fulfilled, a person skilled in the art is still unable to repeat the results which the technical solution is aimed to achieve.

### 3.2.2 Violation of the Laws of Nature

An invention or utility model application possessing practical applicability shall comply with the laws of nature. An invention or utility model application that violates the laws of nature cannot be implemented, and thus does not possess practical applicability.

The examiner shall particularly note that those subject matters that violate the law of conservation of energy, such as perpetual motion machines, definitely do not possess practical applicability.

### 3.2.3 Product Utilizing Unique Natural Conditions

An invention or utility model possessing practical applicability shall not be a unique product confined by natural conditions. A unique product that is made by utilizing specific natural conditions and can never be moved does not possess practical applicability. It should be noted that the components of the above product utilizing unique natural conditions in themselves should not be regarded as not possessing practical applicability just because said product does not possess practical applicability.

### 3.2.4 Methods of Surgery on Human or Animal Body for Non-Treatment Purposes

Methods of surgery include those for treatment purposes and those for non-treatment purposes. Methods of surgery for treatment purposes are part of the unpatentable subject matters as described in Chapter 1, Section 4.3 of this Part. Methods of surgery for non-treatment purposes do not have practical applicability because these methods are practiced on the living human or animal body and cannot be used industrially.

Examples of this kind include methods of surgery for cosmetic purposes, methods of extracting bezoar from the living cattle body by surgery, and methods of surgery for assisting diagnosis, such as the method of surgery adopted before coronary arteriography etc.

### 3.2.5 Methods of Measuring Physiological Parameters of Human or Animal Body under Extreme Conditions

Measuring the physiological parameters of a human or animal body under extreme conditions requires the subject to be placed under such conditions, raising a threat to the life of the human being or animal. Moreover, the extreme conditions which different human beings or animals can endure are different, and for each subject the specific extreme condition shall be determined by an experienced professional according to the situation of the subject. Therefore, such methods cannot be used industrially and do not possess practical applicability.

The following methods are regarded as not possessing practical applicability:

(1) the method of measuring the ability of cold resistance of a human or animal by gradually decreasing the body temperature of the human or animal; and

(2) the method of non-invasive examination for measuring the metabolic function of coronary artery by decreasing oxygen partial pressure of the inhaling air to increase the load of the coronary artery step by step and observing the compensation reaction of the coronary artery according to the dynamic change in the artery blood pressure.

### 3.2.6 No Effective Results

The technical solution of an invention or utility model application having practical applicability shall be able to produce anticipated effective results. The technical solution of an invention or utility model application that is obviously of no utility or deviates from the needs of society does not have practical applicability.

# Chapter 6 Unity of Invention and Divisional Applications

## 1. Introduction

A patent application shall comply with the provisions on unity as provided in the Patent Law and its Implementing Regulations. The requirements of unity of invention or utility model applications are provided for in Article 31.1 and Rule 34. Provisions concerning the filing of divisional applications from an application lacking unity and the amendment thereof are provided for in Rules 42 and 43.

The provisions on unity in this Chapter mainly concern applications for invention, wherein the basic concepts and principles are also applicable to utility model applications. For examination of unity of design applications, Chapter 3, Section 9 of Part I of the Guidelines shall apply. For specific issues on the examination of unity of applications in the field of chemistry, Chapter 10, Section 8 of this Part shall apply.

## 2. Unity of Invention

### 2.1 Basic Concept of Unity

#### 2.1.1 Requirement of Unity

Art. 31.1

Unity means that a patent application for invention or utility model shall be limited to one invention or utility model. Two or more inventions or utility models belonging to a single general inventive concept may be filed as one application. That is, where there are several inventions or utility models in one application, the application is acceptable only if all the inventions or utility models are so linked as to form a single general inventive concept. This is the requirement of unity of a patent application.

The main reasons for the requirement of unity for patent applications consist in the following:

(1) economic reason: in order to prevent an applicant from obtaining patent protection for several diverse inventions or utility models by paying for one patent; and

(2) technical reason: in order to facilitate the classification, search

and examination of a patent application.

Lack of unity does not have prejudice to the validity of a patent. Therefore, lacking unity shall not be taken as a ground to invalidate a patent.

### 2.1.2 General Inventive Concept

Rule 34 provides that two or more inventions or utility models belonging to a single general inventive concept which may be filed as one application shall be technically interrelated and contain one or more of the same or corresponding special technical features, wherein the expression "special technical features" shall mean those technical features that define a contribution which each of the inventions or utility models, considered as a whole, makes over the prior art.

Rule 34 establishes an approach to the determination of whether or not two or more inventions or utility models claimed in an application belong to a single general inventive concept. In other words, two or more inventions belonging to a single general inventive concept shall be technically interrelated. The interrelationship between the inventions is reflected in their respective claims in the form of the same or corresponding special technical features.

Rule 34 also defines the meaning of the expression "special technical features". It is a concept specifically proposed for the evaluation of unity of a patent application. Special technical features shall be understood as the technical features that define a contribution which the invention makes over the prior art, i. e., the technical features which make the invention, as compared with the prior art and considered as a whole, have novelty and involve an inventive step.

Therefore, the expression "belonging to a single general inventive concept" referred to in Article 31.1 means having the same or corresponding special technical features.

## 2.2 Examination of Unity

### 2.2.1 Principles of Examination

In carrying out examination of unity with regard to a patent application for invention, the following principles shall be followed by the examiner.

(1) To determine whether two or more inventions claimed in an application meet the requirement of unity in accordance with Article

31.1 and Rule 34 is to determine whether the substantive contents of the technical solution described in the claims belong to a single general inventive concept, that is, to determine whether these claims contain one or more of the same or corresponding special technical features which make the claimed inventions technically interrelated. This determination is made on the basis of the contents of the claims, and, where necessary, the contents of the description and the drawings may be referred to.

(2) The claims of two or more inventions belonging to a single general inventive concept may be drafted in any one of the following six forms of combination; however, two or more independent claims that do not belong to a single general inventive concept cannot be claimed in one application even though they are drafted in one of these forms:

(i) independent claims of the same category for two or more products or processes which cannot be included in one claim;

(ii) an independent claim for a product and an independent claim for a process specially adapted for the manufacture of said product;

(iii) an independent claim for a product and an independent claim for a use of said product;

(iv) an independent claim for a product, an independent claim for a process specially adapted for the manufacture of said product, and an independent claim for a use of said product;

(v) an independent claim for a product, an independent claim for a process specially adapted for the manufacture of said product, and an independent claim for an apparatus specifically designed for carrying out said process; or

(vi) an independent claim for a process and an independent claim for an apparatus specifically designed for carrying out said process.

Wherein, the term "same category" in item (i) means the types of the independent claims are the same, i.e., the two or more inventions claimed in one patent application only involve either product inventions or process inventions. Several independent claims with the same category can be involved in one patent application as long as having one or more of the same or corresponding special technical features enable the two or more product inventions or process inventions technically interrelated.

Items (ii)-(vi) relate to the combinations of two or more independent claims of different categories.

In the combination of an independent claim for a product and an independent claim for a process specially adapted for the manufacture of said product, the "specially adapted" process necessarily results in the claimed product which is technically interrelated with the process. However, the expression "specially adapted" is not intended to mean that the product could not also be manufactured by any other process.

In the combination of an independent product claim and an independent claim for its use, the use must be derived from the special properties of the product, with technical interrelationship being present between the product and the use.

As for the combination of an independent claim for a process and an independent claim for an apparatus specifically designed for carrying out the process, the "specifically designed" apparatus shall not only be capable of carrying out the process, but the contribution the apparatus makes over the prior art shall correspond to that made by the process. However, the expression "specifically designed" does not mean that the apparatus could not be used to carry out other processes, nor that the process could not be carried out by using other apparatus.

Whether the independent claims of different categories are drafted by way of one making reference to the other is just a matter of form, which does not affect the determination of unity. For example, an independent claim for a process specially adapted for the manufacture of product A may either be drafted as "Process for the manufacture of product A of claim 1, …" or be drafted as "Process for the manufacture of product A, …"

(3) Enumerated above are the six examples of combination of two or more independent claims in the same or different categories which can be included in one application and the appropriate drafting order thereof. However, these six combinations are not exhaustive. In other words, it is possible to use other kinds of combination other than those mentioned above, provided that the claims belong to a single general inventive concept.

(4) The determination of whether two or more inventions belong to a single general inventive concept shall be made without regard to whether the inventions are claimed in separate independent claims or as alternatives within a single claim. In either case, the same criteria shall be applied to determine whether there is unity. The latter case often occurs in Makush claims. For the examination of unity of invention with regard to a Makush claim, Chapter 10, Section 8. 1 of this Part

shall apply. Moreover, the order of the claims shall not affect the determination of unity.

(5) Generally, the examiner need only consider unity among the independent claims, and no objection of lack of unity shall be raised as between an independent claim and its dependent claims. However, where a claim appears to be dependent in its form but actually is independent, it shall be examined as to whether it meets the requirement of unity.

Where an independent claim cannot be approved for lack of novelty or inventive step, it is then necessary to consider whether its dependent claims satisfy the requirement of unity.

(6) For some applications, the question of unity may be decided before search of the prior art; but for some other applications, the question of unity may be decided only after taking the prior art into consideration. Where the different inventions contained in an application obviously fails to belong to a single general inventive concept, the examiner may decide that the application does not meet the requirement of unity before a search is conducted. For example, the application contains two independent claims respectively of a herbicide and a mower. Because no same or corresponding technical features exist between the two claims, and thus it is impossible for them to have any same or corresponding special technical feature, it is obvious that there is no unity between them, which conclusion can be made before a search is conducted. However, since the special technical feature is to define the contribution over the prior art and to be compared with the prior art, it can be identified only after considering the state of the art. In this regard, for many applications the determination of unity can be made only after search.

Where, after the comparison of an application with the prior art, the novelty or inventive step of the first independent claim of the application is denied, it shall be redetermined as to whether the rest of the independent claims belong to a single general inventive concept.

#### 2.2.2 Approach to the Examination of Unity and Examples

Prior to the search of two or more inventions claimed in one application, whether or not they obviously lack unity shall be firstly determined. If the inventions do not have any same or corresponding technical feature, or the same or corresponding technical features they have are customary means in the art, then it is impossible for them to

have any same or corresponding special technical feature that defines a contribution over the prior art, and therefore the inventions obviously lack unity.

For two or more inventions that do not obviously lack unity, the determination of unity can be made only after search. In this case, the following approach is normally adopted:

(1) compare the subject matter of a first invention with the relevant prior art to identify the "special technical feature" that defines the contribution which the invention makes over the prior art;

(2) determine whether a second invention contains one or more special technical features which are the same as or correspond to those in the first invention, so as to determine whether these two inventions are technically interrelated; and

(3) if one or more same or corresponding special technical features exist between the inventions, i. e., the inventions are technically interrelated, it can be concluded that they belong to a single general inventive concept. Conversely, if no technical interrelationship exists between the inventions, it can be concluded that they do not belong to a single general inventive concept and thus it can be determined that there is no unity between them.

In the following, the basic points in combination with the basic concepts, principles, and the examination approach in the examination of unity are illustrated by way of examples.

#### 2.2.2.1 Unity of Independent Claims of the Same Category

[Example 1]

Claim 1: A conveyer belt X characterized by feature A;

Claim 2: A conveyer belt Y characterized by feature B;

Claim 3: A conveyer belt Z characterized by features A and B.

There is no conveyer belt characterized by the feature A or B disclosed in the prior art. From the prior art, such conveyer belt is non-obvious, and the features A and B are not interrelated.

Explanation: claims 1 and 2 do not contain any same or corresponding technical feature. Therefore, it is impossible for them to have any same or corresponding special technical feature. They are not technically interrelated, and thus do not have unity. Feature A of claim 1 is the special technical feature that defines the contribution which the invention makes over the prior art. Claim 3 contains the special technical feature A, and therefore claim 1 and claim 3 contain the same special

technical feature and have unity. Similarly, claim 2 and claim 3 contain the same special technical feature B, and thus also have unity.

[Example 2]

Claim 1: A transmitter characterized by the time axis expander for video signals.

Claim 2: A receiver characterized by the time axis compressor for video signals.

Claim 3: An apparatus for conveying video signal characterized in that it consists of the transmitter in claim 1 and the receiver in claim 2.

The use of the time axis expander and the time axis compressor in the art has neither been disclosed nor implied in the prior art, and the use is non-obvious.

Explanation: the special technical feature of claim 1 is the time axis expander for video signals, and the special technical feature of claim 2 is the time axis compressor for video signals. The expander and the compressor are technically interrelated and inseparable in use, and are technical features corresponding to each other. Therefore claim 1 and claim 2 have unity. As claim 3 contains the special technical feature as contained in claim 1 and claim 2, it therefore has unity both with claim 1 and with claim 2.

[Example 3]

Claim 1: A plug characterized by feature A;

Claim 2: A socket characterized by a feature corresponding to feature A;

The plug characterized by feature A and the corresponding socket have not been disclosed or implied in the prior art, and they are non-obvious.

Explanation: claim 1 and claim 2 have a corresponding special technical feature, and the claimed plug and socket are technically interrelated and have to be used together. Therefore claim 1 and claim 2 have unity.

[Example 4]

Claim 1: A control circuit with feature A for a DC motor.

Claim 2: A control circuit with feature B for a DC motor.

Claim 3: An apparatus comprising a DC motor having control circuit with feature A.

Claim 4: An apparatus comprising a DC motor having control circuit with feature B.

From the prior art, features A and B are the technical features defining the contributions over the prior art respectively, and they are not technically interrelated.

Explanation: feature A is the special technical feature of claims 1 and 3, and feature B is the special technical feature of claims 2 and 4. However, there is no technical interrelationship between features A and B. Therefore, between claims 1 and 3 or between claims 2 and 4 there exists the same special technical feature and thus they have unity, while between claim 1 and claim 2 or 4, or between claim 3 and claim 2 or 4, there is no same or corresponding special technical feature and thus they do not have unity.

[Example 5]

Claim 1: Filament A for a lamp.

Claim 2: Lamp B having filament A.

Claim 3: Searchlight provided with lamp B having filament A and a swivel arrangement C.

As compared with the filaments disclosed in the prior art, filament A is novel and involves an inventive step.

Explanation: since above three claims have in common the same special technical feature of filament A, unity exists between claims 1, 2, and 3.

[Example 6]

Claim 1: A process B for making product A.

Claim 2: A process C for making product A.

Claim 3: A process D for making product A.

As compared with the prior art, product A is novel and involves an inventive step.

Explanation: product A is the same special technical feature common to above three process claims, and there is unity between above three processes B, C, and D. Certainly, product A per se may be also a product claim. If product A is known, it shall not be regarded as the special technical feature. In such case, unity between the three processes shall be reassessed.

[Example 7]

Claim 1: A resin composition, comprising a resin A, a filler B and a flame retardant C.

Claim 2: A resin composition, comprising a resin A, a filler B and an antistatic agent D.

The resin A, the filler B, the flame retardant C and the antistatic

agent D are individually known in the art, and the combination of AB does not define the contribution which the invention makes over the prior art, while the combination of ABC forms a high performance uninflammable resin composition, and the combination of ABD forms a high performance antistatic resin composition, both of which have novelty and involve an inventive step.

Explanation: although both claims contain the same features A and B, but none of A, B and the combination of AB defines the contribution which the invention makes over the prior art. The special technical feature of claim 1 is the combination of ABC, and the special technical feature of claim 2 is the combination of ABD. The both features are neither the same nor corresponding to each other. Therefore, unity does not exist between claim 2 and claim 1.

**2.2.2.2 Unity of Independent Claims in Different Categories**

[Example 8]

Claim 1: A compound X.

Claim 2: A method of preparing compound X.

Claim 3: The use of compound X as an insecticide.

(1) Situation 1: the compound X has novelty and involves an inventive step.

Explanation: compound X is the same technical feature common to above three claims. Since it is the technical feature that defines the contribution over the prior art, i. e. the special technical feature, claims 1, 2 and 3 have the same special technical feature, and thus unity exists between claims 1-3.

(2) Situation 2: after search, the examiner finds that the compound X lacks novelty or inventive step as compared with the prior art.

Explanation: no patent right shall be granted to claim 1 since it lacks novelty or inventive step. The common technical feature of claim 2 and claim 3 is still the compound X. However, since compound X has not made a contribution over the prior art, it is not the same special technical feature. Moreover, there is no corresponding special technical feature between claim 2 and claim 3. Therefore, there is no same or corresponding special technical feature between claim 2 and claim 3, and thus they do not have unity.

[Example 9]

Claim 1: A high strength and corrosion resistant stainless steel

strip consisting essentially of (in percentage by weight): Ni = 2.0-5.0, Cr = 15-19, Mo = 1-2, and the balance Fe, having a thickness of between 0.5 mm and 2.0 mm, and a 0.2% yield strength over 50 kg/mm$^2$.

Claim 2: A process for making a high strength and corrosion resistant stainless steel strip consisting essentially of (in percentage by weight): Ni = 2.0-5.0, Cr = 15-19, Mo = 1-2, and the balance Fe, comprising the steps in following order:

(1) hot rolling the stainless steel strip to a thickness of between 2.0mm and 5.0mm;

(2) annealing the hot rolled strip at 800℃-1000℃;

(3) cold rolling the strip to a thickness of between 0.5 mm and 2.0 mm; and

(4) annealing at 1120℃-1200℃ for 2-5 minutes.

As compared with the prior art, the stainless steel belt having 0.2% yield strength over 50 kg/mm$^2$ possesses novelty and involves an inventive step.

Explanation: unity is present between claim 1 and claim 2. The special technical feature of product claim 1 is the 0.2% yield strength over 50kg/mm$^2$. The steps in process claim 2 are specially adapted for producing the stainless steel strip with such yield strength. Although this feature is not apparent from the wording of claim 2, it is clearly disclosed in the description. Therefore, these process steps are the special technical features which correspond to the feature of yield strength in product claim 1.

Claim 2 may also be drafted by making reference to claim 1, but this would not affect the unity between them. An example of drafting in this form may be:

Claim 2: A process for making the stainless steel strip as defined in claim 1, comprising the following steps:

〔Steps (1)-(4) are the same as above and are omitted here.〕

[Example 10]

Claim 1: A paint containing dustproof substance X;

Claim 2: A process for painting an article by using the paint as defined in claim 1, including the following steps: (1) atomizing the paint by using compressed air; (2) electrically charging the atomized paint by using an electrode arrangement A and directing the paint to the article.

Claim 3: A painting apparatus including an electrode arrangement A.

As compared with the prior art, both the paint containing substance X and the electrode arrangement A are novel and involve an inventive step. However, the process for atomizing the paint by using compressed air, electrically charging the atomized paint and directing the paint to the article is known.

Explanation: unity is present between claim 1 and claim 2, and the paint containing substance X is the special technical feature common to them. Unity is also present between claim 2 and claim 3, because the electrode arrangement A is their common special technical feature. However, unity does not exist between claim 1 and claim 3, since there is no same or corresponding special technical feature between them.

[Example 11]

Claim 1: A process for treating textile material, characterized by spraying the material with coating composition A under condition B.

Claim 2: A textile material coated according to the process of claim 1.

Claim 3: A spraying machine for use in the process of claim 1, characterized in that it includes a nozzle C providing a better distribution of the composition being sprayed on the textile material.

A process for treating textile material with a coating composition has been disclosed in the prior art, but the process for coating with the particular coating composition A under the special condition B (for example, as to temperature, irradiation, etc.), i. e. the process of claim 1 is novel. Moreover, the textile material of claim 2 presents unexpected properties. The nozzle C is novel and involves an inventive step.

Explanation: the special technical feature in claim 1 is the use of special process conditions corresponding to what is made necessary by the choice of the particular coating composition, and the textile material of claim 2 is obtained after treatment by said particular coating composition under the special condition. Therefore, claim 1 and claim 2 have the corresponding special technical feature and unity exists between them. Since the spraying machine in claim 3 has no corresponding special technical feature with claims 1 and 2, there is no unity between claim 3 and claims 1 and 2.

[Example 12]

Claim 1: A process of manufacture comprising step A and step B.

Claim 2: An apparatus specifically designed for carrying out step A.

Claim 3: An apparatus specifically designed for carrying out step B.

No prior art document relevant to the process of claim 1 has been found.

Explanation: steps A and B are respectively the special technical features defining the contribution which the inventions make over the prior art. Unity is present between claim 1 and claim 2, and between claim 1 and claim 3. As there is no same or corresponding special technical feature between claim 2 and claim 3, there is no unity between them.

[Example 13]

Claim 1: A fuel burner characterized in that there are tangential fuel inlets into a mixing combustion chamber.

Claim 2: A process for making a fuel burner, characterized in that it includes the step of forming tangential fuel inlets into a mixing combustion chamber.

Claim 3: A process for making a fuel burner, characterized by a casting procedure.

Claim 4: An apparatus for making a fuel burner, characterized in that it includes a unit X for forming tangential fuel inlets in the mixing combustion chamber.

Claim 5: An apparatus for making a fuel burner, characterized in that it includes an automatic control unit D.

Claim 6: A process of manufacturing carbon black by the fuel burner as defined in claim 1, characterized in that it includes the step of tangentially introducing fuel into a mixing combustion chamber.

In the prior art a fuel burner with non-tangential fuel inlets and a mixing combustion chamber has been disclosed. As viewed according to the prior art, the fuel burner with tangential fuel inlets is neither known nor obvious.

Explanation: unity exists between claims 1, 2, 4 and 6. The special technical feature common to all the claims is the tangential fuel inlets. However, claim 3 or 5 does not share the same or corresponding special technical feature with claim 1, 2, 4 or 6, therefore there is no unity between claim 3 or 5 and claim 1, 2, 4 or 6. Furthermore, claim 3 and claim 5 would also lack unity with each other.

### 2.2.2.3 Unity of Dependent Claims

According to the principle provided in Section 2.2.1, item (5) of this Chapter, no objection of lack of unity shall be raised as between a real dependent claim and the independent claim on which it depends, even if the dependent claim may additionally comprise another invention.

For example, an independent claim relates to a new process for making cast iron. In an embodiment, the cast iron is made by the process under a certain scope of temperature. In this case, a dependent claim may be drafted to protect the scope of temperature. Even if the scope of temperature is not mentioned in the independent claim, no objection of lack of unity between the dependent claim and the independent claim shall be raised.

For another example, claim 1 is a method for making product A characterized by using B as the raw material; and claim 2 is a method for making product A according to claim 1, characterized in that the raw material B is prepared from material C. Because claim 2 contains all the technical features of claim 1, no matter whether the process for preparing the raw material B from material C is inventive, no objection of lack of unity shall be raised as between claim 1 and claim 2.

Still another example concerns the case where claim 1 claims a turbine rotor blade characterized in that the blade is shaped in a specified manner, while claim 2 is a turbine rotor blade as claimed in claim 1 characterized in that the blade is made from alloy A. In this example, even if the alloy A is new and may independently constitute an invention and its use in turbine rotor blade is inventive, no objection on account of lack of unity shall be raised in respect of claim 2 and claim 1.

It should be noted that, under certain circumstances, a claim which appears to be dependent in its form is actually an independent claim, and thus concern in unity may arise accordingly. For example, claim 1 is a contactor with features A, B, and C, while claim 2 defines a contactor according to claim 1 wherein the feature C is replaced by feature D. Since claim 2 does not contain all the features of claim 1, it is not a dependent but independent claim. Whether the two claims have unity shall be examined according to the principles of examination on unity for independent claims of the same category.

Where an independent claim is not patentable due to the reason of

lack of novelty, inventive step etc. , the question of lack of unity may arise among its dependent claims.

[Example]

Claim 1: A display with features A and B.

Claim 2: The display according to claim 1 with additional feature C.

Claim 3: The display according to claim 1 with additional feature D.

(1) Situation 1: as compared with displays in the prior art, the display with features A and B as claimed in claim 1 has novelty and involves an inventive step.

Explanation: claims 2 and 3 are dependent claims that further define the extent of protection of claim 1, and thus unity exists between claims 1, 2 and 3.

(2) Situation 2: as viewed from the combination of two prior art documents, the display as claimed in claim 1 does not involve an inventive step, and features C and D are respectively the technical features which make contributions over the prior art and are not interrelated at all.

Explanation: since claim 1 does not involve an inventive step and cannot be granted a patent right, the remaining claims 2 and 3 shall be taken as independent claims to determine whether unity exists therebetween. Because the special technical feature C of claim 2 and the special technical feature D of claim 3 are neither the same nor correspond to each other, there is no unity between claim 2 and claim 3.

## 3. Divisional Applications

### 3.1 Several Circumstances to File Divisional Application

In any of the following circumstances in which unity is not present in an application, the examiner shall invite the applicant to amend the application (including to divide the application) to meet the requirement of unity.

(1) The original claims contain two or more inventions that do not meet the requirement of unity.

Where two or more inventions not belonging to a single general inventive concept are claimed in the original claims of an application, the examiner shall invite the applicant to restrict the claims to one of the inventions (usually the invention corresponding to claim 1) or to

two or more inventions belonging to a single general inventive concept. For the removed inventions, the applicant may file divisional applications.

(2) There is no unity between an added or replacing independent claim introduced during amendments to the application and the invention defined in the original claims.

In the process of examination, the applicant may amend the claims by introducing to the claims a new independent claim which defines an invention originally described in the description only or, in response to an Office Action, by replacing an original independent claim with a new independent claim which defines an invention originally described in the description only. If there is no unity between the newly introduced invention and the invention defined in the original claims, generally the examiner shall invite the applicant to remove the added or replacing invention from the claims. The applicant may file a divisional application for the removed invention.

(3) One of the independent claims lacks novelty or inventive step, and there is no unity between the other claims.

The lack of novelty or inventive step of a certain independent claim(usually claim 1) may result in lack of unity among its parallel independent claims or even among its dependent claims in case they no longer share the same or corresponding special technical features. In this case, the claims need to be amended, and for any subject matter removed after amendment, the applicant may file a divisional application. For example, an application contains a product, a process for making the product and a use of the product, and it is found after search and examination that the product is not new. In this case, the remaining independent claims of the process for making the product and the use of the product obviously do not have the same or corresponding special technical features, and therefore, they need to be amended.

In the above circumstances, the applicant may file a divisional application on his own initiative or as a response to an Office Action. It should be noted that because whether to file a divisional application is a voluntary choice of the applicant, the examiner shall only invite the applicant to restrict the two or more inventions that do not have unity to one invention or to amend the inventions to form a single general inventive concept. It is up to the applicant whether to file a divisional application for any invention removed after the amendment.

Moreover, an application may be divided by filing one or more

divisional applications based on that application, and a divisional application may be further divided by filing one or more further divisional applications, but the basis shall be the original application that the divisional application is derived from. Where any further divisional application is filed from a divisional application, if the time of filing fails to satisfy the requirement provided in Chapter 1, Section 5.1.1(2) of Part I, the further divisional application shall not be accepted unless it is filed as a response to an Office Action noting the defect of lack of unity in the divisional application.

### 3.2 Requirements to be Met by a Divisional Application

A divisional application shall meet the following requirements.

(1) Text of the divisional application

A divisional application shall, at the beginning of its description, i.e., before the part of technical field to which the invention pertains, indicate the original application from which it is divided and the filing date, the application number and the title of the original application.

In filing a divisional application, a copy of the original application shall be submitted; if priority is claimed, a copy of the priority document of the original application shall also be submitted.

(2) Contents of the divisional application

Rule 53(3)

The divisional application shall not go beyond the scope of disclosure contained in the initial application. Otherwise, it shall be rejected on the ground that it does not comply with Rule 43.1 or Article 33.

(3) Description and claims of the divisional application

The claims of the parent application after division and the divisional application shall claim protection of different inventions respectively. However, their descriptions may have variations. For example, the original application contains two inventions A and B before division. After the application is divided, if the claims of the parent application claim for the protection of invention A, the description of the parent application may still contain both invention A and invention B, or just keep only invention A; if the claims of the divisional application claim for the protection of invention B, the description of the divisional application may still contain both invention A and invention B, or just keep only invention B.

For requirements concerning the applicant, time of filing and type of a divisional application, Chapter 1, Section 5.1.1 of Part I shall

apply.

### 3.3 Examination on Division of an Application

In case where an application needs to be divided, the examination on division of an application includes the examination of the divisional application and of the parent application after division, which shall be performed according to Rules 42 and 43.

(1) In accordance with Rule 43.1, the divisional application shall not go beyond the scope of disclosure contained in the initial application. Otherwise, the examiner shall invite the applicant to make amendments. If the applicant does not make any amendment, or if the amendments made go beyond the scope of disclosure contained in the initial description and the claims, the examiner may reject the divisional application according to Rule 53(3) either on the ground that the divisional application does not comply with Rule 43.1 or on the ground that the amendments do not comply with Article 33.

(2) In accordance with Rule 42.2, where an application does not conform with Article 31.1 or Rule 34, the examiner shall invite the applicant to amend the application, that is, to restrict the application to one invention or to amend the inventions to form a single general inventive concept, within the specified time limit; the examiner shall meanwhile also remind the applicant that the application will be deemed withdrawn if no response is to be made within the time limit without justified reasons, and that the examiner may reject the application under Article 31.1 if the defect of lack of unity is not overcome. Similarly, a divisional application lacking unity of invention shall also be dealt with in the same way.

(3) Except for the examination under Rules 42 and 43, examination on other issues is the same as for a normal application.

# Chapter 7 Search

## 1. Introduction

The search shall be conducted for every invention application before it is granted a patent right. In the procedures of substantive examination for an invention application, the search constitutes a very important step. The objective of the search is to discover from the prior art reference documents closely related or relevant to the subject matter of an application, or to find out conflicting applications or documents for avoiding double patenting, in order to decide whether the subject matter of the application possesses novelty and inventive step as provided for in Article 22. 2 and Article 22. 3 respectively, or meets the requirement of Article 9. 1.

The provisions of this Chapter shall apply to the search on utility model patent and short-term patent of Hong Kong Special Administrative Region.

Results of the search shall be recorded in a search report.

## 2. Search Documentation Used in Examination

### 2. 1 Patent Documentation Used in Search

The search in substantive examination procedure for an invention application is mainly conducted in patent documentation. The patent documentation used in search mainly includes the patent documents of various countries in electronic form( either in computer searchable databases or in CD-ROMs), the search files in paper form for use in examination which are arranged according to IPC order, the patent documents of various countries in paper form which are arranged according to serial number, and the patent documents of various countries in microfiche.

The patent documentation in electronic form collected in the Patent Office mainly includes: the publication of Chinese invention applications, the publication of Chinese invention patents, the publication of Chinese utility model patents, the publication of European patent applications, the international publication of patent applications under the PCT, the publication of US patents, the publication of

Japanese patent applications, the publication of Japanese utility model patents, and patent abstracts of various countries. The patent documentation in paper form collected in the Patent Office mainly includes: the publication of Chinese invention applications, the publication of Chinese invention patents, the publication of Chinese utility model patents, the publication of US patents, the publication of European patent applications, the international publication of patent applications under the PCT, and patent abstracts of various countries.

### 2.2 Non-Patent Literature Used in Search

In addition to searching in patent documentation, the examiner shall also search non-patent literature. The non-patent literature used in search mainly includes foreign and domestic scientific and technological books, periodicals, index tools and manuals in paper form or electronic form.

## 3. Subject of Search

### 3.1 Text of Application for Search

The text of an application for search usually includes the initial claims and description (including the drawings, if any) submitted by the applicant on the date of filing. Where amendments have been made to the claims and/or description by the applicant upon the request of the examiner in accordance with Rule 44 or on his own initiative in accordance with Rule 51.1, the text of the application forming the basis of the search shall be the claims and/or description finally submitted by the applicant and in conformity with the provisions of Article 33 (see Chapter 8, Section 4.1 of this Part).

### 3.2 Search on an Independent Claim

The search shall direct mainly to the claims of an application and with regard to the description and drawings. The examiner shall first take the technical solution defined by the independent claim as the subject of the search. At this time, the search shall be focused on the inventive concept of the independent claim, rather than be restricted to the literal wording of the independent claim. Nevertheless, the search does not need to be broadened to cover every detail that may be derived from a consideration of the description and drawings.

### 3.3 Search on Dependent Claims

After the search directed to the technical solution defined by the independent claim, if a reference document that may affect the novelty or inventive step of the independent claim is found, then for assessing whether the technical solutions further defined by the dependant claims are novel and involve an inventive step as required by Article 22.2 and Article 22.3, the examiner shall continue the search by taking the technical solutions further defined by the dependent claims as the subject of the search. However, there is no need to make a further search if the additional features of the dependent claims fall into the common knowledge of the relevant art.

When the search results have revealed that the technical solution defined by the independent claim possesses novelty and involves an inventive step, generally, it is not necessary to conduct further search which is directed to the technical solutions defined by its dependent claims.

### 3.4 Search on Claims Characterized by Combination of Elements

For claims characterized by a combination of elements A, B, and C, the examiner shall first direct the search to the technical solution of A + B + C, and if no reference document that may affect its novelty or inventive step is found, the examiner shall further direct the search to the sub-combinations of A + B, B + C, and A + C, as well as to the single element of A, B, and C.

### 3.5 Search on Claims of Different Categories

Where an application contains claims of different categories (product, process, apparatus, or use), the examiner shall direct the search to all these claims of different categories. In certain circumstances, even though the application contains only claims of one category, it may be necessary to conduct the search which is directed to the relevant subject matters in other categories. For example, when the search is directed to a claim relating to a chemical process, in order to determine its inventive step, in addition to the search directed to the process claim per se, the search shall also cover the final products made by the process, unless they are obviously known products.

### 3.6 Search on Description and Drawings

In addition to the search directed to the technical solutions defined by the claims, i.e., the claimed subject matter of an application (hereinafter refers to the subject matter of the application), sometimes it may be necessary for the examiner to direct the search to other substantive contents disclosed in the description and drawings which further define the subject matter of the application. This is because when the applicant amends the claims, it is possible for him to add said contents into the claims. For example, in an application relating to an electric circuit, the technical solutions defined by the claims only relate to the function and the manner of operation of the circuit, but an important transistor circuit is disclosed in detail in the description and drawings. Under such circumstances, the search shall be directed to not only the function and the manner of operation of the circuit defined by the claims, but also the transistor circuit. In this way, even if the applicant introduces the transistor circuit into the claims in the later amendments, the examiner will not need to perform supplementary search. However, no search is necessary for the invention included in the description which has no unity with the technical solutions defined by the claims, because it is not allowable to introduce the invention as the claimed subject matter of the application into the claims in the later amendments (see Chapter 8, Section 5.2.1.3(3) of this Part).

## 4. Time Coverage of Search

### 4.1 Time Coverage of Search for Relevant Documents in the Prior Art

For an invention application, the examiner shall search all the relevant patent documents and non-patent literature in the same or analogous technical fields disclosed before the date of filing in China. The advantage of doing so is that the examiner may not need to verify the validity of priority, except for the situations in which the priority must be verified as described in Chapter 8, Section 4.6.1 of this Part, for example, when a reference document which was applied or published within the priority interval and may affect the novelty or inventive step of the application is found.

### 4.2 Time Coverage of Search for Conflicting Applications

In order to determine whether there is a conflicting application prejudicial to the novelty of the subject matter of an invention application, the examiner shall additionally search at least the following:

(1) all the patent applications in the same or analogous technical fields which were filed by any entity or individual prior to the filing date of the application and published or announced within eighteen months from the filing date of the application; and

(2) all the international applications in the same or analogous technical fields designating China under the Patent Cooperation Treaty (PCT) which were filed by any entity or individual with a Receiving Office for international applications prior to the filing date of the application and internationally published within eighteen months from the filing date of the application, in order to find any international application that is identical with the application and may, after its entering of the national phase of China under the PCT, constitute a conflicting application to the application.

## 5. Preparation before Search

### 5.1 Reading the Relevant Documents

Where the following documents are cited in the description, when necessary, the examiner shall find and read them:

(1) documents cited as the basis of the subject matter of the application;

(2) documents cited as background art which relate to the technical problem to be solved by the invention; or

(3) documents which are helpful for a correct understanding of the subject matter of the application.

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If these documents are necessary for the correct under- standing and evaluation of the subject matter of the application to the extent that the examiner cannot carry out a meaningful search without them, and they are not available in the Patent Office, then the examiner shall postpone the search and notify the applicant to provide a copy of these documents within a prescribed time limit. The search shall not be carried out until the copy of the documents is received (see Chapter 8, Sections 3.2.4 and 3.2.5 of this Part).

If the documents cited in the description obviously have no direct

relevance with the subject matter of the application, the examiner may not take such documents into account.

If the applicant has submitted the search report of foreign countries, the examiner shall read the documents cited in the search report, especially those that may affect the novelty or inventive step of the subject matter of the application.

### 5.2 Checking the IPC Symbol of the Application

In order to conduct the search more effectively, the examiner shall first determine the International Patent Classification (IPC) symbol (abbreviated as classification symbol) of the application. For how to determine classification symbol, Chapter 4 of Part I of these Guidelines shall apply. For this purpose, the examiner shall, on the basis of the correct understanding of the subject matter of the application, use the rules of classification to check the IPC symbol assigned by the classification division or an International Searching Authority. When the IPC symbol is found inappropriate, the examiner shall handle it according to the provisions of Chapter 8, Section 3.1 of this Part.

### 5.3 Determining the Technical Fields to be Searched

The examiner shall usually carry out the search in the technical field to which the subject matter of the application pertains. When necessary, the scope of the search shall be extended to the analogous technical fields. The technical field to which the subject matter of the application pertains is determined according to the contents of the claims, especially the specific function and use, as well as the corresponding specific embodiments which are clearly indicated. The classification symbol assigned by an examiner which indicates the invention information is the technical field to which the subject matter of the application pertains. The analogous technical fields are determined according to the essential function or use that the subject matter of the application as revealed in the application documents has to possess, and not only the title of the subject matter of the application, or the specific function expressly indicated in the application documents. For example, a tea mixer and a concrete mixer are in the analogous fields, because mixing is the essential function of the two. Similarly, a brick cutting machine and a biscuit cutting machine also are in the analogous fields. For another example, a cable clamp having certain structural characteristics is defined in an independent claim of an application. If

no relevant document can be found in the technical field to which the cable clamp pertains, the search shall be extended to the technical fields of pipe clamps and other similar clamps. These clamps possess the similar essential function with the cable clamp, thus it is quite possible for them to have the structural characteristics as defined in the independent claim. In other words, when an extended search is made, the search shall cover all the documents that may contain contents relevant to all or some of the features of the subject matter of the application.

### 5.3.1 Using Computer Searchable Databases

The examiner may use keywords, title of the invention, inventor's name and the like as input to search in computer searchable databases to determine the target technical fields. Among them, the search by keywords is the most utilized way to determine the target technical fields.

On the basis of the correct understanding of the subject matter of the application, the examiner may choose one or more "keywords" to conduct a computer search in the computer searchable databases, followed by a statistical analysis, e.g., a statistical analysis of the classification symbols of the found documents, so as to determine the technical fields to be searched as accurately and comprehensively as possible. In the same way, the technical fields which shall be searched for other subject matters mentioned above can also be determined.

### 5.3.2 Using the IPC

Where, through the use of computer searchable databases, the technical fields to be searched cannot be determined appropriately, the examiner may determine the technical fields to be searched by consulting the IPC in the following steps:

(1) looking up the "Contents of Section" at the beginning of each section of the IPC, and selecting all the possible sub-sections and classes according to the titles; and

(2) reading the class titles under the selected sub-sections and classes, and selecting the sub-classes which may be most appropriate to cover the contents of the subject of the search.

In the above two steps, the examiner shall pay attention to the notes or references of the titles of the sub-sections and/or the classes and subclasses. These notes or references may have influence on the contents of subclasses, indicating the differences between the subclasses,

and may possibly direct to the expected location of the subject of the search. If in the advanced level IPC there exists a classification definition for a selected subclass in the electronic layer, the examiner shall pay attention to the detailed contents thereof because the classification definition provides the most accurate indication to the scope of the subclass. Moreover, the examiner shall note that if there is a functional classification position that is similar to the function of the subject of the search, there are possibly one or more application classification positions that are related to the subject of the search. When no specific position of the subject of the search could be found, the classification symbols of the remaining positions, of which the title of the class or group is "other xx" or "xx not listed in Group xx", may be considered as the technical fields to be searched;

(3) referring to the "Subclass Index" at the beginning of the subclass, reading the full titles of main groups together with notes and references, and selecting the main group which is most appropriate to cover the subject of the search;

(4) reading all the subgroups with one dot under the selected main group, and selecting the most appropriate one to cover the subject of the search. If the subgroup has notes and references, then other classification positions shall be taken into consideration according to these notes and references so as to find out one or more classification positions that may be more appropriate for the subject of the search;

(5) selecting a subgroup with more than one dot which can still cover the subject of the search.

Through the above-mentioned five steps, the subgroup which is most suitable for the covering of the subject of the search can be determined. This subgroup and all its hierarchically lower subgroups in which the subject of the search are not obviously excluded are the technical fields to be searched. If there is any note of priority with the selected subgroup, such subgroup and all its hierarchically lower subgroups in which the subject of the search are not obviously excluded shall also be deemed as the technical fields to be searched. Furthermore, from the hierarchically immediate higher subgroups of the selected subgroup through to the main group to which the selected subgroup belongs are the technical fields to be searched, because there include documents relating to the subject of the search in an even broader scope. If the selected subgroup is in a subgroup according to the "last position rule", then, besides the selected subgroup and its

hierarchically lower subgroups in which the subject of the search are not obviously excluded, the search shall also be performed in the relevant subgroups under those which have the same number of dots as the selected subgroup and their hierarchically lower subgroups in which the subject of the search are not obviously excluded. Moreover, the search shall be performed in the various relevant subgroups at the immediate higher level of the selected subgroup through to the main group. For example, 8/20 is a subgroup with three-dot under C08G8/00. It is a selected subgroup according to the "last position rule", under which there is a four-dot subgroup 8/22. Under 8/20, there is a three-dot subgroup 8/24, which is relevant with and has the same number of dots as 8/20. Above the three-dot subgroups, there are relevant two-dot subgroup 8/08 and one-dot subgroup 8/04. Therefore, the examiner shall perform the search first in subgroup 8/20, then the search shall be carried out in subgroups 8/22, 8/24, 8/08, 8/04 through to the main group 8/00 successively; and

(6) considering other possible main groups or subgroups under the same subclass and other subclasses which are selected in step (2) by using the above-mentioned method.

### 5.4 Analyzing Claims and Determining Search Elements

After reading the application documents, having sufficiently understood the contents of the invention and made a preliminary determination of the IPC symbols and the technical fields to be searched, the examiner shall further analyze the claims and determine the search elements.

#### 5.4.1 Analyzing Claims as a Whole

The examiner shall study the claims to find all the independent claims, and then make a preliminary analysis of the independent claims to determine whether or not the technical solutions claimed in the independent claims fall into the circumstances under which the search is not necessary, as provided in Section 10 of this Chapter.

For searchable claims, the examiner shall find the independent claim of the broadest protection extent and make an analysis of it. Generally, the search shall be first conducted for such independent claim.

### 5.4.2 Determining Search Elements

The examiner shall first analyze the technical solution defined in the independent claim of the broadest protection extent, and determine the basic search elements which can reflect this technical solution. Basic search elements are those searchable elements which can reflect the basic concept of a technical solution. In general, technical fields, technical problems, technical means, technical effects, etc. should be taken into consideration for determining the basic search elements.

After the basic search elements have been determined, the examiner shall, taking account of the features of the technical fields to be searched, determine the expressing means of each element in a computer search system, such as keywords, classification symbols, and chemical structural formulas. In order to make a complete search, it is normally required to express these search elements as far as possible by various means including keywords and classification symbols, and add the search results obtained from the various means altogether to form the search results of said search elements.

In selection of keywords, normally the various synonyms and approximate expressions of the corresponding search element need to be taken into account, and when necessary, the relevant generic term, specific term, other relevant terms, and the various synonyms and approximate expressions thereof, shall also be considered.

In determining the search elements for reflecting a technical solution, the examiner shall not only consider the explicit technical features in the solution, but also consider the equivalent features of some technical features in the solution when necessary. An equivalent feature is the feature that, as compared with the feature described, performs substantially the same function in substantially the same way, produces substantially the same effect, and can be associated by a person skilled in the art with the feature described. In determining equivalent features, such factors as the various alternative embodiments specified in the description and the contents not obviously excluded by the description shall be taken into account.

## 6. Search on an Invention Application

### 6.1 Essentials of Search

When conducting the search, the examiner shall direct his

attention primarily to the novelty and at the same time pay attention to any prior art likely to have a bearing on the inventive step, and find out two or more reference documents that may destroy the inventive step of the subject matter of the application when they are combined together. The examiner shall also pay attention to any document that may be of importance for other reasons, such as documents which may contribute to a better understanding of the subject matter of the application; or the closest prior art documents which are most suitable for illustrating the subject matter of the application and are possible to become the reason for the examiner to invite the applicant to make amendments of the preamble portion of the independent claim and the relevant part of the description.

In the course of the search, the examiner shall pay attention to all of the contents of the patent documents in the prior art, especially the contents of the description (and the drawings) and shall not pay attention to the claims only. The examiner shall compare the contents of the claims of the application to be searched with the contents as disclosed in the relevant patent documents in the prior art.

### 6.2 Sequence of Search

#### 6.2.1 Search in Technical Fields to Which the Invention Pertains

The technical fields to which the invention pertains are the major technical fields of the subject matter of the application. There is the greatest possibility to find the closely relevant documents if the search is conducted in these fields. Therefore, the examiner shall begin the comprehensive search in the patent documents in these fields. For example, if the IPC symbol indicating the invention information is "xxxx7/16...(7/12 having priority)", then the search shall be directed to 7/16 first and then to 7/12; after that, the examiner shall search the various subgroups under 7/16 and 7/12, in which the subject matter of the application are not obviously excluded. Finally, the examiner shall search the subgroup at the immediate higher level up to the main group which covers the subject matter of the application. If there are more than one IPC symbols indicating the invention information, in the same way, the examiner shall search the patent documents in the technical fields defined by other IPC symbols.

As to other subject matters of the application to which the search shall be directed, the search shall be carried out in a similar way in the

technical fields to which it pertains and in the relevant technical fields.

#### 6.2.2 Search in Technical Fields of Similar Function

Based on the search results obtained by carrying out the search according to what is described in Section 6.2.1 of this Chapter, the examiner shall consider whether it is necessary to extend the search to the analogous technical fields. If it is, the search shall be carried out in these technical fields which have analogous function in the way as described in Section 6.2.1 of this Chapter.

#### 6.2.3 Search after Redetermination of Technical Fields

If no reference documents are found after the search described in Sections 6.2.1 and 6.2.2 of this Chapter, it is possible that the technical fields have not been correctly determined. Then, the examiner has to redetermine the technical fields and carry out the search in those fields.

In carrying out the search as described in Sections 6.2.1, 6.2.2 and 6.2.3 of this Chapter, the chronological order of the search, i.e., the sequence of the disclosure date of the search materials to be consulted, shall be, in general, from latest to previous as compared with the filing date of the application.

#### 6.2.4 Search in Other Materials

Where necessary, the examiner shall carry out search in the non-patent literature for search (see Section 2.2 of this Chapter).

Besides, the examiner may consult the documents cited in the reference documents obtained in the above-mentioned Sections 6.2.1-6.2.3, and the relevant documents listed as "reference cited" of the publication of invention applications or publication of invention patents obtained from the search.

### 6.3 Detailed Steps

#### 6.3.1 Manner of Computer Search

When conducting a computer search, in order to make a complete search, the examiner shall express each search element by various means, such as by keywords, classification symbols and chemical structural formulas. For example, for a claim including two basic search elements A and B, the basic search strategy may be as follows:

making an "OR" combination of the search result from classification symbols with that from keywords of search element A as the search result for search element A; making an "OR" combination of the search result from classification symbols with that from keywords of search element B as the search result for search element B; and then making an "AND" combination of the above search result for search element A with that for B as the search result for the claim.

In practical search, the examiner may conduct the search by means of different combinations according to the specific circumstance of the application. For example, the examiner may:

(1) make an "AND" combination of the search result from classification symbols of element A with the search result from keywords of element B;

(2) make an "AND" combination of the search result from classification symbols of element A with the search result from classification symbols of element B;

(3) make an "AND" combination of the search result from keywords of element A with the search result from keywords of element B;

(4) make an "AND" combination of the search result from keywords of element A with the search result from classification symbols of element B; or

(5) make an "OR" combination of the search result from classification symbols with that from keywords of element A, and then make an "AND" combination of the above result with the search result from keywords or classification symbols of the element B.

If no relevant reference document is found by one means of search, the examiner shall consider whether there may be any document possibly missed by this means. For example, in the above search means(1), possibly missed documents include: those documents having the keywords relevant with at least one of A and B but not assigned any of the classification symbols of A; and those documents assigned a classification symbol that is the same as at least one of the classification symbols of A and B, but not having any of the keywords relevant with B. For those possibly missed documents, the examiner shall adjust the means of search to conduct a targeted search. Where no reference document capable of affecting the novelty or inventive step of the technical solution is found by search directed to the combination of search elements A and B, in general, the examiner shall consider the

results from conducting search respectively directed to the individual search elements A or B. If the technical solution involves a plurality of basic search elements, e. g. , basic search elements A, B and C, where no reference document capable of affecting the novelty or inventive step of the technical solution is found, in general, the examiner shall consider conducting search directed to the combinations of the basic search elements, e. g. , the combinations of A + B, A + C and B + C; if necessary, the individual search elements A, B or C shall also be considered.

Furthermore, in the process of computer search, the examiner may also at any time use a relevant document to trace the citing documents, cited documents, inventors, or applicants in order to find further relevant documents.

### 6.3.2 Manner of Manual Search

In the process of manual search, the examiner may consult the patent documents in the following steps.

Step 1: in the search files of the technical fields to be searched, quickly skim through the abstract and figure on the first page of the patent documents and the contents of the independent claims in the claims, the patent abstracts of Japan, Russia (including the former USSR), Germany (including the former Federal Republic of Germany), UK, France, Switzerland, etc., bibliographic data of the Chinese and foreign periodicals and thesis, and pick out those documents which are considered to be relevant to the subject matter of the application after a preliminary judgment. If the application to be searched has drawings showing various detailed structures, the examiner may compare the drawings of the application with those of the documents in the search files one by one, and pick out those documents with the same or similar structures as those in the application.

Step 2: carefully read the abstracts, drawings, and claims of the patent documents selected in Step 1, and the documents corresponding to the abstracts and bibliographic data selected in Step 1, and pick out those documents which are rather relevant to the application.

Step 3: carefully read, analyze and study the descriptions of the documents selected in Step 2, and finally determine the reference documents to be used in the search report and in the Office Action.

### 6.4 Search for Conflicting Applications

#### 6.4.1 Basic Principles

The search for any conflicting application shall be carried out as completely as possible before *Notification to Grant Patent Right* is sent out to an application, that is, the examiner shall search in the updated available patent documents for all the documents of the applications filed before the filing date of the present application and published or announced after said filing date.

#### 6.4.2 Search on an Application Entering Substantive Examination Stage after Publication on Schedule

Usually, an invention application shall be published after the expiration of eighteen months from its filing date and may thereafter enter the stage of substantive examination. In this situation, the search made before the issuance of the first Office Action shall include the search for conflicting applications.

#### 6.4.3 Search on an Application Entering Substantive Examination Stage after Publication ahead of Schedule

Where an invention application is published ahead of schedule and then enters the substantive examination stage, the examiner may preliminarily carry out a search for conflicting applications before the issuance of the first Office Action. If the examination of that application is concluded less than eighteen months after the filing date of that application, the examiner shall carry out supplementary search step by step depending on the introduction of the conflicting applications into the patent documents for search. If the examination is concluded on or after the date of expiration of eighteen months from the filing date, the examiner shall make a further search for conflicting applications before the examination is concluded.

### 7. Search to Avoid Double Patenting

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In order to avoid double patenting, the search shall be conducted as completely as possible before *Notification to Grant Patent Right* is sent out to an application, that is, applications or the patent documents relating to identical inventions-creations which are present in the Chinese patent documents shall be found out. For judgment of identical

inventions-creations, Chapter 3, Section 6 of this Part shall apply.

## 8. Termination of Search

### 8.1 Limit of Search

Theoretically, a perfect search shall be comprehensive and complete. However, the search shall be limited in view of reasonableness of cost. The examiner shall, at any time, determine whether the search shall be stopped according to the quantity and quality of the selected reference documents. The factors to be considered are the balance of time, energy and cost spent on the search and the expected results.

### 8.2 Several Circumstances of Termination of Search

The examiner may terminate the search when one of the following circumstances occurs during the search:

(1) where a reference document closely related to all of the subject matters of the application has been found out, so that the examiner thinks that the document has clearly disclosed all of the technical features of all the subject matters of the application or the contents disclosed by the document may enable a person skilled in the art to obtain all of the technical solutions described in the claims, that is, the novelty or inventive step of all of the subject matters of the application are prejudiced by that reference document alone, and that document constitutes a document at category "X" or category "E" provided by the search report;

(2) where two or more reference documents closely related to all of the subject matters of the application have been found out, so that the examiner thinks that a person skilled in the art can easily combine them to obtain all of the technical solutions of the claims, that is, the inventive step of all of the subject matters of the application are prejudiced by the combination of these reference documents, and these documents constitute documents at category "Y" provided by the search report;

(3) where according to his knowledge and working experience, the examiner thinks that it is impossible to discover closely related reference documents, or the time, energy and cost spent on the work is not commensurate with the expected results, it is therefore not worth continuing the search; or

(4) where closely related reference document(s) mentioned in the

above paragraph (1) or (2) (usually the document(s) of category "X" or "Y" as specified in the search report) is found from the materials provided by the public or from the foreign search materials or foreign examination results provided by the applicant.

## 9. Search under Special Circumstances

### 9.1 Search on an Application of Which the Subject Matter Covers More than One Technical Field

Where the subject matter of an application covers different technical fields, as the case requires, the examiner shall, in addition to making search in the technical field in which he works, consult the examiners working in the other technical fields to decide how to make further search.

### 9.2 Search on an Application Which Lacks Unity

#### 9.2.1 Search on an Application Which Lacks Unity Obviously

Where it can be determined that unity does not exist between the subject matters of an application after the examiner analyzes and studies the claims and description (and the drawings), one of following measures may be taken:

(1) performing search after the applicant makes necessary amendments to eliminate the defect of lack of unity; or

(2) where all of the technical solutions described in two or more independent claims, between which unity is not present, fall into the technical field in which the examiner is responsible for performing examination and the search fields of them are very close or even overlap to a great extent, the examiner may make search for them together under the circumstance that it takes little or no additional search effort. As a result, the examiner may both indicate the defect of the lack of unity and evaluate these independent claims when drafting the Office Action. In this way, the procedure of examination can be accelerated by reducing one Office Action. If one or more independent claims of the application are found to lack novelty or inventive step after search, the applicant may delete these claims rather than make divisional application(s) after receiving the Office Action, thus unnecessary work is avoided by doing so. Moreover, the reference documents which further indicate that unity is not present between the subject matters of the

application may be found through such search.

### 9.2.2 Search on an Application Which Lacks Unity Nonobviously

An application that does not obviously lack unity refers to the application in which whether the unity is present between its claimed subject matters can be determined only after the search. The examiner shall perform the search for such an application in a way as follows:

(1) when making a search for the first independent claim, if the examiner finds that the claim is lack of novelty or inventive step after the search, according to the principles of examination on unity as provided in Chapter 6, Section 2.2.1 of this Part, he shall determine whether there exists unity between the remaining independent claims. Search is not required for those independent claims which lack unity;

(2) where the inventive concept of two or more inter-parallel independent claims of an application are very close, and none of the independent claims needs to be searched in other technical fields, the examiner may make search for all of the subject matters of the application, because it will not greatly increase the workload; and

(3) when making search directed to an independent claim, if the examiner finds the claim lack of novelty or inventive step, which causes that unity is not present between its inter-parallel dependent claims, the examiner may apply *mutatis mutandis* the methods described in Section 9.2.1(1), 9.2.1(2), 9.2.2(1) or 9.2.2(2) of this Chapter to handle it.

### 9.3 Search under Other Circumstances

Where part of the subject matters of an application fall into the situations described in Section 10 of this Chapter, the examiner shall make search directed to the other subject matters that are not in these situations. Where the defect of lack of unity exists between the other subject matters that are not in these situations, the search shall be made in accordance with the provisions of Section 9.2 of this Chapter.

## 10. Subject Matters for Which Search is Not Required

It is not necessary for the examiner to make the search if all of the subject matters of an application fall into one of the following circumstances:

(1) falling into the circumstances mentioned in Articles 5 and 25 according to which no patent right shall be granted for the application;

(2) contravening Article 2. 2;

(3) lacking practical applicability;

(4) the description and claims fails to set forth clearly and completely the subject matters of the application so that a person skilled in the art cannot carry it out.

## 11. Supplementary Search

During the course of the substantive examination of an application, in order to obtain more suitable reference documents, the examiner shall make a supplementary search under any of the following circumstances:

(1) where the applicant has amended the claim(s), but the earlier search did not cover the protection extent claimed in the amended claim(s);

(2) where the clarification of the applicant makes the earlier search incomplete or inaccurate;

(3) where the earlier search made before the issuance of the first Office Action is incomplete or inaccurate; or

(4) where the change of the Office Action makes the earlier search incomplete or inaccurate so that it is necessary to increase or change the technical fields to be searched.

During the course of restored examination after reexamination, if any of the above circumstances occurs, the supplementary search shall be made.

Moreover, as to the international patent application designating China which may constitute a conflicting application, as described in Section 4. 2(2) of this Chapter, a supplementary search shall be made before *Notification to Grant Patent Right* is sent to an application to check whether the international patent application has entered the national phase of China and has been published in Chinese.

## 12. Search Report

The search report is used to record the results of the search, especially the documents which constitute the relevant prior art. The search report shall use the form prescribed by the Patent Office, and it shall clearly record the technical fields and databases to be searched, the basic search elements used and their expressions (e. g., keywords, etc.), and the reference documents obtained by the search with symbols showing the level of relevance of the reference documents with

the subject matter of the application. The examiner shall fill in all other items as required in the form of search report.

In a search report, the following symbols are used to express the relevance of a reference document with a claim:

"X": the document that when taken alone, prejudices the novelty or inventive step of the claim;

"Y": the document that when combined with other such documents cited in the search report, prejudices the inventive step of the claim;

"A": the document defining the general state of the art, i. e. , the document that reflects part of the technical features of the claim or the relevant prior art;

"R": the patent or patent application document belonging to identical invention-creation that was submitted to the Patent Office by any entity or individual on the date of filing;

"P": the intermediate document, that is the document published on dates falling between the filing date of the application being examined and the claimed priority date, or the document that causes necessity to verify the priority of the application; and

"E": the conflicting application document that when taken alone, prejudices the novelty of the claim.

Among the above categories of documents, symbols "X", "Y" and "A" indicate the relevance of a reference document with a claim of the application in contents; symbols "R" and "E" indicate the relevance of a reference document with a claim of the application both in time and in contents; and symbol "P" indicates the relevance of a reference document with a claim of the application in time, which shall be followed by a symbol of "X", "Y", "E" or "A" indicating the relevance of the document in contents. Symbol "P" is used under the circumstance that the priority of an application has not been verified.

Where a claim includes several parallel technical solutions and the level of interrelationship between a reference document and these technical solutions are different, the examiner shall use the symbol which represents the highest level of interrelationship to indicate the reference document.

Besides the documents of above categories, other documents cited in the Office Action shall also be filled in the search report, without the category symbols and/or the claims related to.

# Chapter 8 Procedure for Substantive Examination

## 1. Introduction

According to Article 35, the Patent Office shall perform substantive examination for an application for invention.

The purpose of substantive examination is to judge whether the patent right shall be granted to an invention application, especially whether the application meets the requirements of novelty, inventive step and practical applicability as set out in the relevant provisions of the Patent Law.

In accordance with Article 35.1, the procedure for substantive examination usually shall be started upon the request of the applicant. However, in accordance with Article 35.2, such substantive examination may be started by the Patent Office on its own initiative.

In accordance with Article 39, where it is found upon substantive examination that there is no grounds for rejection of the invention application, the Patent Office shall make a decision to grant the patent right for invention.

In accordance with Article 38, in the course of substantive examination, where, after the applicant has made the observations or amendments, the Patent Office finds that the invention application is still not in conformity with the provisions of the Patent Law, i. e., it still has defects falling into the situations described in Rule 53, the application shall be rejected.

In accordance with Article 32, an applicant may withdraw his application at any time before the patent right is granted. Furthermore, in Articles 36.2 and 37 and Rule 42.2, circumstances are described where an application shall be deemed to be withdrawn in the procedure for substantive examination.

The substantive examination in this Chapter refers to the substantive examination to a Chinese invention application. As for the substantive examination of an international application in the Chinese national phase, where there are specific provisions in Chapter 2 of Part Ⅲ of these Guidelines "Substantive Examination of International Applications Entering the National Phase", the examination shall be conducted in accordance with those provisions; where there is no specific provi-

sions, the provisions of this Chapter shall apply.

## 2. Procedure for Substantive Examination and Basic Principles Thereof

### 2.1 Outline of Procedure for Substantive Examination

Circumstances that may occur in the procedure for substantive examination are as follows:

Art. 37

(1) where the examiner, after making substantive examination of the invention application, finds that the application is not in conformity with the provisions of the Patent Law and its Implementing Regulations, he shall notify the applicant and request him to submit his observations or, if necessary, to amend the application within a specified time limit. The notification (e. g., *Notification of the Office Action, Notification to Make Divisional Application, Notification to Submit Materials,* etc.) issued by the examiner and the response made by the applicant may be repeated for several times until the patent right is granted to the application or the application is rejected or withdrawn or deemed to be withdrawn;

Art. 39

(2) where it is found, upon substantive examination, that there is no grounds for rejection of an application, or the initial defects in the application have been overcome after the observations or amendments have been made by the applicant, *Notification to Grant Patent Right* shall be issued;

Art. 38

(3) where, after the applicant has made the observations or amendments, the examiner finds that the defects falling into the situations described in Rule 53, which have been pointed out in the Office Action still exist in the application, the application shall be rejected; and

Art. 37 & 36.2
Rule 42.2

(4) where, without any justified reason, the applicant fails to reply in due time to *Notification of the Office Action*, *Notification to Make Divisional Application*, or *Notification to Submit Materials,* etc., the examiner shall send *Notification that Application Deemed to be Withdrawn.*

Furthermore, where necessary, the examiner may have interview, telephone discussion or on-spot investigation in the procedure for substantive examination according to the provisions of these Guidelines.

### 2.2 Basic Principles in Procedure for Substantive Examination

(1) Principle of examination upon request

Except in certain special cases provided for in the Patent Law and its Implementing Regulations, the procedure for substantive examination shall be started only upon the request of the applicant. The examiner shall perform the examination on the basis of the application documents (including those submitted when the application was filed, when amendment was made according to the Patent Law or when response to the Office Action was made) duly submitted by the applicant according to the Patent Law.

(2) Principle of hearing

In the course of substantive examination, at least one opportunity of stating observations and/or amending application documents against the facts, grounds and evidence on which the rejection relies shall be given to the applicant before the decision of rejection is made, that is, the facts, grounds and evidence on which the rejection relies shall be notified to the applicant before the examiner makes a decision of rejection.

(3) Principle of procedural economy

In the course of substantive examination of an invention application, the examiner shall make the examination procedure as brief as possible. In other words, the examiner shall try his best to close the case as early as possible. To reach this aim, the examiner shall indicate all the defects of the application which are not in conformity with the Patent Law and its Implementing Regulations in the first Office Action and invite the applicant to make response for all the issues within the specified time limit, unless he is sure that the application is not possible to be granted the patent right. The correspondence between the examiner and the applicant shall be reduced to the least to economize on procedure.

However, the examiner shall not neglect the principle of examination under request and the principle of hearing for the reason of economizing on procedure.

## 3. Verification of Application Documents and Preparation of Substantive Examination

### 3.1 Verification and Check of IPC Symbol of Application

On receiving an application, the examiner shall, no matter whether the examination will be conducted in the near future, first verify and check the IPC Symbol of the application.

When the examiner finds that the application is beyond his responsibility, he shall timely deal with it in accordance with the rules of coordination of classification so as not to delay the examination.

Where the examiner finds that although the classification Symbol is not precise, but still belongs to his responsibility, he shall correct it on his own initiative.

### 3.2 Verification of Application File

For the application files within his responsibility according to classification, or for the applications allocated to him, the examiner shall timely check them, no matter whether they are to be examined in the near future. For documents on formalities and other documents not related to the substantive examination, which shall be handled by other departments, the examiner shall deliver these documents to the corresponding departments in time to avoid any delay.

Art. 35; Rule 50

#### 3.2.1 Check of Grounds for Initiating the Procedure

The examiner shall check whether a request for the substantive examination is included in the application file, whether it was submitted within three years from the date of filing (for divisional application, see Chapter 1, Section 5.1.2 of Part I of these Guidelines), and whether *Notification of Publication and Entering the Substantive Examination Stage of the Application* is included in the application file. Where the Patent Office, on its own initiative, determines to proceed the substantive examination to the invention application, the examiner shall check whether there is a notification with the signature of the Commissioner and the record indicating that the applicant has been notified.

Art. 26.1
Rule 51.1

#### 3.2.2 Check of Application Documents

The examiner shall check whether the documents for substantive examination (including initial application documents and published documents, and the amended documents if the applicant has, on his own initiative or upon the request of the Patent Office in the course of preliminary examination, made any amendment of the documents) are complete.

Art. 30

#### 3.2.3 Check of Material Related to Priority

Where the applicant claims the right of foreign priority, the examiner shall check, in the application file, whether there are declaration of

claiming the right of priority and copy of the earlier patent application documents certified by the competent authority of the foreign country or the inter-governmental organization in which the earlier application was filed. Where the applicant claims the right of domestic priority, the examiner shall verify, in the application file, whether there are declaration of claiming the right of priority and copy of patent application documents that were first filed in China.

Art. 36. 2; Rule 49

#### 3. 2. 4 Check of Other Relevant Documents

For an invention application that has already been filed in a foreign country, the examiner shall check, in the application file, whether there are documents submitted by the applicant that concern the search for the purpose of application examination or the results of examination made in that country.

Art. 36. 2

#### 3. 2. 5 Handling of Application File with Defect

Where the examiner finds any ground, document or material mentioned in the above-mentioned Sections 3. 2. 1 to 3. 2. 3 missing in an application file, or any documents not in conformity with the provisions of the Patent Law and its Implementing Regulations, he shall return the application to the Procedure Administration Department and state the reason for doing so. When the examiner finds that the materials mentioned in the above-mentioned Section 3. 2. 4 are missing in an application file, and he is sure that the applicant has obtained such materials, he may fill in *Notification to Submit Materials* and invite the applicant to submit the relevant materials within the specified time limit of two months. If the applicant fails to do so without any justified reason, the application shall be deemed to be withdrawn.

Besides, before substantive examination is conducted, it is preferable for the examiner to have a rough reading of the application documents to see if it is necessary to invite the applicant to submit any relevant reference materials. If it is, the examiner may fill in *Notification to Submit Materials* to notify the applicant to submit such materials within the specified time limit of two months. To finish this work in advance may accelerate the examination procedure.

### 3. 3 Establishment of Personal Examination File

After checking the application file, the examiner shall establish a personal examination file to record the important information of the

application examined by himself and add relevant information in the subsequent stages of examination, so as to have the information of the examination proceedings and the basic status of each application in hand at any time.

### 3.4 Order of Examination

#### 3.4.1 General Principles

Except for the special circumstances described in Section 3.4.2 of this Chapter, the examination shall be performed according to the order of receipt for all the invention applications that are received. However, the applications belonging to the same category received successively may be handled together.

After the applicant responses to the first Office Action, the examiner shall continue the examination in the order of the time of receiving the responses.

#### 3.4.2 Special Treatment

There may be special treatment in the following circumstances:

(1) for applications having great significance to the interest of the State or to the public interest, upon the request of the applicant or the competent authorities concerned and with the approval of the Commissioner of the Patent Office, examination may be conducted first and handled with priority in the later examination proceedings;

Art. 35.2

(2) for applications of which the substantive examination is started on the initiative of the Patent Office, examination may be conducted with priority; and

(3) for divisional applications of which the original dates of filing are retained, examination may be conducted together with that of the original application.

## 4. Substantive Examination

### 4.1 Text of Examination

Usually, the text of examination used by the examiner for the first time is the initial application documents submitted by the applicant according to the Patent Law and its Implementing Regulations or the documents amended upon the request of the preliminary examination department of the Patent Office.

Rule 51. 1

Where the applicant has made amendments to the invention application on his own initiative, when a request for substantive examination is made or within three months after the receipt of the *Notification of Entering the Substantive Examination Stage of the Application* issued by the Patent Office, the amended application documents submitted by the applicant shall be used as the text of examination no matter whether the content of amendments goes beyond the scope of disclosure contained in the initial description and claims.

Where the applicant has made amendments to the application documents several times on his own initiative within the above-mentioned time limit, the application documents last submitted shall be used as the text of examination. Generally, the amendment of the application documents made by the applicant on his own initiative in time period other than the above-mentioned prescribed time limit shall not be accepted. The amended application documents submitted by the applicant shall not be used as the text of examination. The examiner shall state the reasons thereof in the Office Action and use the previous acceptable documents as the text of examination. Where, though the amendments made by the applicant is not in conformity with the provisions of Rule 51. 1, if the examiner thinks, after reading them, that the amended documents have eliminated the defects existing in the initial application documents and meet the requirements of the provisions of Article 33, and taking the amended text as the basis for examination can help economize the examination procedure, such amended documents may be accepted as the text of examination.

### 4. 2 Reading of Application Documents and Understanding of Invention

After the substantive examination is started, the examiner shall read the application documents carefully first, and try to understand the invention accurately. The examiner shall put emphasis on understanding the technical problem to be solved and the technical solution for solving said technical problem, figuring out all the essential technical features of the technical solution, especially those which are different from that of the background art, and understanding the technical effect produced by said technical solution. Necessary notes may be taken when reading and figuring out the invention so as to facilitate further examination.

### 4.3 Issuance of Office Action without Search

Where all the subject matters of an application obviously fall into the circumstances described in Chapter 7, Section 10 of this Part, the examiner may issue the first Office Action without making any search.

It shall be noted that, in cases where only some, and not all of the subject matters of an application belong to the above-mentioned circumstances, the first Office Action shall be issued after the search has been conducted to the subject matters which do not belong to said circumstances.

### 4.4 Handling of Application Lacking Unity

The defect of lacking unity is sometimes obvious for an application, and sometimes it can only be determined after the search and examination have been conducted. The defect of lacking unity may exist between the inter-parallel independent claims or between the inter-parallel dependent claims because the independent claim referred to by them does not possess novelty or involve an inventive step, or between the inter-parallel technical solutions in one claim.

Art. 31.1
Rules 34 & 42.2

The examiner may handle the application lacking unity by using one of following methods.

(1) To invite the applicant to make amendments before search

If the examiner, at the time of reading the application documents, can immediately come to the conclusion that there obviously lacks unity between the subject matters of the application, the search may be postponed (see Chapter 7, Section 9.2.1(1) of this Part). *Notification to Make Divisional Application* may be issued, in which the applicant is invited to make amendments to the application within the specified time limit of two months.

(2) To invite the applicant to make amendments after search

If the lack of unity for the subject matters of an application can be decided only after search, the examiner may, according to circumstances, decide either to put off further search and examination, or to continue further search and examination (see Chapter 7, Section 9.2.2 of this Part).

If after search and examination, it is believed that the first independent claim or its dependent claim has prospect of being granted the patent right, and there lacks unity between other independent claims and the claim having prospect of being granted the patent right, the ex-

aminer may put off the search and examination for the other independent claims and only make observations of examination with regard to the first independent claim or its dependent claim, and invite the applicant to delete or amend other claims which lack unity in order to eliminate the defect of lacking unity of the application.

If after search and examination, it is believed that the first independent claim and its dependent claim do not have prospect of being granted the patent right, and there lacks unity between other independent claims, the examiner may put off the search and examination for the other independent claims, indicate in the first Office Action that the first independent claim and its dependent claim do not have prospect of being granted the patent right, and at the same time, indicate the defect of lacking unity in the application, or the examiner may continue to conduct the search and examination to other independent claims especially when the search fields are very close or overlap to a great extent, and in the meanwhile point out the defect of lacking unity and other defects in the first Office Action (see Chapter 7, Section 9.2.2 (1) or (2) of this Part).

If, according to the requirements of the first Office Action, the applicant has made amendments which are in conformity with the provisions of Section 5.2 of this Chapter to the application, and there is no longer the defect of lacking unity in the claims, the examiner shall continue the examination to the claims.

For situations where there is no unity between the inter-parallel dependent claims because the independent claim to which they refer does not possess novelty or involve an inventive step, the above-mentioned provisions (1) or (2) shall apply *mutatis mutandis*.

It shall be noted that, although sometimes there is no unity between the subject matters of the application, especially when the lack of unity between the inter-parallel dependent claims results from the fact that the corresponding independent claim does not possess novelty or involve an inventive step, however, the relevant search fields of them are very close or even overlap to a great extent. Under such circumstances, it is preferred that the examiner searches and examines these claims together and indicates in the Office Action the defects in these claims that are not in conformity with the other provisions of the Patent Law and its Implementing Regulations, and at the same time, the defect of lacking unity in the application, so as to economize the examination procedure [see Chapter 7, Section 9.2.1(2) of this Part].

Rule 42.2

No matter the application is under situation (1) or (2) as described above, the applicant shall, within the specified time limit, amend his application, such as to restrict the claims to eliminate the defect of lack of unity. If no response has been made by the applicant within the time limit, the application shall be deemed to be withdrawn.

Where the applicant has opposite opinion in his response to the Office Action of the examiner on the defect of lacking unity of the application, and the examiner thinks that the opinion of the applicant is tenable, or said defect is eliminated after the claims have been amended by the applicant, the examination procedure of the application shall be continued. Where the opposite opinion is untenable or the defect of lack of unity has not been eliminated, the examiner may reject the application according to provisions of Article 38.

### 4.5 Search

Search shall be conducted for every invention application before it is granted the patent right. For how to determine the technical field of search and how to proceed the search, see Chapter 7 of this Part.

### 4.6 Verification of Right of Priority

#### 4.6.1 Circumstances Where Verification of Right of Priority is Needed

Whether it is necessary to verify the right of priority shall be decided by the examiner after searching. Where the dates of publication of all the reference documents are earlier than the priority date, no verification of right of priority is necessary. Such verification is needed when one of following events occurs:

(1) the disclosure of a reference document is identical with or closely related to the subject matter of the application, and the date of the publication of the reference document is between the date of filing and the priority date. That is, the reference document constitutes the document of category "PX" or "PY";

(2) the disclosure of an application filed by any entity or individual with the Patent Office is identical with some or all of the subject matters of the application. Moreover, the date of filing of the former application is between the date of filing and the priority date of the latter, and the date of publication or announcement of the former is on or later than the date of filing of the latter. That is, the application filed

by any entity or individual with the Patent Office constitutes the document of category "PE"; or

(3) the disclosure of an application filed by any entity or individual with the Patent Office is identical with some or all of the subject matters of the application. Moreover, the priority date of the former application is between the date of filing of the latter and the priority date of the latter, and the date of publication or announcement of the former is on or later than the date of filing of the latter. That is, the application filed by any entity or individual with the Patent Office constitutes the document of category "PE".

As for the circumstances described in item (3), the verification of right of priority of the application under examination shall be conducted first. If its claim of right of priority is invalid, the claim of right of priority of the application which is filed by any entity or individual with the Patent Office and used as the reference document shall also be verified.

### 4.6.2 General Principle on Verification of Right of Priority

Generally speaking, verification of right of priority refers to the verification of whether the right of priority claimed by the applicant is valid according to the provisions of Article 29. To this end, the examiner shall, on the basis of the examination performed by the preliminary examination department (see Chapter 1, Section 6.2 of Part I of these Guidelines), verify the following:

(1) whether the earlier application, which is used as the basis of the right of priority, involves the same subject matter as that of the later application for which the priority is claimed;

(2) whether this earlier application is the first application in which the same subject matter is described; and

(3) whether the date of filing of the later application is within twelve months from the date of filing of the earlier application.

The verification mentioned in item (1) is to judge whether the technical solutions contained in the claims of the later application are clearly described in the documents (the description and claims, not including the abstract) of said earlier application. For this purpose, the examiner shall analyze and study the earlier application in its entirety. If the technical solution described in the claim of the later application is clearly described in the documents of the earlier application, it shall be assured that the earlier application has the same subject matter as

the later application. The examiner cannot refuse to accept the claim of priority right based on the view that such technical solution is not contained in the claims of the earlier application.

By the phrase "clearly described", it does not mean the way of illustration is completely identical. It is sufficient if the technical solutions described in the claims of the application have been set forth. However, where one or more technical features of said technical solutions are just generally or ambiguously described in the earlier application, or where there is only a hint in the earlier application, if the detailed description of such technical features is described in the application claiming for the priority right, and a person skilled in the art cannot directly and unambiguously derive it from the earlier application, the earlier application cannot serve as the basis for claiming the right of priority.

Under certain circumstances, the content described in item (2) shall be checked. For example, the right of priority for an application A is claimed on the basis of another earlier application B of the applicant. In the course of searching for application A, the examiner finds another patent application document or patent document C of the same applicant which is published or announced between the date of filing and the priority date of application A. The subject matter of application A has been disclosed in document C and the date of filing of document C is earlier than the priority date of application A, i. e., earlier than the date of filing of application B. Thus, it may be assured that the earlier application B is not the first application of that applicant which described the identical subject matter as that of the application A. As a result, application A shall not claim the date of filing of the earlier application B as its priority date.

#### 4.6.2.1 Verification of Partial Priority

When improvement or perfection is made to the invention of the earlier application, the applicant may introduce into the later application the technical solution which is not included in the earlier application. Under such circumstances, in verifying the right of priority, the examiner shall not come to the conclusion that the claim of right of priority is not valid because new contents are added into the later application. The priority right shall be granted to the identical subject matter of the later application that is clearly described in the earlier application, i. e., partial priority shall be granted. Speaking in detail, for

the claims of the later application, the claim of right of the priority of an earlier application is valid when the technical solutions of them have been clearly described in the earlier application; however, the claim of priority of an earlier application is not valid when the technical solutions of them have not been described in the earlier application, and these claims shall be deemed to be put forward on the date of filing of the later application. So far as the whole application is concerned, this is called partial priority, i. e. , parts of the subject matters of the application have valid right of priority. In other words, the technical solutions defined by part of the claims have valid right of priority.

#### 4.6.2.2 Verification of Multiple Priorities

Rule 32.1

Where multiple priorities are claimed by an application which meets the requirement of unity, in verifying the right of priority, the examiner shall check whether the various technical solutions included in the claims of the application have been clearly described respectively in the foreign or domestic applications serving as the basis for claiming the priority. Moreover, it is also necessary for the examiner to verify whether all the dates of filing of the earlier applications are within the time limit of the priority of the later application. If these two requirements are satisfied, the claim of multiple priorities is valid. The various claims in which the various technical solutions are described will possess different dates of priority. If some of the claims do not satisfy the above-mentioned requirements, but the other claims do, the claim to the right of priority of the former shall not be valid, while the claim to the right of priority of the latter shall be valid.

Where different technical features are described respectively in different foreign or domestic applications which serve as the basis for claiming the right of priority and the claims of the later application are the combination of these features, the claim to multiple priorities is not valid.

#### 4.6.3 Handling Procedure after Verification of Right of Priority

Where the right of priority of an application is not valid after the verification, the examiner shall state the reasons for the invalidity of right of priority in the Office Action, and continue forward examination on the basis of the newly determined priority date (or the date of filing where there are no other rights of priority). When the application

is granted the patent right, the examiner shall change the right of priority thereof in *Notification of Change in Bibliographic Data*.

**4.7 Comprehensive Examination**

So far as procedure are concerned, reasons of economy dictate that the examiner makes a comprehensive examination of the application before the first Office Action is issued, i. e. , to examine whether the application is in conformity with all the provisions of the Patent Law and its Implementing Regulations relating to the formalities and substance of the application.

The emphasis of the examination shall be whether there is any situation as described in Rule 53 in the description and the whole of the claims. In general, first of all, the examiner shall examine whether the subject matter of the application falls into the circumstances mentioned in Article 5 or 25 according to which no patent right shall be granted for the application; whether the subject matter of the application is in conformity with the provisions of Article 2. 2; whether it possesses the practical applicability as required in Article 22. 4; and whether the description has sufficiently disclosed the claimed subject matter of the application, which is required by Article 26. 3. Then, the examiner shall examine whether the technical solutions defined by the claims possess novelty and involve inventive step as required in the provisions of Article 22. 2 and Article 22. 3; whether the claims are supported by the description and define the extent of the patent protection sought for in a clear and concise manner as required in the provisions of Article 26. 4; whether a complete technical solution to solve the technical problem has been described in the independent claim. In the course of the above-mentioned examination, the examination shall be carried out to decide whether there is defect of lacking unity in the claims; whether the amendments of the application are in conformity with the provisions of Article 33 and Rule 51; whether the divisional applications are in conformity with the provisions of Rule 43. 1; and whether the application document is in conformity with the provisions of Article 26. 5 for the invention-creation which is developed relying on the genetic resources.

Rule 20. 2

Art. 31. 1

If the examiner can reasonably doubt that the invention contained in the application has been developed in China, and the applicant does not request the Patent Office for confidentiality examination before filing the application for patent abroad, the examiner shall examine

whether the application is in conformity with the provisions of Article 20.

Rules 17-19 & 21-23

Where no situations described in Rule 53 exist in the application; or although there are substantive defects falling into the situations described in Rule 53, the application still has the prospect of being granted the patent right after some amendments, for the sake of economy in procedure, the examination of whether all the other provisions of the Patent Law and its Implementing Regulations are complied with shall be conducted by the examiner as well.

For examiners who have already clearly understood the claimed subject matter of the application as well as its contributions to the prior art after search, the main job at this stage is to make a positive or negative judgment to the above-mentioned emphases of examination according to search results.

### 4.7.1 Examination of the Claims

In accordance with the provisions of Article 26.4, the claims shall be supported by the description and shall define the extent of the patent protection sought for in a clear and concise manner. In accordance with the provisions of Article 59.1, the extent of protection of the patent right shall be determined by the terms of the claims. To this end, the substantive examination shall be focused on the claims, especially on the independent claim(s).

In general, after it is determined that the subject matter of the application does not fall into the circumstances mentioned in Article 5 or 25 according to which no patent right shall be granted for the application, is in conformity with the provisions of Article 2.2, and possesses the practical applicability provided in Article 22.4, and the claimed subject matter of the application has been sufficiently disclosed in the description, the following examination shall be conducted to the claims.

Art. 22.2 & .3

(1) To examine whether the independent claim possesses novelty and involves an inventive step in accordance with the provisions of Chapter 3 and Chapter 4 of this Part.

If the independent claim is believed to lack novelty or inventive step upon examination, further examination shall be carried out to determine whether the dependent claims possess novelty and involve inventive step. If it is found after examination that none of the independent claims and dependent claims possesses novelty or involves an in-

ventive step, it is not necessary to continue examination for claims.

If it is found upon examination that the independent claim possesses novelty and involves an inventive step, or although the independent claim lacks novelty or inventive step, the dependent claims possess novelty and involve inventive step, and the application has the prospect of being granted the patent right, the examiner shall, according to the principle of procedural economy, carry out the examination of (2) to (7) in the following to the claims.

Art. 26. 4

(2) To examine whether all the claims are supported by the description (and the drawings), and whether the claims define the extent of the patent protection sought for in a clear and concise manner.

Rule 20. 2

(3) To examine whether the independent claim indicates a complete technical solution to solve the technical problem the invention aims to settle. The crux of determining whether the technical solution is complete lies in checking whether all the essential technical features for solving said technical problem have been described in the independent claim.

(4) To examine whether the dependent claims are in conformity with the provisions of Rules 20. 3 and 22.

Rule 21. 3

(5) To examine whether one invention has only one independent claim and whether the claim precedes all the dependent claims relating to the same invention.

Rule 19. 3

(6) To examine whether the standard scientific and technical terms (scientific and technological terms) used in the claims are in conformity with the provisions of Rule 3. 1 and consistent with those used in the description.

Art 9. 1

(7) If a reference document belonging to identical invention-creation has been found through search, which is submitted by any entity or individual on the same date of filing, double patenting of identical claims shall be avoided. The provisions of Chapter 3, Section 6 of this Part shall apply to the handling of identical invention-creation. Where there are two or more invention applications concerning identical invention-creation, these applications shall be examined by the same examiner. In principle, the examination shall be conducted by the examiner who first puts forward a request to transfer one of these applications.

It shall be noted that, for some applications, there may exist such defects as ambiguity of claims, which make the examiner unable to examine the novelty and inventive step of the claims first. In this case,

the examiner shall first examine these defects, and at the same time, according to his understanding of the description, he may also make observations on the novelty and inventive step of the technical solutions in the description for the applicant's reference.

### 4.7.2 Examination of Description and Abstract

Art. 26.3 & .4
Art. 59.1

The description (and the drawings) shall set forth the invention in a manner sufficiently clear and complete so as to enable a person skilled in the art to carry it out. In the meanwhile, it, as the basis of the claims, shall be used to interpret the contents of claims when the extent of the protection of the patent right is determined.

The examiner shall conduct the following examination to the description and drawings:

Art. 26.3

(1) whether the description (and the drawings) has set forth the invention in a manner sufficiently clear and complete so as to enable a person skilled in the art to carry it out; whether the technical solutions described in the description are able to solve the technical problem of the invention and achieve the expected advantageous effects (see Chapter 2, Section 2.1 of this Part);

Art. 26.4; Rule 17

(2) whether the extent of protection defined by the technical solution of each claim is supported by the description and whether the technical solutions contained in the part of "Contents of Invention" of the description are consistent with the corresponding technical solutions defined by the claims; and

(3) whether the relevant contents mentioned in Rule 17 are included in the description; and whether the description is drafted in the required manner and order by using standard terms and clear wording (see Chapter 2, Section 2.2 of this Part).

If the drafting of the description in other manner or order can result in a more economical presentation and an accurate understanding of the invention by others due to the nature of the invention, such drafting manner or order may be allowed in accordance with the provisions of Rule 17.2.

Where one or more nucleotide or amino acid sequences are included in the application, the examiner shall examine whether the description contains a sequence listing in conformity with the provisions.

As for the application having drawings appended, the examiner shall examine whether the drawings meet the requirements of Rule 18 (see Chapter 2, Section 2.3 of this Part).

For applications of which drawings are not necessary, the description may not contain the contents as provided for in Rule 17. 1(4).

Rule 3. 1

Moreover, the examiner shall check whether the scientific and technological terms used in the description are the standard ones; and for the name of a foreigner or a foreign place, as well as for some scientific and technological terms, whether the original language are provided when no standard Chinese translations are available.

Rule 23

The examiner shall attach importance to the examination of the abstract. The provisions of Chapter 2, Section 2. 4 of this Part shall apply to the examination of the abstract.

If, after the examination performed in accordance with Section 4. 7. 1(1) of this Chapter, the examiner believes that all the claims lack novelty or inventive step, attention shall be paid to whether there is any other technical solution included in the description, which belongs to a single general inventive concept with the original independent claim, and possesses novelty and involves an inventive step, so as to determine whether the application belongs to situation (3) or (4) as listed in Section 4. 10. 2. 2 of this Chapter.

Art. 26. 5

Rule 26. 2

**4. 7. 3 Examination of Other Application Documents**

For the inventions-creations developed relying on the genetic resources, the examiner shall examine whether the applicant has submitted the *Registration Form for Indicating Source of Genetic Resources* prepared by the Patent Office, and whether the direct and original source of genetic resources are indicated in said form; where no original source is indicated, the examiner shall examine whether the applicant has stated the reasons thereof.

**4. 8 Non-Comprehensive Examination**

Usually, for the sake of procedural economy, the comprehensive examination shall be performed for an invention application in accordance with Section 4. 7 of this Chapter.

However, where there exists a serious defect in the application documents which is not in conformity with the provisions of the Patent Law and its Implementing Regulations, i. e. , when there exist defects falling into situations listed in Rule 53, and that it is impossible to grant the patent right to said application, the examiner may not conduct the comprehensive examination on said application. He just needs to indicate the substantive defects which lead to the conclusion of exami-

nation in the Office Action, at this time, there is no sense in pointing out the less important substantive defect and/or formal defect in the application.

Rule 48

### 4.9 Handling of Public Opinion

The observations submitted by anyone to the Patent Office on an invention application not in conformity with the provisions of the Patent Law shall be included in the application file, and the examiner shall take them into consideration in the course of substantive examination. It is not necessary for the examiner to consider the observations submitted after the issuance of *Notification to Grant Patent Right*. The handling of the observation submitted by the public does not need to be notified to the public concerned.

### 4.10 First Office Action

#### 4.10.1 General Requirement

After substantive examination for an application, the observations and the tendentious conclusion of the examination shall be notified to the applicant in the form of Office Actions.

The examiner shall describe in detail the observations according to the Patent Law and its Implementing Regulations in the text of the Office Action. The observations shall be definite and detailed enough to enable the applicant to understand the problem of his application clearly.

Under any circumstances, observations shall be accompanied with reasons thereof, the conclusions shall be definite, and the relevant provisions of the Patent Law and its Implementing Regulations shall be cited. But the words with personal feelings shall not be introduced. In order to enable the applicant to make the amendment in conformity with the requirements as soon as possible, where necessary, the examiner may provide a suggestion of amendment for the applicant' s reference. If the applicant accepts the suggestion from the examiner, he shall formally submit a revised document. The proposed amendment in the Office Action cannot be used as the text of the document for further examination.

In order to accelerate the examination procedure, the Office Actions shall be as few as possible. Therefore, the comprehensive observations of the examiner, either on substantive or formal matters, shall

be described in the first Office Action unless the application under examination has no prospect of being granted the patent right due to serious substantive defects (such as those circumstances described in Section 4.3 or 4.8 of this Chapter) or the examiner intends to postpone the examination because the lack of unity in the application. Besides, where the text of examination is not in conformity with the provisions of Article 33, the examiner may provide the observations of examination for the applicant's references on the text other than the text of examination.

#### 4.10.2 Composition and Requirements

The first Office Action shall consist of the standard Form and the text of the Office Action. Where reference documents are cited in the Office Action, a copy of the reference documents shall be included according to circumstances.

##### 4.10.2.1 Standard Form

The examiner shall fill in all the items of the standard Form according to relevant requirements, and shall especially check and fill in the text on which the examination is based. Said text shall be the text of examination determined in accordance with the provisions of Section 4.1 of this Chapter. The text concerning the reference observations described in the text of first Office Action shall not be filled in the Form. If there are two or more applicants, all the applicants or their representative(s) shall be indicated.

The examiner shall fill in the item of "cited reference documents" in the standard Form according to the following requirements.

(1) Where the reference documents are patent documents (the publication of patents, the publication of patent applications), the country code, document number and document type provided by the "Information Search International Cooperation Committee of the Patent Offices with Examination System of the Paris Union" (ICIREPAT) shall be indicated. Moreover, the date of publication of those documents shall be indicated. With regards to the conflicting applications, the date of filing shall also be indicated.

[Examples]

| Title of Document | Date of Publication |
|---|---|
| CN1161293A | 1997.10.8 |
| US4243128A | 1981.1.6 |

JP59-144825A 1984. 8. 20

(2) Where the reference documents are articles in the periodicals, it shall be indicated the title of the article, the name of the author, the name and number of the volume of the periodical, the starting and ending page numbers of the relevant article and the date of publication, etc.

[Example]

"Laser Two-coordinate Measuring Instrument", Laser Two-coordinate Measuring Instrument Development Group of China Academy of Measuring Sciences, Journal of Metrology, Vol. 1, No. 2, pages 84-85, April 1980.

(3) Where the reference documents are books, it shall be indicated the title of the book, the name of the author, the starting and ending page numbers of the relevant content, the name of the publishing house and the date of publication.

[Example]

"Gas Discharge", Yang Jinji, pages 258-260, published on October 1983 by the Publishing House of Sciences.

**4.10.2.2 Text of Office Action**

The text of the Office Action may be drafted in the following ways according to circumstances and the result of the search of the application.

(1) Where the application belongs to one of the circumstances provided in Sections 4.3 of this Chapter under which the Office Action may be issued without the search, only main problem and its reason shall be indicated in the text of the Office Action, and it is not necessary to mention any other defect. At last, it shall be indicated that the application shall be rejected according to Article 38 because the application falls into some circumstances of rejection as listed in Rule 53.

(2) Where, although the patent right may be granted to an application, there still exist some minor defects, in order to accelerate the examination procedure, the examiner may provide specific suggestion in the Office Action, or directly make some suggestive amendments in the copy of the application documents which are used as the appendix of the Office Action, and state the reasons for such suggestion. Then it shall be pointed out that if the applicant agrees with the suggestive amendments of the examiner, he shall formally submit the amended

document or the replacement sheet of the amendment.

(3) Where although the patent right may be granted to an application, there still exist some serious defects that involve both the claims and the description, the examiner shall draft his observations in the order of the importance of the related issues. Usually, the observations on the independent claim(s) shall be described at first; secondly the observations on dependent claims; then the observations on the description (and the drawings) and abstract. The observations on the description may be written in the order provided in Rule 17.

Where the independent claim has to be amended, the applicant shall be usually invited to make corresponding amendments on the relevant part of the description. Moreover, if the examiner finds, through search, that some reference documents are even more related to the invention than the reference documents cited by the applicant in the description, the applicant shall be invited to make corresponding amendments in the part of "Background Art" and other relevant part of the description in the text of the Office Action.

Rule 21.1
Rule 17.1(2)

As for the improvement invention, if the examiner finds, through search, that a reference document is considered most related to the application, while the original reference document, which is used as the basis of delimiting the claim, is obviously unsuitable, the applicant shall be invited to delimit the independent claim again. Under such circumstances, the examiner shall also describe in detail in the Office Action how to delimit the independent claim by the newly cited reference document. The applicant shall be invited to make corresponding amendments to the description, for example, to make objective comments on the contents disclosed in said reference document in the part of "Background Art" of the description.

Where the technical problem to be solved by the invention has not been clearly indicated, or has only been generally described in the description, but the examiner may understand that problem by studying the complete contents of the description and can proceed the search and substantive examination based on this understanding, the examiner shall, at the beginning of the text of the Office Action, indicate the technical problem which he believes the invention intends to solve according to his understanding.

(4) Where it is impossible to grant the patent right to an application because of the lack of novelty or inventive step, the examiner shall provide his objection on novelty and inventive step to each claim in

the text of the Office Action, first to the independent claim, and then to the dependent claims one by one. However, if there are too many claims or the reason of objection is the same, the dependent claims can be evaluated in group. It shall be pointed out in the end that there is no substantive content to be granted the patent right even in the description.

Under such circumstances, it is not necessary for the examiner to point out the minor defects or formal defects in the text of the Office Action. It is also not necessary to invite the applicant to make any amendment.

Where the examiner provides the observations of examination in accordance with certain parts of the reference documents cited in the Office Action, the relevant specific paragraphs, or the numbers of the relevant figures and the reference signs of the components or parts in the figures shall be indicated.

For how to make the observations of examination and state the reasons thereof on the contents of the claims and the description according to the provisions of Article 22 on novelty and inventive step, see the relevant contents in Chapter 3 and Chapter 4 of this Part.

The common knowledge of the art cited in the Office Action by the examiner shall be accurate. Where the applicant has objections to the common knowledge cited by the examiner, the examiner shall state the reasons or provide corresponding evidence for proof.

Rules 42.2 & .1

(5) Where the application belongs to those situations obviously lacking unity as described in Section 4.4(1) of this Chapter, the examiner may issue *Notification to Make Divisional Application* to invite the applicant to amend the application documents and clearly inform the applicant that the examination shall be continued only after the defect of lacking unity is eliminated. Where the application belongs to those situations described in Section 4.4(2) of this Chapter, at the time of providing specific observations of the examination, the examiner shall, in the text of the Office Action, point out that the several inventions included in the application are not in conformity with the provisions of Article 31.1 concerning requirement of unity. If, after search, it is found that the lack of novelty or inventive step of the independent claim has led to lack of unity of the invention application, the examiner shall, according to the provisions of Section 4.4 of this Chapter, decide whether to continue the examination.

#### 4.10.2.3 Duplicate of Reference Documents

For the reference documents cited in the Office Action, a duplicate copy of the documents shall be included in the application file. If the cited reference document is too long, only the content relating to the text of the Office Action shall be copied. Besides, there shall be clear marks on the copy of the reference documents to indicate the source and the date of publication. Where the cited reference documents derive from periodicals or books, it is more necessary to include such marks.

Art. 37

### 4.10.3 Time Limit of Response

The examiner shall specify the time limit for the applicant to submit the response in the Office Action. The time limit shall be decided by the examiner after taking the relevant factors of the application into consideration, including the quantity and nature of the observations, the workload and the degree of complexity of the possible amendments and so on. The specified time limit for replying the first Office Action is four months.

### 4.10.4 Signature

The Office Action shall be sealed by the examiner who is responsible for the examination of the application. Where the Office Action is drafted by a trainee examiner, the seals of both the trainee and his instructor shall be affixed to it.

## 4.11 Continuation of Examination

After the response of the first Office Action has been submitted by the applicant, the examiner shall continue the examination of that application and consider the observations and/or amendments made by the applicant. The same standard of examination shall be applied by the examiner at the various stages of the examination.

Before continuing the examination, the examiner shall verify the information in the response, such as the application number, the name of the applicant, the names of the patent agency and the patent agent, and the title of the invention, etc., to avoid mistakes.

If the examiner has conducted the comprehensive examination before the issuance of the first Office Action, the attention at the stage of continuation of the examination shall be focused on the response of the

applicant to each observation mentioned in the text of the Office Action, especially on the reasons and evidences submitted by the applicant when he has objections against all or part of the comments of the examiner. Where the applicant submits the revised description and/or revised claims simultaneously, the examiner shall, according to the provisions of Article 33 and Rule 51.3, examine respectively whether the amendments go beyond the scope of disclosure contained in the initial description and claims, and whether the amendments have been made based on the requirements of the Office Action (see Section 5.2 of this Chapter). Where the amendments meet said requirements, the examiner shall further examine whether the revised application has overcome the defect(s) indicated in the Office Action, whether there arise new defects not in conformity with the provisions of the Patent Law and its Implementing Regulations, and, what is even more important is to examine whether the newly revised independent claim meets the requirements of Article 22 so as to determine whether the revised application is patentable.

**4.11.1 Handling of Application after Continuation of Examination**

After the continuation of the examination, the examiner may handle the application in the following ways according to the circumstances:

(1) where the applicant has made amendments according to the observations of the examiner, eliminated the defect which may lead to rejection of the application so that the patent right may be granted to the revised application, if there are still some defects in the application, the examiner shall invite the applicant again to eliminate these defects. Where necessary, the examiner may accelerate the examination by an interview with the applicant (see Section 4.12 of this Chapter). If possible, the examiner may have discussion with the applicant by telephone in the way as described in Section 4.13 of this Chapter. However, no matter in what form the amendment is proposed, the basis for the examination shall be the written amendments formally submitted by the applicant except that the examiner makes amendments to the obvious mistakes *ex officio* (see Sections 5.2.4.2 and 6.2.2 of this Chapter);

Art. 38

(2) if, after the applicant has made the observations or amendments, the examiner finds that there still exist the defects falling into situations specified in Rule 53 which have been indicated in the origi-

nal Office Action, he may make the decision of rejecting the application if the principle of hearing has been met; and

Art. 39

(3) where, after the applicant has made the amendment or observations, the application meets the requirements of the Patent Law and its Implementing Regulations, the examiner shall issue *Notification to Grant Patent Right*.

#### 4.11.2 Supplementary Search

In the course of the continuation of examination (including the examination after reexamination), where necessary, the examiner shall proceed to supplementary search. For example, where, after reviewing the response of the applicant, the examiner realizes that his original understanding of the invention is not accurate, which has led to the incomprehensiveness of the search, or where the amendments submitted by the applicant require for further search, or where an international application document designating China as described in Chapter 7, Section 4.2(2) of this Part which may constitute a conflicting application has been found in the first search (see Chapter 7, Section 11 of this Part), and it is necessary to conduct supplementary search to decide whether the application has entered into the national phase of China and has been published in Chinese.

#### 4.11.3 Further Office Action

##### 4.11.3.1 Circumstances to Issue Further Office Action

The examiner shall issue the further Office Action under one of the following circumstances:

(1) where some reference documents which are more relevant to the application are found by the examiner, and it is necessary to re-evaluate the claims;

(2) where the examiner has not made observations on one or more claims in the earlier examination, and it is found through the continuation of the examination that there are among them cases which do not meet the requirements of the Patent Law and its Implementing Regulations;

(3) the examiner considers that it is necessary to give new observations after the applicant submits observations and/or amendments;

(4) where, though the patent right may be granted to the amended application, there still exist defects which are not in conformity with

the provisions of the Patent Law and its Implementing Regulations. And these defects may be fresh defects that emerge after the amendments, defects newly found by the examiner, or defects that have been informed to the applicant by the examiner but have not been completely eliminated; or

(5) where, though the examiner intends to reject the application, he failed to indicate clearly in the earlier Office Action the facts, grounds or evidence upon which the rejection is based.

#### 4.11.3.2 Contents and Requirements of Further Office Action

The drafting and requirements of the first Office Action shall also apply to that of the further Office Action.

Where the applicant submits a revised text in response to the Office Action, the examiner shall make his observations on the revised text, and indicate the problem existing in the newly revised claims and description.

Where, in the response, if the applicant just puts forward his observations and has made no amendment to the application documents, the examiner may usually insist on his previous observations in the text of the further Office Action. However, if the applicant puts forward sufficient reason or if certain circumstances described in Section 4.11.3.1 of this Chapter occur, the examiner shall take the drafting of new observations into consideration.

The examiner shall make necessary comments in the further Office Action on the arguments in observations filed by the applicant.

In order to accelerate the examination procedure, the conclusion of the examination of the application shall be indicated definitely in the further Office Action. The specified time limit of the response to the further Office Action is two months.

### 4.12 Interview

Under some circumstances, such as the circumstances described in Section 4.11.1(1) of this Chapter, the examiner may invite the applicant to have an interview so as to accelerate the examination procedure. The applicant may also request for an interview. In this situation, if the examiner believes that a useful purpose will be served by such an interview, the request shall be granted; otherwise, the request may be refused.

### 4.12.1 Conditions of Holding Interview

The conditions for holding an interview are as follows:

(1) the examiner has issued the first Office Action; and

(2) at the time of or after submitting the response to the Office Action, the applicant files a request for interview; or when the examiner thinks it necessary to invite the applicant to have an interview.

No matter invited by the examiner or requested by the applicant, the interview shall be arranged in advance by issuing *Notification of Interview* or by telephone. The duplicate copy of the *Notification of Interview* or the *Minutes of Telephone Communication Concerning Appointment of Interview* shall be included in the application file. It shall be indicated clearly in said notification or the minutes the contents, time and place of the interview confirmed by the examiner. If a new document is to be put forward in the interview by the examiner or by the applicant, it shall be submitted to the other party before the interview.

Generally, the date of the interview shall not be changed once it is fixed. If it has to be changed, the other party shall be notified in advance. If, without any justified reason, the applicant fails to take part in the interview, the examiner may refuse to arrange a new interview, and continue the examination by sending a further written action.

### 4.12.2 Venue of Interview and Participants

The interview shall be held in the place designated by the Patent Office. With regard to the application, the examiner shall not interview the applicant in any other place.

The interview shall be presided over by the examiner responsible for the examination of the application. Where necessary, other experienced examiners may be invited to provide assistance. Where an interview is presided over by a trainee examiner, the instructor examiner shall be present at the spot.

Where a patent agency is appointed by the applicant, the patent agent shall participate in the interview and shall produce his certificate of patent agent. Where the applicant changes the patent agent, the applicant shall go through the formality for a change of the bibliographic data and the new patent agent shall participate in the interview after said formality is qualified. Where a patent agency is appointed by the applicant, the applicant may participate in the interview together with his patent agent.

Where no patent agency is appointed by the applicant, the applicant shall participate in the interview. Where the applicant is an entity, the person appointed by the entity shall participate in the interview. Said person shall produce their identifications and the letter of introduction issued by the entity.

The provisions mentioned above shall also apply to co-applicants unless there are other statements or other appointed patent agency. Each entity or individual of the co-applicants shall participate in the interview.

Where necessary, when designated or appointed by the applicant, the inventor may participate in the interview together with the patent agent; or where no patent agency is appointed by the applicant, the inventor entrusted by the applicant may participate in the interview on behalf of the applicant.

The total number of the applicants or patent agents present in the interview shall be usually no more than two. Where a patent application is owned by two or more entities or individuals and where no patent agency is appointed, the number of the participants in the interview may be decided according to the number of the co-applicants.

### 4.12.3 Record of Interview

When an interview is over, the examiner shall fill in the Record of Interview. The Record of Interview shall take the standard form uniformly formulated by the Patent Office. The record shall be copied in duplicate, signed or sealed by the examiner and the applicant (or his patent agent) who participate in the interview, one copy shall be given to the applicant and the other shall be kept in the application file.

Usually, the matters discussed, the conclusions reached or amendments agreed shall be indicated in the Record of Interview. If the interview is concerned with solving many matters, such as questions of novelty, inventive step, or whether the amendment introduces new contents, the examiner shall make a fuller note of the matters discussed and any agreement reached.

The Record of Interview shall not replace the formal response to the Office Action or the amendment of the applicant. Even though the agreement on how to make the amendment has been reached by both parties in the interview, the applicant still has to submit the formal amended documents and the examiner cannot make any amendment on the applicant's behalf.

Where no agreement on the amendment of the application documents is reached in the interview, the examination shall be continued by sending a further written action.

Art. 37

When the interview is over and the applicant is required to resubmit the amended documents or written observations, if the watch on the initial specified time limit still exists, the time limit may not need to change because of the interview, or the time limit may extend one month depending upon the situation. If the watch on the initial specified time limit exists no more, the examiner shall specify another time limit for submitting the amendments or observations in the Record of Interview. The amendments or observations submitted within this time limit shall be deemed as the response to the Office Action. If the applicant fails to make response in due time, the application shall be deemed to be withdrawn.

If the new documents submitted by the applicant in the interview are not received by the examiner before the interview, the examiner may decide to suspend the interview.

**4.13 Communication by Telephone**

The examiner may discuss the problems in the application documents with the applicant by telephone. However, the communication by telephone shall apply only to minor issues and non-misleading issues concerning the formal defects. The examiner shall record the matters discussed and keep it in the application file. For the amendments agreed by the examiner in the telephone conversation, the applicant shall usually submit the formal revised documents in written form. The examiner shall make conclusion according to such written documents.

Rule 51.4

Where the contents of the amendments agreed by the examiner in the telephone conversation fall into the scope as described in Sections 5.2.4.2 and 6.2.2 of this Chapter, the examiner may correct the obvious mistakes *ex offcio*.

**4.14 Taking of Evidence and On-Spot Investigation**

Generally speaking, since the main responsibility of the examiner is to point out to the applicant the problems of the application which are not in conformity with provisions of the Patent Law and its Implementing Regulations, it is not necessary for the examiner to request the applicant to provide evidence in the procedure for substantive examination. If the applicant does not accept the views of the examiner, then

it is for the applicant to decide whether he wishes to produce evidence in support of his case. If so, he shall be given an appropriate opportunity to produce any evidence which is likely to be relevant, unless the examiner convinced that no useful purpose will be served by it.

The evidence provided by the applicant may be either written documents or a model. For example, the applicant may provide materials concerning merits of the technology of the invention to prove the inventive step of the application. For another example, the applicant may make a demonstration of the model to prove the practical applicability of the application and so on.

Where an application involves problems that can be solved only by an on-spot investigation of the examiner, a request shall be made by the applicant. The on-spot investigation of the examiner shall be carried out only when the request is approved by the Director General of the relevant department of substantive examination. All the costs of the investigation shall be borne by the Patent Office.

## 5. Response and Amendment

### 5.1 Response

Art. 37

The applicant shall respond to the Office Action issued by the Patent Office within the specified time limit.

The response of the applicant may include the observations only, the revised application documents (replacement sheet and/or rectification) may be also included. Where the applicant states in his response the objection to the observations in the Office Action or makes amendments to his application, he shall state his opinions in detail in the observations, or explain whether the amendments are in compliance with the corresponding provisions and how the defects existing in the initial application documents have been overcome. For example, where the applicant introduces a new technical feature into the amended claim to overcome the defect of lack of inventive step indicated in the Office Action, the applicant shall specifically indicate in his observations the part of the description from which the new technical feature is derivable, and state the reasons for which the amended claim involves an inventive step.

The applicant may request the Patent Office to extend the specified time limit of the response. However, the request shall be submitted before the expiration of the initial time limit. For handling of the re-

quest concerning the extension of time limit, the provisions of Chapter 7, Section 4 of Part V of these Guidelines shall apply. After the Patent Office receives the response of the applicant, the subsequent examination procedure may be initiated. After the notifications or decisions of the subsequent examination procedure are issued, the examiner shall not consider later responses submitted by the applicant within the initial time limit of response.

Art. 37
Rule 2

### 5.1.1 Form of Response

The applicant shall respond to the Office Action within the specified time limit in the form of observations or rectifications as required by the Patent Office (see Chapter 1, Section 4 of Part V of these Guidelines). The observations or rectifications without any specific content of response submitted by the applicant is also the formal response from the applicant, for which the examiner shall think that the applicant does not give any specific objections to the opinions given in the Office Action and does not overcome the defects existing in the application documents indicated in the Office Action.

The applicant shall submit his response to the Receiving Section of the Patent Office. The response or the correspondence asking for opinions addressed directly to the examiner shall not be deemed as the formal response and shall have no legal effect.

### 5.1.2 Signature of Response

Rule 119.1

Where no patent agency is appointed, the observations or rectifications submitted by the applicant shall be signed or sealed by the applicant. Where the applicant is an entity, an official seal shall be affixed. Where there are two or more applicants, the observations or rectifications may be signed or sealed by their representative.

Where a patent agency is appointed by the applicant, the response shall be sealed by such agency, and signed or sealed by the patent agent designated in the Power of Attorney. Where there is a change in patent agent, the response shall be signed or sealed by the new patent agent.

Where no patent agency is appointed by the applicant, if the response is not signed or sealed by the applicant (where there are two or more applicants, it shall be signed or sealed by all the applicants, or at least by their representative), the examiner shall return the response to the department responsible for preliminary examination.

Where a patent agency is appointed by the applicant, if the seal of the patent agency is not affixed to the response, or if the response is made by the applicant himself, the examiner shall return the response to the department responsible for preliminary examination.

Rule 119. 2

Where there is a change in the applicant or the appointed patent agent, the examiner shall check whether there is a corresponding *Notification of Change in Bibliographic Data* in the file. If such notification is not in the file, the examiner shall return the response to the department responsible for preliminary examination.

**5. 2 Amendments**

In accordance with Article 33, the applicant may amend his application for a patent, but the amendment to the application for a patent for invention or utility model may not go beyond the scope of disclosure contained in the initial description and claims. The amendment to the international application submitted by the applicant in accordance with the provisions of PCT shall also be in conformity with the provisions of Article 33.

In accordance with Rule 51. 1, when a request for substantive examination is made, and within the time limit of three months after the receipt of the *Notification of Entering the Substantive Examination Stage of the Application* issued by the Patent Office, the applicant may amend the invention application on his own initiative.

In accordance with Rule 51. 3, where the applicant amends the application after receiving the Office Action of the Patent Office, the amendment shall be made to the defects as indicated in the Office Action.

**5. 2. 1 Requirement of Amendments**

Article 33 provides for the content and scope of the amendment. Rule 51. 1 provides for the time for the applicant to make amendment on his own initiative, and Rule 51. 3 provides for the manner for the applicant to make amendment in response to the Office Action.

Art. 33

**5. 2. 1. 1 Content and Scope of Amendment**

In the procedure for substantive examination, the amendment of the application documents may take place several times so that the application meets the requirements of the Patent Law and its Implementing Regulations. When examining the amended documents submitted

by the applicant, the examiner must strictly abide by the provisions of Article 33. Whether the applicant amends the application documents on his own initiative or in answer to the defects as indicated in the Office Action, the amendment of the application documents shall not go beyond the scope of disclosure contained in the initial description and claims. The scope of disclosure contained in the initial description and claims includes the contents described in the initial description and claims, and the contents determined directly and unambiguously according to the contents described in the initial description and claims, and the drawings of the description. The contents described in the initial description and claims submitted by the applicant on the date of filing shall be taken as the basis of examining whether the above-mentioned amendment is in conformity with the provisions of Article 33. The contents of the application documents in foreign language and the priority documents submitted by the applicant to the Patent Office shall not be taken as the basis to judge whether the amendment to the application documents meet the requirements of Article 33, except for the originally filed text in foreign language of an international application entering into the national phase. For the legal effect thereof, see Chapter 2, Section 3.3 of Part III of these Guidelines.

If the contents and scope of the amendment are not in conformity with the provisions of Article 33, the amendment shall not be allowed.

#### 5.2.1.2 Time of Amendment on His Own Initiative

Rule 51.1

Only in the following two cases, the applicant may amend the application document for an invention patent on his own initiative.

(1) At the time when a request for examination as to substance is made; and

(2) When within the time limit of three months after the receipt of the notification of the Patent Office on the entry into examination as to substance of the application.

Rule 51.3

When replying the Office Action from the Patent Office, the amendment on his own initiative is not allowable.

#### 5.2.1.3 Manner for Making Amendment When Replying the Office Action

In accordance with Rule 51.3, when replying the Office Action, the amendment, if there is, shall be made in answer to the defects as indicated in the Office Action. If the manner of the amendment is not

in conformity with Rule 51.3, the text as so amended shall generally be unacceptable.

However, where the manner for making amendment does not meet the requirements of Rule 51.3, but the contents and scope of the amendment are in conformity with the provisions of Article 33, the amendment may be deemed to be made in answer to the defects as indicated in the Office Action and the application documents amended in this way may be acceptable, provided that the defects existed in the initial application documents are eliminated in the amended documents and there is prospect for the application to be granted the patent right. By doing so, it is beneficial to economize the examination procedure. Nevertheless, under the following circumstances, even though the contents of the amendment do not go beyond the scope of disclosure contained in the initial description and claims, the amendment shall not be deemed to be made in answer to the defects as indicated in the Office Action, therefore the amendment shall be unacceptable.

(1) The applicant has removed one or more of the technical features from the independent claim on his own initiative, which leads to the expanding of the extent of protection claimed in the claim.

For example, the applicant has, on his own initiative, removed from the independent claim a technical feature, or a relevant technical term, or a technical feature which is used to define the specific application scope, even though the contents of the amendment do not go beyond the scope of disclosure contained in the initial description and claims, such amendment shall not be accepted as long as it leads to the expanding of the extent of protection claimed in the claim.

(2) The applicant has changed one or more of the technical features of the independent claim on his own initiative, which leads to the expanding of the extent of protection claimed in the claim.

For example, the applicant has, on his own initiative, replaced the technical feature "helical springs" by "resilient part". Although the technical feature of "resilient part" has been described in the initial description, it is not acceptable since such change will expand the extent of protection.

For another example, in Example 1 to Example 4 of Section 5.2.3.2(1) of this Chapter, although the contents of said four changes are described in the initial description, it is not acceptable since such changes may lead to the expanding of the extent of protection.

(3) The applicant has taken the technical content which is only

described in the description and lacks unity with the initial claimed subject matter as the subject matter of the revised claim on his own initiative.

For example, the applicant has described not only a new handle but also other parts in the description of an invention application concerning the new handle of a bicycle, such as the saddle of the bicycle. It is found that the new handle defined by the claim does not involve an inventive step after substantive examination. Then the applicant, on his own initiative, makes the saddle as the subject matter of the claim. As there is no unity between the revised subject matter and the initial claimed subject matter, such amendment is not acceptable.

(4) The applicant has added a new independent claim on his own initiative, and the technical solution defined by it is not present in the initial claims.

(5) The applicant has added a new dependent claim on his own initiative, and the technical solution defined by it is not present in the initial claims.

Where the amended text submitted by the applicant in response to the Office Action is not made in answer to the defects as indicated in the Office Action but belongs to the above-mentioned unacceptable situations, the examiner shall issue an Office Action, state the reason for not accepting the amendment, and invite the applicant to submit an amendment complying with the provisions of Rule 51. 3 within the specified time limit. In the meanwhile, it shall be indicated that, when the specified time limit is expired, if the text of amendment submitted by the applicant is still not in conformity with the provisions of Rule 51. 3 or the amendment has other contents which are not in conformity with the provisions of Rule 51. 3, the examiner shall continue to examine the text submitted before the amendment is made, for example, to make a decision to grant or to reject.

If the examiner has new opinions on parts of the current amended text, which is in accordance with the requirements of Rule 51. 3, the opinions can be stated in this Office Action.

**5. 2. 2 Allowability of Amendments**

Herein, the term "allowability of amendments" mainly refers to the amendments which are in conformity with the provisions of Article 33.

**5.2.2.1 Amendments to the Claims**

The amendments to the claims mainly involve the change in the extent of protection of the independent claim made through adding or altering the technical features of the independent claim, or altering the category or title of the subject matter of the independent claim and its corresponding technical features; the addition or deletion of one or more claims; the amendment to the independent claim for re-delimiting it from its closest prior art; the amendment to the reference portion of the dependent claim to revise the relation of reference, or the amendment to the characterizing portion of the dependent claim to clearly define the extent of protection claimed by the claim. For all the above-mentioned amendments, provided that the technical solution of the revised claim has been clearly disclosed in the initial description and claims, the amendments shall be allowable.

Art. 22.2 & .3

Allowable amendments to the claims include the following:

Art. 26.4
Rule 20.2

(1) One or more additional technical features are introduced into the independent claim to further define the claim so as to eliminate the defects of the initial claim, such as lacking novelty or inventive step, lacking essential technical feature for solving the technical problem, lacking support in the description, or not defining the extent of the patent protection sought for in a clear manner, etc., provided that the technical solution of the independent claim into which the additional technical features are introduced does not go beyond the scope of disclosure contained in the initial description and claims, the amendment shall be allowable.

Art. 22.2 & .3
Art. 26.4

(2) One or more technical features of the independent claim are changed to eliminate the defects of the initial claim, such as lacking support in the description, not defining the extent of the patent protection sought for in a clear manner, or lacking novelty or inventive step. So long as the technical solution described in the independent claim having the changed technical features does not go beyond the scope of disclosure contained in the initial description and claims, such amendment shall be allowable.

As for the amendment to the numerical range of the claim which contains the technical feature defined by such range, it is allowable only when the two extreme values of the revised numerical range are really described in the initial description and/or claims and the revised numerical range is within the initial numerical range. For example, the

range of temperature in the technical solution of the claim is 20℃-90℃. The difference between the technical contents disclosed in the reference documents and this technical solution is that the corresponding range of temperature disclosed in the reference documents is 0℃-100℃, and a specific numerical value of 40℃ is also disclosed in the reference documents. Therefore, the examiner shall indicate in the Office Action that said claim does not possess novelty. If the specific numerical values of 40℃, 60℃ and 80℃ in the range of 20℃-90℃ are also mentioned in the description or claims of the invention application, it is allowable for the applicant to change the range of temperature in the claim to 60℃-80℃ or 60℃-90℃.

Art. 22.2 & .3
Rule 26.4

(3) The category, title of the subject matter and the corresponding technical features of the independent claim are changed to eliminate the defects of the initial claim, such as having wrong category or lacking novelty or inventive step. So long as the technical solution of the revised independent claim does not go beyond the scope of disclosure contained in the initial description and claims, such amendment shall be allowable.

Art. 31.1 & 26.4
Rule 21.3

(4) One or more claims are deleted to eliminate such defects as lacking unity between the initial first independent claim and the parallel independent claims, the claims being not concise as two claims have identical extent of protection, or the claims lacking support in the description. As such amendment does not go beyond the scope of disclosure contained in the initial claims and description, it is allowable.

Rule 21.1

(5) The independent claim is correctly delimited from the closest prior art. As such amendment does not go beyond the scope of disclosure contained in the initial claims and description, it is allowable.

Rules 22.1 & .2

(6) The reference portion of the dependent claim is amended to correct the mistake of reference so as to accurately mirror the specific mode for carrying out the invention or embodiment described in the initial description. As such amendment does not go beyond the scope of disclosure contained in the initial claims and description, it is allowable.

Rules 20.3 & 22.1

(7) The characterizing portion of the dependent claim is amended to clearly define the extent of protection claimed by said dependent claim so as to accurately mirror the specific mode for carrying out the invention or embodiment described in the initial description. As such amendment does not go beyond the scope of disclosure contained in the initial claims and description, it is allowable.

Above is the explanation to the several allowable amendments to the claims. Such amendments are allowable as they are in conformity with the provisions of Article 33. However, after the above-mentioned amendments, whether the claims meet other requirements of the Patent Law and its Implementing Regulations remains to be further examined by the examiner. For the amendments made in response to the Office Action, the examiner shall check whether the revised claims have overcome the defects indicated in the Office Action, whether the amendments have introduced any other defects. For the amendments made on the applicant' s own initiative, the examiner shall judge whether, in the revised claims, there are any other defects which do not meet the requirements of the Patent Law and its Implementing Regulations.

#### 5.2.2.2 Amendments to Description and Abstract Thereof

There are two kinds of amendments so far as the description is concerned: amendments to the defects of the description per se which do not meet the requirements of the Patent Law and its Implementing Regulations; and the amendments made to adapt to the revised claims. So long as the two kinds of amendments do not go beyond the scope of disclosure contained in the initial description and claims, they are allowable.

Rule 17

The allowable amendments to the description and its abstract include the following.

(1) The title of the invention is amended to enable it accurately and concisely reflect the title of the claimed subject matter. Where the categories of the independent claims cover product, process and use, all of the claimed subject matter shall be reflected in the title of the invention. The title of the invention shall be as brief as possible and it generally shall not exceed 25 Chinese characters. In special situations, for example, for some invention applications in the chemistry field, the title may be allowed to have up to 40 Chinese characters.

(2) The technical field to which the invention pertains is amended. Said field refers to the technical field reflected by the classification position of the International Patent Classification (IPC). In order to enable the public and the examiner to clearly understand the invention and the relevant prior art, the applicant is allowed to amend the technical field of the invention to make it relevant to the corresponding field which is defined in the lowest classification position of the IPC.

(3) The part of "Background Art" is amended to make it consist-

ent with the claimed subject matter of the invention. Where the independent claim is drafted according to the provisions of Rule 21, the relevant contents of the prior art described in the preamble portion of the claim shall be contained in the part of "Background Art" of the description, and the documents reflecting the background art shall be cited. If, through search, the examiner finds any reference documents which are even more related to the claimed subject matter of the invention than the prior art cited in the initial description by the applicant, the applicant shall be allowed to amend such part of the description by adding the contents of these documents and citing the documents. At the same time, the contents describing the unrelated prior art shall be deleted. It shall be noted that such amendment, in fact, has introduced the contents which are not contained in the initial claims and description. However, since the amendment relates just to the background art other than the invention per se, and the contents added are prior art already known to the public before the date of filing, it is allowable.

(4) The content in the part of "Contents of Invention" which relates to the technical problem to be solved by the invention is amended to make it more consistent with the claimed subject matter, i. e., reflecting the technical problem to be solved by the technical solution of the invention with reference to the closest prior art. Of course, the amended contents shall not go beyond the scope of disclosure contained in the initial description and claims.

Rule 3. 1

(5) The content in the part of "Contents of Invention" which relates to the technical solution of the invention is amended to make it adapted to the claimed subject matter of the independent claim. If amendments have been made to the independent claim which meet the requirements of the Patent Law and its Implementing Regulations, the corresponding amendments may be made in this part. If there is no amendment of the independent claim, such amendments as polishing of the language, standardization of the words and unifying the technical terms are allowable provided that the initial technical solution is not changed.

(6) The content in the part of "Contents of Invention" which relates to the advantageous effects of the invention is amended. Such amendment is allowable only when the technical feature(s) is clearly described in the initial application documents, but its advantageous effect is not mentioned clearly, and it can be deduced directly and un-

ambiguously by a person skilled in the art from the initial documents.

(7) The description of the drawings is amended. Where the application documents contain the drawings, but there is no description of the drawings, it is allowable to add said description. Where the description of the drawing is not clear, the proper amendment according to the context of the application may be allowed.

(8) The best mode for carrying out the invention or embodiment is amended. Such amendment is generally limited to the addition of the source of the specific contents of the initial mode or embodiment and the standard measuring method of the described data reflecting the advantageous effects of the invention (including the standard equipment and/or appliance to be used). If it is found through search that part of the claimed subject matter of the initial application has become a part of the prior art, the applicant shall delete the contents reflecting such part of the subject matter or clearly indicate that such contents fall into the scope of prior art.

Rule 18

(9) One or more drawings are amended. This refers to the deletion of the unnecessary words and explanatory notes in the drawings, which may be then added into the text of the description; the amendment to the reference signs of the drawings to make it consistent with those in the text of the description; in order to make the structure of certain parts of the drawing sufficiently clear, the addition of the enlarged drawings of said parts is allowable so long as the description of the drawings is clear; amendment to the Arabic numbering of the drawings to make each drawing have a number.

Rule 23

(10) The abstract is amended. This refers to the amendment to the abstract to make it indicate the title of the invention and the technical field to which the invention pertains, clearly reflect the technical problems to be solved, the essential contents of the technical solution for solving said problems and the principal uses; deletion of the commercial advertising; change of the drawing of the abstract to make it best reflect the main technical features of the invention.

(11) The obvious mistakes which can be discerned by a person skilled in the art, i. e., grammar, wording, or typing mistakes are corrected. The amendment to such mistakes shall be the only correct solution deduced by said person from the whole and the context of the description.

### 5.2.3 Disallowable Amendments

Art. 33

As a principle, any amendment to the description (and the drawings) and the claims that is not in conformity with the provisions of Article 33 is not allowable.

Specifically, if, after the addition, change and/or deletion of part of the contents of the application, the information as seen by a person skilled in the art is different from those described in the initial application and such information cannot be directly or unambiguously derived from those described in the initial application, such amendment shall not be allowable.

Here, the contents of the application refer to contents described in the initial description (and the drawings) and claims, not including the contents of any priority documents.

#### 5.2.3.1 Disallowable Additions

The following additions are not allowable.

(1) The technical features which cannot be directly and definitely confirmed from the initial description (and the drawings) and/or claims are introduced into the claims and/or description.

(2) The information which cannot be directly and unambiguously determined from the initial description (and the drawings) and/or claims is added to make the disclosed invention clear or the claims complete.

(3) The contents added are the technical features relating to the parameter of size obtained by measuring the drawings.

(4) The additional component which has not been mentioned in the initial application documents is introduced, which leads to special effects which do not exist in the initial application.

(5) The useful effects which cannot be directly derived from the initial application by a person skilled in the art are added.

(6) The experimental data is added to illustrate the advantageous effects of the invention, and/or the specific mode for carrying out the invention or embodiment is added to prove that the invention can be carried out in the extent of protection claimed in the claims.

(7) The supplement of the drawings that are not mentioned in the initial application is generally not allowable. However, the supplement of drawing of the background art, or the replacement of the drawing of the well-known art contained in the initial drawings by the one of the

closest prior art shall be allowable.

**5.2.3.2 Disallowable Changes**

The following changes are not allowable.

(1) The technical features of the claims are changed. Such amendment goes beyond the scope of disclosure contained in the initial claims and description.

[Example 1]

A kind of phonograph record case with the opening at one side is defined by the initial claim. A view of a case with opening at one side and the other three sides been glued is given in the drawings. If the applicant amends the claim as "a case with openings at least at one side", while it has never been mentioned in any part of the description "there may be openings at more than one side", such change has gone beyond the scope of disclosure contained in the initial claims and description.

[Example 2]

What is claimed in the initial claim is the component for manufacturing rubber. It cannot be replaced by the component for manufacturing elastic material, unless it is clearly indicated in the initial description.

[Example 3]

A kind of brake of bicycle is claimed in the initial claim, and the applicant amends it as a kind of brake of vehicle. This amended technical solution cannot be directly derived from the initial claims and description. Such amendment has also gone beyond the scope of disclosure contained in the initial claims and description.

[Example 4]

The component or part which has specific structure features is replaced by "functional term + means" which cannot be directly derived from the initial application documents. Such amendment has gone beyond the scope of disclosure contained in the initial claims and description.

(2) New contents are introduced by changing indefinite contents into definite and specific contents.

For example, there is an invention application relating to the synthesis of a high molecular compound. It is just indicated in the initial application documents that the polymerization reaction is carried out at "higher temperature". When the applicant knows that it is indicated in

a reference document cited by the examiner that the same reaction is carried out at the temperature of 40℃, he changes the "higher temperature" to "temperature higher than 40℃". Although "temperature higher than 40℃" falls into the scope of "higher temperature", a person skilled in the art is unable to draw a conclusion that "higher temperature" refers to "temperature higher than 40℃" from the initial application documents. Therefore, such amendment has introduced new contents.

(3) Several separate features of the initial application documents are combined as a new feature while the interrelations of these separate features are not mentioned definitely in the initial application documents.

(4) Certain feature described in the description is changed to make the changed technical contents different from those described in the initial application documents. Such amendment goes beyond the scope of disclosure contained in the initial description and claims.

[Example 1]

Several embodiments of different layered arrangements are described in the initial application documents of an invention application relating to a multi-layer laminated panel, one of which has an outer layer of polyethylene. If the applicant makes the amendment of altering the polyethylene to polypropylene, it is not allowable because the laminated panel after amendment is totally different from the originally described one.

[Example 2]

The content of "such as helical springs supports" is described in the initial application documents, and after the amendment, said content in the description is altered to "resilient supports", which leads to the broadening of specific helical springs supports to all the possible resilient supports. Such amendment makes the technical contents go beyond the scope of disclosure contained in the initial description and claims.

[Example 3]

The temperature condition defined in the initial application documents is 10℃ or 300℃, whereas said temperature condition in the description is amended to be 10℃-300℃ later. If the range of temperature cannot be directly and unambiguously derived from the contents described in the initial application documents, the amendment goes beyond the scope of disclosure contained in the initial description and claims.

[Example 4]

The content of a certain component of a composition defined in the initial application documents is 5% or 45%-60%, whereas said content in the description is amended to be 5%-60% later. If the range of content cannot be directly and unambiguously derived from the contents described in the initial application documents, the amendment goes beyond the scope of disclosure contained in the initial description and claims.

### 5.2.3.3 Disallowable Deletions

The following deletions are not allowable.

(1) The technical features which are definitely determined as the essential technical features of the invention in the initial application are deleted from the independent claim, i. e., the technical features which are described as the essential technical features throughout the initial application are deleted; or a technical term which is related to the technical solution described in the description is deleted from the claims; or the technical feature which is affirmed clearly in the description as relating to the specific application scope is deleted from the claims.

For example, "a sidewall with rib" is changed into "a sidewall". For another example, the initial claim is "a seal of rotative axis for use in a pump…", while the amended claim is "a seal of rotative axis". Such amendments are not allowable because the basis of the amendments cannot be found in the initial description.

(2) Some contents are deleted from the description, which makes the amended description go beyond the scope of disclosure contained in the initial description and claims.

For example, several embodiments of different layered arrangements are described in the description of an invention application relating to a multi-layer laminated panel, one of which has an outer layer of polyethylene. If the applicant makes amendment of deleting the outer layer of polyethylene, it is not allowable because the laminated panel after amendment is completely different from the originally described one.

(3) If no other numerical value within the initial numerical range of a certain technical feature is described in the initial description and claims, while novelty and inventive step are prejudiced by the contents disclosed in reference documents, or the invention cannot be carried

out when said feature adopts certain parts of the initial numerical range, in view of these two situations, the applicant has to use a specific "disclaimer" to exclude said parts from the initial numerical range so that the numerical range of the claimed technical solution does not include said parts obviously as a whole, such amendment shall not be allowed because the amendment has gone beyond the scope of disclosure contained in the initial description and claims, with the exception that the applicant can prove, in accordance with the contents described in the initial application, that the invention cannot be carried out when said feature adopts the "disclaimed" numerical value, or the invention possesses novelty and involves an inventive step when said feature adopts the numerical value after the "disclaimer". For example, the numerical range in the claimed technical solution is $X_1 = 600\text{-}10000$, the only difference between the technical contents disclosed in the reference documents and said technical solution is that said numerical range in the former is $X_2 = 240\text{-}1500$. As $X_1$ and $X_2$ overlap partially, the claim does not possess novelty. The applicant uses the specific "disclaimer" to amend $X_1$, excluding from $X_1$ the portion that $X_1$ and $X_2$ overlap, i. e. , 600-1500, thus, said numerical range of the claimed technical solution is changed to be from $X_1 > 1500$ to $X_1 = 10000$. If the applicant can neither prove that the inventions within the numerical range from $X_1 > 1500$ to $X_1 = 10000$ involve inventive step with reference to those within the $X_2 = 240\text{-}1500$ range described in the reference documents based upon the initially disclosed contents and the prior art, nor prove that the invention cannot be carried out when $X_1$ is within 600-1500, such amendments shall not be allowed.

### 5.2.4 Specific Form of Amendment

#### 5.2.4.1 Submission of Replacement Sheet

In accordance with the provisions of Rule 52, when an amendment to the description or the claims is made, a replacement sheet in prescribed form shall be submitted. There are two ways for the submission of the replacement sheet.

(1) The retyped replacement sheet is submitted with the table of comparison of the amendments.

This applies to the description and/or claims with many amendments, and all the amended drawings. At the time when the applicant submits the replacement sheet, he shall submit a detailed table of com-

parison between the amendments made and the initial documents.

(2) The retyped replacement sheet is submitted with the page of comparison of the amendments which are made on the duplicate of the original page.

This applies to the description and/or claims with few amendments. At the time when the applicant submits the retyped replacement sheet, he shall submit the page of comparison of the amendments made on the duplicate of the original page, which may enable the examiner to find out the amendments more easily.

Rules 52 & 51.4

#### 5.2.4.2 Amendment by Examiner *Ex Officio*

Usually, the amendments to the application shall be submitted by the applicant in the form of formal documents. As for amendments for the alteration, addition or deletion of few words or marks, as well as the amendments to the obvious mistakes in the title of the invention or the abstract (see Sections 5.2.2.2(11) and 6.2.2 of this Chapter), the examiner may carry out *ex officio* and inform the applicant. At this time, the examiner shall use a pen, signature pen or ball-pen, rather than a pencil, to make clear and distinct amendments.

## 6. Decision of Rejection and Notification to Grant Patent Right

Art. 38 & 39
Rule 58

The examiner shall finish the substantive examination of an application within the time as short as possible. Usually, the examiner may make the decision of rejection or issue *Notification to Grant Patent Right* after one or two Office Actions. Once said decision or notification is issued, any observations, response or amendment from the applicant shall be no more considered.

### 6.1 Decision of Rejection

#### 6.1.1 Conditions of Rejection of Application

Art. 38

Before making the decision of rejection, the examiner shall notify the applicant the facts, grounds and evidence confirmed by substantive examination upon which the conclusion is based that the application is considered to fall into one of the circumstances where an application shall be rejected as specified in Rule 53, and provide at least one opportunity for the applicant to make the observations and/or amendments.

The decision of rejection shall usually be made after the second

Office Action. However, If the applicant, within the time limit specified in the first Office Action, has not put forward any convincing observations and/or evidences for rejectable defects as indicated in the Office Action, or has not amended the application documents in answer to such defects, or the amendments have only corrected the wrongly written characters or altered the presentations without modifying the technical solution substantially, the examiner may make a decision of rejection directly.

If the applicant amends the application documents, another opportunity to make further observations and/or amendments to the application documents shall be provided to the applicant as long as the facts upon which the rejection is based have changed, even if the defects which can be rejected by the grounds and evidence previously notified to the applicant still exist in the amended application documents. However, where the later amendments concern the same kinds of defects, if the defects which can be rejected by grounds and evidence previously notified to the applicant still exist in the amended application documents, the examiner may make a decision of rejection directly without issuing another Office Action so as to comply with both the principle of hearing and the principle of procedural economy.

**6.1.2 Circumstances of Rejection**

Various circumstances where an invention application shall be rejected as provided for in Rule 53 are as follows:

Art. 5 & 25 — (1) the subject matter of the application is contrary to the laws or social morality or is detrimental to public interest, or it is developed relying on the genetic resources, the acquisition or use of which is not consistent with the provisions of the laws and administrative regulations, or it is one of the objects mentioned in Article 25 for which no patent right shall be granted;

Art. 2.2 — (2) the application is not a new technical solution relating to a product, a process, nor improvement thereof;

Art. 20.1 — (3) the invention contained in the application has been developed in China, and the applicant does not request the Patent Office for confidentiality examination before filing the application for patent abroad;

Art. 22 — (4) the invention in the application lacks novelty, inventive step or practical applicability;

Art. 26.3 & .4 — (5) the application does not sufficiently disclose the claimed subject matter; or the claim is not supported by the description, or the

claim does not define the extent of the patent protection sought for in a clear and concise manner;

Art. 26. 5

(6) the application is for an invention-creation developed relying on the genetic resources, however, the applicant fails to indicate the direct or original source of such genetic resources in the patent application documents; where the original source can not be indicated, the reasons thereof is not stated either;

Art. 31. 1

(7) the application does not meet the requirement of unity as provided for by the Patent Law;

Art. 9

(8) the subject matter of the application shall not be granted according to Article 9;

Art. 20. 2

(9) the independent claim lacks essential technical features for solving the technical problem; or

Art. 33
Rule 43. 1

(10) the amendment to the application or the divisional application goes beyond the scope of disclosure contained in the initial description and the claims.

### 6.1.3 Formation of Decision of Rejection

The decision of rejection consists of the following two parts.

(1) Standard Form

Each item of the standard form shall be filled in completely according to the requirements; where there are two or more applicants, all the names of the applicants shall be filled in (see Chapter 6, Section 1.2 of Part V of these Guidelines).

(2) Text of decision of rejection

The text of decision of rejection includes three parts: brief of the case, grounds for rejection and conclusion.

### 6.1.4 Drafting of Text of Decision of Rejection

#### 6.1.4.1 Brief of the Case

In this part, the process of examination of the application shall be briefly stated, including especially the information relating to the decision of rejection, i. e., all of the observations (including the relevant evidence) and the summaries of the responses of the applicant, defects of the application which are the grounds for rejection, and the text of the application upon which the decision of rejection is based.

#### 6.1.4.2 Grounds for Rejection

In this part, the examiner shall expound explicitly the facts, grounds and evidence upon which the decision of rejection is based, and special attention shall be paid to the following points.

(1) The provisions shall be applied correctly. Where different provisions may be applied simultaneously to reject the application, the most suitable, predominant provisions shall be selected to form the main legal basis of the rejection, in the meanwhile, other substantive defects existing in the application shall be indicated briefly.

(2) Convincing facts, grounds and evidence shall be taken to form the basis of rejection, and the hearing of these facts, grounds and evidence has satisfied the rejection requirements for an application mentioned in Section 6.1.1 of this Chapter.

(3) For applications which are not in conformity with the provisions of Article 22 and to which no patent right shall be granted even after the amendment, analysis shall be made to each of the claims one by one.

The grounds for rejection shall be sufficient and convincing, rigorous in logic and appropriate in wording. The examiner shall not only cite the relevant Articles and/or Rules or only make a conclusion. Brief comments of the examiner shall be made in this part on the arguments of the applicant.

#### 6.1.4.3 Conclusion

In this part, the examiner shall indicate in which case as listed in Rule 53 the grounds for rejection of the present application is, and reach the conclusion of rejecting the application in light of Article 38.

## 6.2 Notification to Grant Patent Right

### 6.2.1 Conditions for Issuing Notification to Grant Patent Right

Art. 39
Rule 54.1

Where it is found after substantive examination that there is no grounds for rejection, the Patent Office shall make a decision to grant the patent right. Before the decision to grant the patent right is made, a *Notification to Grant Patent Right for Invention* shall be issued. The text to which the right is granted must be the final text confirmed by the applicant in written form.

### 6.2.2 Work Involved in Issuing Notification to Grant Patent Right

The examiner is allowed to make the following amendments or rectifications to the text to which the patent right shall be granted *ex officio* before the *Notification to Grant Patent Right* is issued (see Section 5.2.4.2 of this Chapter):

Rule 51.4

(1) the description: amendment of the obviously inappropriate title of the invention and/or technical fields to which the invention pertains; rectification of wrongly written characters and errors in symbols, marks, etc.; amendment of the terms that are obviously non-standard; addition of the missing titles of the various part of the description; and the deletion of the unnecessary explanatory notes in the drawings;

(2) the claims: rectification of wrongly written characters and errors in punctuation marks or in the reference signs of the drawings; the enclosing of the reference signs of the drawings with brackets, etc. However, any amendment that may lead to the change of the scope of protection does not fall into the range of amendments *ex officio;*

(3) the abstract: rectification of the inappropriate contents and obvious mistakes in the abstract.

The above-mentioned amendments or rectifications made by the examiner shall be notified to the applicant.

The following work shall also be conducted sequentially by the examiner: filling in the IPC symbols of the patent identified by himself on the cover of the file and submitting the file to the person of his Division who is responsible for the verification of the IPC symbols; putting the text to which the patent right is going to be granted in the gazette pouch; filling in the prescribed items on the punch and affixing his seal to it; filling in the *Notification to Grant Patent Right* (standard Form) in duplicate, after affixing the seal to them, binding one in the file and putting the other in the folder of the inner cover of the application file; preparing a complete set of the file and filling in on the front and the back cover of the file the record of handing-over of the file and the record of outgoing the documents at the time of granting the patent right. Where the title of the invention has been amended by the applicant, the right of priority has been changed after verification, or after verification the IPC symbols has been rectified, it is also necessary to fill in the *Notification of Change in Bibliographic Data* in duplicate, one is bound before the front page of the first bind-

ing strip of the file, and the other is put in the folder of the inner cover.

## 7. Termination, Suspension and Resumption of Procedure for Substantive Examination

### 7.1 Termination of Procedure

The procedure for substantive examination shall be terminated if the examiner makes a decision of rejection and the decision has entered into force, or the *Notification to Grant Patent Right* has been issued, or the applicant withdraws the application on his own initiative, or the application is deemed to be withdrawn.

As for the rejected or granted application, the examiner shall indicate "rejection" or "grant" in the item of "substantive examination" on the cover of the file, and affix seal to it.

The examiner shall establish a personal examination file for each application for further consultation or for statistics purposes (see Section 3.3 of this Chapter).

### 7.2 Suspension of Procedure

The procedure for substantive examination may be suspended upon the request of the interested party concerned to a dispute relating to the ownership of the right to apply for a patent in accordance with Rule 86.1, or may be suspended due to assets preservation. Once the examiner receives the *Notification of Suspension of Procedure and Recalling of File*, he shall return the file to the proceeding administration department within the prescribed time limit.

### 7.3 Resumption of Procedure

When termination of the procedure of an application results from that the application is deemed to be withdrawn because the time limit as prescribed in the Patent law and its Implementing Regulations or specified by the Patent Office is not observed due to *force majeure* or any justified reason, according to the provisions of Rule 6.1-6.2, the applicant may request the Patent Office to resume the terminated procedure for substantive examination. Where the right is resumed, the Patent Office shall resume the procedure for substantive examination.

Rule 86.3

For the procedure suspended upon the request of the interested party concerned to a dispute relating to the ownership of the right to

apply for a patent, after the Patent Office receives the mediation agreement or written judgment which has entered into force, the procedure shall be resumed immediately if no change in the right owner is involved. Where there is a change in the right owner, the procedure shall be resumed after the formalities of amendment of bibliographic data have been gone through. If, within one year from the date when the request for suspension is filed, no decision is made on the dispute relating to the ownership of the right to apply for a patent, and the person who requested for the suspension does not request for an extension of the suspension, the Patent Office shall resume the procedure for substantive examination on its own initiative.

After receiving the written notice to resume the examination procedure and the patent application file from the proceeding administration department, the examiner shall re-start the procedure for substantive examination.

## 8. Interlocutory Examination and Continuation of Examination after Reexamination

In accordance with Rule 62, the examiner shall perform interlocutory examination on the request for reexamination transferred by the Patent Reexamination Board, and an Office Action shall be made within one month from the date of receiving the file, which will be transferred to the Patent Reexamination Board with the file. The Board shall make a reexamination decision. For the requirements of interlocutory examination, the provisions of Chapter 2, Section 3 of Part IV of these Guidelines shall apply.

Rule 63.2

After the Board makes a decision of withdrawing the decision of rejection of the Patent Office, the examiner shall continue the examination of the application. For the requirements of continuation of the examination, the provisions of this Chapter shall apply. However, in the continuation of the examination, the examiner shall not make a decision of rejection which is opposite to the decision of reexamination based on the same facts, grounds and evidence (see Chapter 2, Section 7 of Part IV of these Guidelines).

# Chapter 9 Some Provisions on Examination of Invention Applications Relating to Computer Programs

## 1. Introduction

Examination of invention applications relating to computer programs has certain characteristics. This Chapter is to present the specific provisions for the examination characteristics of invention applications relating to computer programs based on the provisions of the Patent Law and its Implementing Regulations.

Invention applications relating to computer programs also share common general characteristics with invention applications in other fields. The general proceedings of examination not mentioned in this Chapter shall comply with the provisions set forth in other chapters of these Guidelines when invention applications relating to computer programs are examined.

Computer programs per se said in this Chapter mean a coded instruction sequence which can be executed by a device capable of information processing, e. g. , a computer, so that certain results can be obtained, or a symbolized instruction sequence, or a symbolized statement sequence, which can be transformed automatically into a coded instruction sequence. Computer programs per se include source programs and object programs.

The invention relating to computer programs said in this Chapter refers to solutions for solving the problems of the invention which are wholly or partly based on the process of computer programs and control or process external or internal objects of a computer by the computer executing the programs according to the above mentioned process. The said control or process of external objects includes control of certain external operating process or external operating device, and process or exchange of external data, etc. ; the said control or process of internal objects includes improvement of internal performance of computer systems, management of internal resources of computer systems, and improvement of data transmission, etc. Solutions relating to computer programs do not necessarily include changes to computer hardware.

## 2. Examination Criteria of Invention Applications Relating to Computer Programs

Examination shall focus on solutions for which protection is sought for, i. e. , solutions defined by each claim.

In accordance with Article 25. 1(2), no patent rights shall be granted for the rules and methods for mental activities. Invention applications relating to computer programs fall under the situations described in Chapter 1, Section 4. 2 of this part shall be examined under principles thereof.

(1) If a claim merely relates to an algorithm, or mathematical computing rules, or computer programs per se, or computer programs recorded in mediums( such as tapes, discs, optical discs, magnetic optical discs, ROM, PROM, VCD, DVD, or other computer-readable mediums), or rules or methods for games, etc. , it falls into the scope of the rules and methods for mental activities and does not constitute the subject matter for which patent protection may be sought.

If all the contents of a claim, except its title of the subject matter, merely relate to an algorithm, or mathematical computing rules, or programs per se, or rules or methods for games, etc. , the claim essentially merely relates to rules and methods for mental activities, and does not constitute the subject matter of patent protection.

For example, computer-readable storage medium or a product of computer program that is merely defined by recorded program, or devices for computer games, etc. , which are merely defined by game rules and does not include any technical features, e. g. , those do not include any physical entity, does not constitute the subject matter of patent protection because it essentially merely relates to rules and methods for mental activities. However, the claimed medium in an patent application relating to physical characteristics improvement thereof, for example, layer composition, magic channel spacing, materials, etc. , does not fall into the cases mentioned above.

(2) Besides cases said in (1), if all the contents of a claim include not only rules and methods for mental activities but also technical features, for example, the contents defining the above mentioned devices for computer games include rules for games and technical features as well, then the claim as a whole is not rules and methods for mental activities, and shall not be excluded from patentability in accordance with Article 25.

In accordance with Article 2. 2, "invention" in the Patent Law means any new technical solution relating to a product, a process or improvement thereof. An invention application relating to computer programs is the subject matter of patent protection only if it constitutes a technical solution.

If the solution of an invention application relating to computer programs involves the execution of computer programs in order to solve technical problems, and reflects technical means in conformity with the laws of nature by computers running programs to control and process external or internal objects, and thus technical effects in conformity with the laws of nature are obtained, the solution is a technical solution as provided for in Article 2. 2 and is the subject matter of patent protection.

If the solution of an invention application relating to computer programs involves the execution of computer programs not in order to solve technical problems, or does not reflect technical means in conformity with the laws of nature by computers running programs to control and process external or internal objects, or the effect obtained is not restrained by the laws of nature, the solution is not a technical solution as provided for in Article 2. 2, and is not the subject matter of patent protection.

For example, if the solution of an invention application relating to computer programs involves the execution of computer programs in order to perform control of an industrial process, a measurement or test process, completes a series of control during various stages of industrial process in accordance with the laws of nature through execution of a kind of industrial process control program by a computer, and thus industrial process control effects in conformity with the laws of nature are obtained, the solution is a solution as provided for in Article 2. 2 and is the subject matter of patent protection.

If the solution of an invention application relating to computer programs involves execution of computer programs in order to process a kind of external technical data, completes a series of technical process on the technical data in accordance with the laws of nature through execution of a kind of technical data process program by a computer, and thus technical data process effects in conformity with the laws of nature are obtained, the solution is a solution as provided for in Article 2. 2 and is the subject matter of patent protection.

If the solution of an invention application relating to computer

programs involves execution of computer programs in order to improve the internal performance of a computer system, completes a series of setting or configuration to parts of a computer system in accordance with the laws of nature through execution of a kind of system internal performance improvement program by a computer, and thus internal performance improvement effects of the computer system in conformity with the laws of nature are obtained, the solution is a solution as provided for in Article 2.2 and is the subject matter of patent protection.

## 3. Examination Examples for Invention Applications Relating to Computer Programs

The following are examination examples for invention applications relating to computer programs based on the above examination criteria.

(1) Invention applications relating to computer programs that fall into the scope of Article 25.1(2) are not subject matters of patent protection.

[Example 1]

A method to solve the ratio of the circumference of a circle to its diameter using computer programs

Application summary

The solution of the invention application is a method to solve the ratio of the circumference of a circle to its diameter by computer program. According to this method, a square is first divided by evenly distributed "dots" which are sufficiently accurate; next an inner circle of the square is drawn; then the ratio of the circumference of a circle to its diameter $\pi$ is solved by a computer program. The computer program first carries out a pulse counting of the "dots" which are evenly distributed throughout the said square, and then calculates and obtains the ratio of the circumference of a circle to its diameter $\pi$ according to the following formula:

$$\pi = \frac{\sum \text{count value of the "dots" in the circle}}{\sum \text{count value of the "dots" in the square}} \times 4$$

In the calculation, the closer the "dots" are located, the more accurate the ratio of the circumference of a circle to its diameter $\pi$ is.

Claims of the application

A method to solve the ratio of the circumference of a circle to its

diameter using computer programs, characterized in that it includes the following steps:

calculating the number of "dots" in a square;

calculating the number of "dots" in the inner circle of the said square;

solve the ratio of the circumference of a circle to its diameter using formula

$$\pi = \frac{\sum \text{count value of the "dots" in the circle}}{\sum \text{count value of the "dots" in the square}} \times 4$$

Analysis and conclusion

This solution merely relates to a pure mathematical computing method or rule executed by computer programs, and is essentially an abstract thinking method of human, therefore, this invention application belongs to rules and methods for mental activities as provided for in Article 25. 1(2) and is not the subject matter of patent protection.

[Example 2]

A method of automatically computing the coefficient of kinetic friction $\mu$

Application Summary

The solution of the invention application relates to a method of computing the coefficient of kinetic friction $\mu$ using computer programs. The traditional method to measure the coefficient of kinetic friction is to draw the restiform body to be measured at a fixed speed by a device so as to obtain the position variables of the friction plate $S_1$ and $S_2$ respectively, and then to calculate the coefficient of kinetic friction $\mu$ of the restiform body according to the following formula:

$\mu = (\log S_2 - \log S_1)/e$

Claims in the application

A method of automatically computing the coefficient of kinetic friction $\mu$ using computer programs, characterized in that it includes the following steps:

calculating the ratio of the position variables, $S_1$ and $S_2$, of the friction plate;

calculating the logarithm, $\log S_2/S_1$, of the ratio $S_2/S_1$;

solving the ratio of the logarithm $\log S_2/S_1$ to $e$.

Analysis and conclusion

The solution is not an improvement of the measurement method but a numerical computing method executed by a computer program,

although what to be solved relates to physical quantity, the solving process is a kind of numerical computing, and the solution on the whole is a mathematical computing method. Therefore, this invention application belongs to rules and methods for mental activities as provided for in Article 25. 1(2) and is not the subject matter of patent protection.

[Example 3]

A general transition method for global language characters

Application summary

Existing automatic translation systems are merely one-to-one, one-to-multiple, or multiple-to-multiple language processing systems, which have the problems of complicated programs, and different, complex and a large number of notation methods for various parts of speech. To overcome the problems, the invention application presents a unified translation method for any global language realizing unification of grammar, syntax of different languages by means of "global language character input method" which is the same as the Esperanto auxiliary language notation method, and Esperanto and Esperanto auxiliary language are used as the inter-language of machine translation during language transition.

Claims in the application

A general transition method for global language characters by computers, which includes the following steps:

forming corresponding auxiliary language of the input language by first using consonant word-notation, then consonant sentence-notation uniformly after words;

completing language transition using the corresponding relationship between inter-language and auxiliary language of the input language, and the said inter-language are Esperanto and Esperanto auxiliary language;

characterized in that the said methods for word-notation and sentence-notation of input language are the same as those of forming Esperanto auxiliary language, the said word-notation method is: -m means noun, -x means adjective, -y means plural, -s means quantifier, -f means adverb; the said sentence-notation method is: -z means subject, -w means predicate, -d means attribute, -n means object, -b means complement including predicative, and -k means adverbial modifier.

Analysis and conclusion

Although the title of the subject matter of this solution includes

computer, all the contents thereof merely realize unified translation transition for global languages by unified translation inter-language and regulating the input rules for global language characters artificially. The solution is not an improvement of the machine translation, and does not embody the improvement of the combination between intrinsic objective language characteristics of different languages and the computer technology in the machine translation, but relates to the re-regulation and re-definition of the transition rules for language characters based on the inventor' s own subjective understanding, and merely embodies the unifying of the corresponding relationship between the auxiliary language of the input language and the inter-language into the word-notation and sentence-notation rules of the Esperanto auxiliary language, thus is essentially rules and methods for mental activities as provided for in Article 25.1(2), and is not the subject matter of patent protection.

(2) Invention applications relating to computer programs that use technical means in order to solve technical problems and obtain technical effects are technical solutions as provided for in Article 2.2, and therefore are subject matters of patent protection.

[Example 4]

A method for controlling a die forming process of rubber

Application summary

The invention application relates to a method for controlling a die forming process of rubber using computer programs. The said computer program accurately controls, in real time, the time of vulcanization of the rubber in the forming process, thus can rectify the defects of over-vulcanization and under-vulcanization, which often occur in the existing process, and can greatly improve the quality of the rubber products.

Claims in the application

A method for controlling a die forming process of rubber by using computer programs, characterized in that it includes the following steps:

sampling rubber vulcanization temperature through temperature sensor;

computing positive vulcanization period in the vulcanization process for rubber product in response to the vulcanization temperature;

determining whether the said positive vulcanization time reaches

required positive vulcanization time;

sending vulcanization halt signal if the said positive vulcanization time reaches required positive vulcanization time.

Analysis and conclusion

This solution is a method for controlling a die forming process of rubber by using computer programs in order to solve the problem of over-vulcanization and under-vulcanization of rubber, which is a technical problem. The solution is a method by which a die forming process of rubber is controlled through execution of computer programs. Therefore what it reflects is the accurate and real-time control over rubber vulcanization time based on rubber vulcanization principles, and what it utilizes is the technical means in conformity with the laws of nature. Because of the accurate and real-time control over vulcanization time, the quality of rubber product is improved greatly. Therefore, what are obtained by the method are technical effects. Thus, this invention application is a solution performing industrial process control through execution of computer programs, which belongs to technical solutions as provided for in Article 2. 2 and is the subject matter of patent protection.

[Example 5]

A method for enlarging storage capacity of mobile computing devices

Application summary

Existing mobile computing devices, e. g. , portable computer, mobile telephone, etc. , usually use small-storage-capacity flash memory card as storage medium due to its size and the requirement of portability, hence, the mobile computing devices cannot process multimedia data which need large storage capacity due to storage capacity limits, and multimedia technology cannot be applied in mobile computing devices. The invention application provides a method of enlarging storage capacity of mobile computing devices using virtual device file systems, so that mobile computing devices can use large storage space on servers for local applications.

Claims in the application

A method for enlarging storage capacity of mobile computing devices using virtual device file systems characterized in that it includes the following steps:

building up a virtual device file system module on a mobile computing device, and hanging it on the operating systems of the mobile

device;

providing virtual storage space to applications on the mobile computing device through the virtual device file system module, and sending read/write request on the virtual storage space to the remote server through network;

converting read/write request from the mobile computing device to read/write request on local storage devices on the remote server, and sending read/write result back to the mobile computing device through network.

Analysis and conclusion

This solution is a method for improving storage capacity of mobile computing device, therefore what it solves is a technical problem on how to increase effective storage capacity of mobile computing devices, e. g. , portable computers. This solution is a method by which internal operating performance of mobile computing devices is improved through execution of computer programs. Therefore, what it reflects is to build up virtual storage space on local computers through virtual device file system module and convert access to local storage devices into access to storage devices on servers. What it utilizes is technical means in conformity with the laws of nature, and what is obtained is the technical effect that data storage is not restrained by storage capacity of mobile computing devices. Thus, this invention application is a solution realizing internal performance improvement of computer systems through execution of computer programs, which belongs to the solutions as provided for in Article 2. 2, and is the subject matter of patent protection.

[Example 6]

A method of removing image noise

Application summary

Prior art usually adopts the approach of mean filter, i. e. , replacing pixel value of the noise with the mean value of pixels surrounding the noise, to remove image noise, however, it will decrease the grey difference of neighboring pixels, and render the image to blur. The invention application proposes a method of removing image noise, in which, based on $3\theta$ principle in probability statistical theory, the pixel whose grey value is greater or less than the mean value with more than 3 times variance are regarded as noise and is removed, while whose grey value is within 3 times variance above or below the mean value will not be modified. Thus, according to the invention, not only image

noises are removed effectively, but image blur phenomena caused by removing image noise can be reduced as well.

Claims in the application

A method for removing image noises characterized in that it includes the following steps:

obtaining every pixel data of the image to be processed in a computer;

computing the grey mean value and the grey variance of the said image from the grey values of all the image pixels;

reading the grey values of all the image pixels, and determining whether the gray value of every pixel is within 3 times variance above or below the mean value, if yes, then not modifying the said pixel gray value, otherwise, regarding the pixel as a noise, removing it by modifying its grey value.

Analysis and conclusion

What this solution solves is a technical problem on how to remove the image noise effectively and meanwhile reduce the image blur phenomena due to image noise processing. This solution is a method by which noises of image data are removed through execution of computer programs. Therefore, what it reflects is the approach of taking pixels whose grey value are greater or less than mean value with more than 3 times variance as noises and removing them, and taking pixels whose grey value are within 3 times variance above or below the mean value as image signal and not modifying their gray value, thus avoiding the drawback of replacing all the pixels with mean value in the prior art. What it utilizes is technical means in conformity with the laws of nature. According to the invention, the effect of the effective removal of image noise and the decrease of image blur phenomena due to image noise removal can be obtained. In the meantime, the computing amount of the system is reduced due to obvious decrease of replaced pixels, and the speed and quality of image process are increased. Thus, what is obtained by the method of the invention is technical effect. Therefore, the invention application is a solution realizing external technical data processing through execution of computer programs, which belongs to technical solutions as provided for in Article 2. 2 and is the subject matter of patent protection.

[Example 7]

A method of measuring liquid viscosity by using computer programs

Application summary

Liquid viscosity is a frequently used and important technical parameter in liquid producing and applying process. Common liquid viscosity measuring method is performed manually by use of rotational measuring device. According to the common method, first, an engine drives the rotor to rotate in the liquid, the rotating angle of the rotor is reflected through the rotating angle of the pointer on the dial, then the rotating angle on the dial is read, and the liquid viscosity is obtained. Ensuing problems are the measurement process is done manually, measuring speed is slow, accuracy is low, and therefore the method does not suit for real-time live measurement. The invention application proposes a liquid viscosity measuring method controlled by computer programs, by which the process of data collecting, data processing and data presentation for liquid viscosity measurement are controlled automatically through execution of computer programs, thus the real-time liquid viscosity measurement on site can be realized.

Claims in the application

A method of measuring liquid viscosity using computer programs characterized in that it includes the following steps:

determining suitable rotating speed for sensor rotor through preset parameter signal processing program in terms of liquid type;

starting the sensor rotor and making it shear rotate in the liquid at the said rotating speed by the sensor rotor control program, and converting liquid sticky resistance value detected by the sensor rotor into circuit signal;

calculating the liquid viscosity basing on the said circuit signal by sensor rotor signal processing program, and sending the calculated viscosity value to the LCD for display, or sending it to the production control center through communication ports.

Analysis and conclusion

This solution is a method for measuring liquid viscosity. What it solves is the technical problem on how to improve the speed and accuracy of liquid viscosity measurement. The solution is a method by which liquid viscosity measuring process is controlled through execution of computer programs. What it reflects is the automatic control over the sensor rotor working process, including selection of sensor rotor rotating speed, starting running status, etc., the process of collected technical data processing, and the process of displaying measuring result. What it utilizes is the technical means in conformity with the laws

of nature, and what is obtained is the technical effect of the real-time measurement of liquid viscosity on site, and the improvement of speed and accuracy of liquid viscosity measurement. Therefore, this invention application is a solution realizing measurement or testing process control through execution of computer programs, which belongs to the technical solutions as provided for in Article 2. 2 and is the subject matter of patent protection.

(3) Invention applications relating to computer programs which do not solve technical problems, or do not utilize technical means, or do not obtain technical effects, are not technical solutions as provided for in Article 2. 2, and therefore are not subject matter of patent protection.

[Example 8]

A method for computer game

Application summary

In terms of existing computer game types, one type is to achieve learning while playing through the question and answer approach, the other is the grown-up type game, realizing the change of game roles and game environment based on the grown-up of game roles. The invention application combines the merits of the said two types of games into one single computer game, realizing the change of game roles and game environment through the question and answer approach in the game. This game method provides one game interface to users, and displays corresponding questions according to game progress; when users input answers to the questions, determines whether the said answers are right or not in order to determine whether or not to change the level, equipment or environment of the game role run by users.

Claims in the application

A computer game method featured with both grown-up type and question-and-answer type for users, characterized in that it includes:

questioning step, selecting question materials corresponding to the game progress from stored question materials, answer materials corresponding to the said question materials and game progress materials when users enter the game environment through computer game devices, and displaying the question materials to users;

score determining step, determining whether or not answers input by users are the same as the stored answer materials corresponding to the said questions based on presented question materials, if yes, then go to the next step, if no, then go back to the questioning step;

changing game status step, determining the level, equipment, or environment of game roles run by users based on the result in the score determining step and stored score recording materials for question and answer. If the number of right answers reaches certain level, then the level, equipment or environment thereof will be upgraded or increased accordingly; if the number of right answers does not meet certain requirements, the level, equipment or environment thereof will not be changed.

Analysis and conclusion

This solution is to combine question-and-answer type and grown-up type game together into one computer game method through computer executing the well-known programs for processing control over question-and-answer type game. This method makes game roles and environment change correspondingly in the question and answer process by means of question-and-answer and game role status change. Although, according to this solution, users access into computer gaming environment by gaming devices and game process is controlled through execution of computer programs, the said gaming devices are well-known gaming devices, control over the said game process neither improves the internal performance of game devices, e. g. , data transmission, internal resource management, etc. , nor causes any technical change to the composition or function of the said game devices. The aim of said solution is to combine characteristics of two types of games based on human will, and thus does not constitute a technical problem. What it utilizes is not technical means but to combine both question-and-answer and grown-up type games based on man-made activity rules. What is obtained is not technical effect but merely the effect of management and control of combining process of question-and-answer type game and grown-up type game, which is merely management and control of game process or game rules. Therefore, this invention application is not the technical solution as provided for in Article 2. 2 and is not the subject matter of patent protection.

[Example 9]

A system for learning foreign language with active selection of learning contents

Application summary

For existing systems for learning foreign language with computers as assisting tools, learning contents are preset, and users must learn these preset contents instead of determining learning contents accord-

ing to their language proficiency. According to the invention application, which enables user to select learning materials based on his needs, first, the user inputs the said materials into the system; second, the system divides sentences of the materials into multiple sentence units through execution of programs; third, the user reorders divided sentence units into sentences and inputs the reordered sentences into the system; finally, the system compares the reordered sentences with the original ones through execution of programs, scores based on preset scoring criteria, and outputs the scores to the user.

Claims in the application

A system for learning foreign language with active selection of learning contents characterized in that it includes:

learning machine, into which a user input selected learning materials;

file receiving module, receiving language files input by the user;

file dividing module, dividing the said language file into at least one independent sentence;

sentence dividing module, dividing the said independent sentences into multiple divided units;

sentence-making language learning module, outputting the said divided units to the user, receiving reordered sentences from the user, comparing the said independent sentences with reordered sentences input by the user, scoring based on preset scoring criteria, and outputting the score to the user.

Analysis and conclusion

This solution is to form a learning system by a set of computer program function modules, which can receive language files determined and input by users, compare sentences thereof with reordered sentences by users, and output comparing results to users. Although the learning system realizes the aim of control over learning process by the learning machine executing computer programs, the said learning machine is well-known electronic equipment, the division, reordering, comparison, and scoring of sentences neither improve the internal performance of the learning machine, nor cause any technical change to the composition or function of the learning machine. What the system aims to solve is how to determine learning contents based on users' objective will, and thus does not constitute a technical problem. What it utilizes is making learning rules artificially and following these rules without restriction of the laws of nature, and thus is not technical

means. The system enables users to actively select learning contents according to their needs, and further improve learning efficiency. What is obtained is not technical effect in conformity with the laws of nature. Therefore, this invention application is not the technical solution as provided for in Article 2. 2 and is not the subject matter of patent protection.

Art. 25. 1(2)

### 4. Chinese Character Encoding Method and Chinese Character Inputting Method for Computers

Chinese character encoding method is an information presentation method, like presentation methods of voice signal, language signal, visual display signal or traffic signal, etc. What it solves is merely determined by human expressing will, what it adopts is merely man-made coding rules, and what is obtained by implementing the said coding method is merely a symbol/alphanumeric string. The solved problems, the utilized means, and the obtained effects do not comply with the laws of nature. Therefore, invention applications merely relating to Chinese character coding method belong to rules and methods for mental activities as provided for in Article 25. 1(2) and are not the subject matter of patent protection.

For example, the solution of an invention application merely relates to a method for encoding the radicals of Chinese characters, which is used to compile dictionaries and to search the Chinese characters in the said dictionaries. According to the method for encoding the Chinese characters of the invention application, rules for encoding the Chinese characters are made artificially merely based on knowledge and understanding of the inventor, that is to select, designate and combine the code elements for encoding the Chinese characters so as to form the code/alphanumeric strings to express the Chinese characters. The said Chinese character encoding method neither solves any technical problems, nor utilizes any technical means, or produces any technical effects. Therefore, the said method for encoding the Chinese characters of the invention application belongs to rules and methods for mental activity as provided for in Article 25. 1(2) and is not the subject matter of patent protection.

However, if the method for encoding the Chinese characters is combined with a special keyboard so that it works as a method for inputting the Chinese characters into a computer system which processes the Chinese characters or as a method for a computer to process the

Chinese character information, enables the known computer system to use the information in the form of the Chinese characters as instruction, execute programs, and thus control or process external objects or internal objects, the Chinese character inputting method for computers or Chinese character information processing method for computers belongs to technical solutions as provided for in Article 2. 2 instead of rules and methods for mental activity, and is the subject matter of patent protection.

For such an invention application relating to a method for inputting the Chinese characters into a computer, which combines the method of encoding the Chinese characters with a special keyboard used for this encoding method, the technical features of the Chinese character inputting method shall be described in the description and the claims. When necessary, the technical features of the keyboard used for this method, including the definition of every key on the keyboard and the location of every key on the keyboard, etc. , shall also be illustrated.

For example, the subject matter of an invention application relates to a method for inputting the Chinese characters into a computer, comprising the steps of selecting a determined number of specific radicals from all the radicals of the Chinese characters as the code elements for encoding, assigning the said code elements for encoding to the corresponding keys on the keyboard and inputting the Chinese characters according to the rules of encoding and inputting the Chinese characters by using the specific keys on the keyboard.

This invention application is a method for inputting the Chinese characters into a computer that combines the method for encoding the Chinese characters with the special keyboard. This inputting method enables the known computer system to run according to information in the Chinese characters, and therefore increases the processing function of the computer system. What the said invention application aims to solve is a technical problem, what it utilizes is technical means, and it can produce technical effects. Therefore, the said invention application constitutes a technical solution and is the subject matter of patent protection.

### 5. Drafting of Description and Claims of Invention Applications Relating to Computer Programs

In principle, the requirements for drafting the description and the claims of an invention application relating to computer programs are

the same as those for drafting the description and the claims of invention applications in other technical fields. Following are the specific requirements for drafting the description and the claims of an invention application relating to computer programs.

Art. 26. 3

**5. 1 Drafting of Description**

The description of an invention application relating to computer programs shall, in addition to outlining the technical solution of the invention as a whole, illustrate the concept of design and the technical features of the computer program concerned and the mode of exploitation to produce the technical effect in a clear and complete manner. In order to outline the main technical features of the computer program clearly and completely, the principal flow chart of the computer program shall be presented in the drawings of the description. An explanation of every step of the computer program shall be made in the description in natural language based on the said flow chart in chronological order. The main technical features of the computer program shall be described in the description to such extent that a person skilled in the art can, on the basis of the flow chart presented in the description and explanation thereof, produce the computer program capable of producing the technical effect as described in the description. In order to describe clearly, where necessary, the applicant may briefly extract some important parts from the computer source program, in marked program language that is customarily used, to serve as a reference, but it is not necessary to provide the whole source program.

If an invention application relating to computer programs includes contents concerning changing the hardware structure of computer devices, the hardware entity structure graph of the said computer devices shall be presented in the drawings of the description, and the component parts of the hardware of the said computer devices and the mutual relationships thereof shall be described in the description, based on the said hardware entity structure graph, in clear and complete manner so as to enable a person skilled in the art to carry out the invention.

Art. 26. 4
Rule 20. 2

**5. 2 Drafting of Claims**

The claims of an invention application relating to computer programs may be drafted as process claim or product claim, i. e. , the apparatus for executing the process. No matter what kind of claim it is drafted as, the claim shall be supported by the description, represent

the technical solution of the invention in its entirety and outline the essential technical features for resolving the technical problems, and do not describe resumptively the functions of the computer program and the effects those functions can produce only. If it is drafted as a process claim, the various functions to be performed by the computer program and the way to perform the functions shall be described in detail according to the steps of the process. If it is drafted as an apparatus claim, the various component parts and the connections among them shall be specified, and a detailed account shall also be given on the component parts by which the various functions of the computer program are performed, and on how these functions are performed.

If an apparatus claim is drafted on the basis of computer program flow completely and according to the way completely identical with and corresponding to each step in the said computer program flow, or according to the way completely identical with and corresponding to the process claim reflecting the said computer program flow, i. e., each component in the apparatus claim completely corresponds to each step in the said computer program flow or each step in the said process claim, then each component in the apparatus claim shall be regarded as function modules which are required to be built to realize each step in the said computer program flow or each step in the said method. The apparatus claim defined by such a group of function modules shall be regarded as the function module architecture to realize the said solution mainly through the computer program described in the description rather than entity devices to realize the said solution mainly through hardware.

As references, the following are examples of inventions relating to computer programs, which are drafted as process claim and apparatus claim respectively.

[Example 1]

The independent claim of a patent application for invention, entitled “the cursor control of the characters on the CRT screen”, may be drafted as the following process claim:

A method for controlling the characters on the CRT screen by a cursor, comprising:

the inputting step for inputting information;

the step of storing the starting position addresses of the horizontal movement and vertical movement of the cursor into a H/V starting position memory unit;

the step of storing the designation addresses of the horizontal movement and vertical movement of the cursor into a H/V designation memory unit;

the step of storing the horizontal and vertical addresses of the current position of the cursor into a cursor position memory unit; and characterized by further including:

the step of comparing the current horizontal and vertical addresses of the cursor stored in the said cursor position memory unit with the corresponding horizontal and vertical designation addresses stored in the H/V designation memory unit respectively;

the step of transformation of the cursor position controlled by the output signal from the said inputting keyboard and output signal of the said comparator, which may select the following performances:

increment as a single character position to the horizontal and vertical addresses stored in the cursor position memory unit;

decrement as a single character position from the horizontal and vertical addresses stored in the cursor position memory unit; or

setting the horizontal and vertical starting position addresses stored in H/V starting position memory unit to cursor position memory unit;

the step of cursor display, in which the current position of the cursor on the screen is displayed according to the memory state of the cursor position memory unit.

[Example 2]

The claim of the patent application for invention described in example 1, which relates to a computer program, is drafted as an apparatus claim.

A cursor controller for CRT screen, comprising:

an inputting means for inputting information;

the H/V starting point memory means for storing the starting position addresses of the horizontal movement and vertical movement of the cursor;

the H/V designation memory means for storing the designation addresses of the horizontal movement and vertical movement of the cursor;

a cursor position memory means for storing the horizontal and vertical addresses of the current position of the cursor; and characterized by further including:

a comparator for respectively comparing the current horizontal

and vertical addresses of the cursor stored in the said cursor position memory means with corresponding horizontal and vertical designation addresses stored in the H/V designation memory means;

a cursor position transformation means controlled by the output signal from the said inputting keyboard and the output signal from the comparator, which includes:

means for increasing as a single character position the horizontal and vertical addresses stored in the cursor position memory means;

or means for decreasing as a single character position from the horizontal and vertical addresses stored in the cursor position memory means;

or means for setting the horizontal and vertical starting position addresses stored in the H/V starting position memory means to the cursor position memory means;

a cursor display means which displays the current position of the cursor on the screen according to the memory state of the cursor position memory means.

[Example 3]

An invention application relating to "a computer system suitable for sequence control and servo control" uses parallel processing to conduct sequence control and servo control by taking the instructions of opening, closing, and pausing as the parallel processing instructions between the first and second programs. The independent process claim of this invention may be drafted as the following:

A process to conduct sequence control and servo control by taking the instructions of opening, closing, and pausing as the parallel processing instructions is characterized by adopting the following steps:

storing the sequence control program or servo control program which is going to execute the task into the program memory of the computer system;

starting the computer system, and the CPU fetching instructions, executing operation according to the program counter unit, and updating the program counter unit according to the executive instructions;

if the executing instructions are program instructions, the updating of the program counter unit is identical with that of the general computer;

if the executing instructions are opening instructions, the program counter unit is updated as the address of instructions following this

opening instruction, i. e. , the first address of the parallel processing program which is going to be opened so as to start the operation of the sub-process of controlling;

if the executing instructions are closing instructions, the program counter unit is updated by the address selected from the address list or the address of the instruction following this closing instruction, so that the program per se which issues the said closing instruction or another parallel program stops its execution and other parallel programs start into operation at the same time;

if the executing instructions are pausing instructions, the program counter unit is updated by the address of the instruction following this pausing instruction so that the execution of the program shall be suspended for a certain period of time according to the requirements, and another parallel program is started simultaneously in the period.

# Chapter 10 Some Provisions on Examination of Invention Applications in the Field of Chemistry

## 1. Introduction

Many special issues exist in the examination of invention applications in the field of chemistry. For example, under most circumstances, whether a chemical invention can be carried out is difficult to be predicted and needs to be verified and confirmed by virtue of test result; some chemical products whose structures are not clear yet have to be defined by virtue of their property parameters and/or methods of preparation; the discovery of the new property or use of a known chemical product does not mean the change of its structure or composition. Therefore, the product cannot be regarded as possessing novelty; some inventions relating to biological material cannot be carried out merely according to the written disclosure of the description, and the deposit of the biological material shall be used as a supplementary means. This Chapter is meant to set forth some provisions on how to handle issues that are particular to the examination of invention applications in the field of chemistry according to the principles of the Patent Law and its Implementing Regulations, provided that the general provisions of these Guidelines are satisfied.

## 2. Applications for Chemical Invention for Which No Patent Right Shall Be Granted

### 2.1 Natural Substances

A substance, found in the nature and existing in its natural state, is merely an object of discovery in the sense of the "scientific discoveries" as provided for in Article 25.1(1), and no patent right shall be granted for it. However, if a substance is isolated or extracted from the nature for the first time, of which the structure, the morphology or other physical/chemical parameters are unknown in the prior art and can be precisely characterized, and if it can be exploited industrially, the substance per se and the process for obtaining it are all patentable under the Patent Law.

### 2.2 Medical-use of Substances

As the medical-use of a substance is a use for the diagnosis or treatment of diseases, it falls into the situations provided for in Article 25.1(3); hence, it shall not be granted the patent right. However, if it is used for the manufacturing of a medicament, it may be patentable under the Patent Law (see Section 4.5.2 of this Chapter).

Art. 26.3

## 3. Sufficient Disclosure of Chemical Invention

### 3.1 Sufficient Disclosure of Chemical Product Invention

Here, the word "chemical product" includes compound, composition, and chemical product which cannot be clearly described by its structure and/or composition. Where the claimed invention is a chemical product itself, the description shall describe the identification, preparation and use of the chemical product.

(1) Identification of a chemical product

As for the invention of a compound, the description shall indicate the chemical name and the structural formula (including various function groups, molecule steric-configuration and so on) or the molecular formula of said compound. The explanation of the chemical structure shall be clear enough to enable a person skilled in the art to identify the compound. In order to clearly identify the claimed compound, the description shall describe the chemical/physical property parameters (such as the various qualitative or quantitative data and spectrum, etc.) relating to the technical problem to be solved by the invention. Moreover, in the case of a high molecular compound, besides the name, the structural or molecular formula of its repeating units shall be described according to the same requirements as those of the above-mentioned compound, the description shall properly state its molecular weight and the distribution thereof, the arrangement state of its repeating units (such as homopolymeric, copolymeric, block-polymeric or graft-polymeric state), etc. If the high molecular compound cannot be completely identified by these structural elements, the property parameters, such as crystallinity, density and second-order transition point, shall also be described.

As for the invention of a composition, besides the components of the composition, the description shall describe the chemical and/or physical state of each component, the range of selection of each com-

ponent, the range of content of each component and its effect on the property of the composition.

As for a chemical product which cannot be clearly described merely by its structure and/or composition, the description shall further state the product by proper chemical/physical parameters and/or the manufacturing process, so that the claimed chemical product can be clearly identified.

(2) Preparation of chemical product

The description of a chemical product invention shall describe at least one preparation method and disclose the raw materials, procedures, conditions and specially adapted equipment used for carrying out the method so as to make it possible for a person skilled in the art to carry it out. In the case of a compound invention, the example of its preparation is usually required.

(3) Use and/or its technical effect of chemical product

As for a chemical product invention, the use and/or its technical effect of the product shall be completely disclosed. Even if the structure of the compound has been confirmed for the first time, at least one use of the compound shall be described.

If a person skilled in the art is unable, on the basis of the prior art, to predict that the use and/or its technical effect stated in the invention can be carried out, the description shall sufficiently provide qualitative or quantitative data of experimental tests for the person skilled in the art to be convinced that the technical solution of the invention enable the use to be carried out and/or the effect as expected to be achieved.

For a new pharmaceutical compound or pharmaceutical composition, not only its specific medical use or pharmacological action, but also its effective amount and the method of application shall be described. If a person skilled in the art is unable, on the basis of the prior art, to predict that said use or action stated in the invention can be carried out, the qualitative or quantitative data of the laboratory test (including animal test) or clinical test shall be sufficiently provided for the person skilled in the art to be convinced that the technical solution of the invention can solve the technical problem or achieve the technical effect as expected. The description shall describe effective amount, method of application or method of formulation to such an extent that the person skilled in the art can carry it out.

As for the property data showing the effect of the invention, the

method used to measure it shall be specified when various measuring methods for it in the prior art yield different results. If it is a special method, it shall be explained in detail to enable a person skilled in the art to carry it out.

### 3.2 Sufficient Disclosure of Chemical Process Invention

(1) For a chemical process invention, regardless of a process for preparing a substance or any other process, the raw materials, procedures and processing conditions adopted in the process shall be described. If necessary, the effect of the process on the property of the title substance shall be described so as to enable a person skilled in the art, when carrying out the invention according to the process described in the description, to solve the problem which the invention is intended to solve.

(2) As for the raw materials used in the process, the components, property, manufacturing process or source of it shall be described in such a manner that a person skilled in the art can obtain it.

### 3.3 Sufficient Disclosure of Use Invention of Chemical Product

As for a use invention of a chemical product, the description shall describe the chemical product to be used, the method for using the product and the effect to be achieved to enable a person skilled in the art to carry it out. If the product to be used is a new chemical product, the statement of the product in the description shall comply with relevant requirements in Section 3.1 of this Chapter. If a person skilled in the art can not predict the use according to the prior art, the description shall sufficiently provide data of experimental tests for a person skilled in the art to be convinced that the product is useful for said use and can solve the technical problem or achieve the technical effect as expected.

### 3.4 Specific Mode for Carrying Out the Invention

Chemistry is an experimental science, and a number of inventions in this field need to be verified by experimentation, therefore, the description generally shall include embodiments, in case of an invention of a product, for instance, those which specifically show how to make the product and how to use it.

(1) The number of embodiments needed in the description depends on the extent to which the technical features are generalized in

the claim, such as the extent of generalization of parallel alternative elements and the range of selected values of data. The number of embodiments needed in a chemical invention varies depending on the nature and specific fields of technology of the invention. As a general rule, there shall be a sufficient number of embodiments for a person skilled in the art to understand how to carry out the invention and to assess that the invention can be carried out and achieve the effect as expected through the whole of the scope defined by the claims.

(2) Whether or not the description is sufficiently disclosed is judged on the basis of the disclosure contained in the initial description and claims, any embodiment and experimental data submitted after the date of filing shall not be taken into consideration.

## 4. Claim of Chemical Invention

Art. 26.4

### 4.1 Claim of Compound

The claim of a compound shall be characterized by the name or the structural or molecular formula of the compound. The compound shall be named according to general nomenclature, rather than a trade name or code name. The structure of the compound shall be clear enough, and any ambiguous or vague wording is not permitted.

### 4.2 Claim of Composition

Art. 26.4

#### 4.2.1 Open-Ended Mode, Close-Ended Mode and Their Application Requirements

In accordance with the provisions of Rule 21.2, if it is not appropriate, according to the nature of the invention, to present the independent claim in the form of a preamble portion and characterizing portion, it may be presented in other form. Generally, the claim for composition is such an example.

The claim for a composition shall be characterized by the features of the composition, such as the components, or the components and the contents thereof. There are two modes of presentation for the claim of a composition: open-ended and close-ended. The open-ended mode means that the composition does not exclude those components that are not mentioned in the claim. The close-ended mode means that any of the other components that are not mentioned in the claim shall be excluded. The commonly used wording for open-ended mode and close-

ended mode is as follows:

(1) open-ended mode: wording such as "comprising", "including", "containing", "essentially comprising", "substantially comprising", "mainly consisting of", "be mainly composed of", "substantially consist of", "be substantially composed of", etc. All of them indicate that some components which are not indicated in the claim may be further included in the composition, though the indicated components may take quite a great proportion in content;

(2) close-ended mode: wording such as "consisting of…", "be composed of…", "be balanced with …", etc. All of them indicate that the composition claimed is composed of the indicated components only, without any other components to be included in. However, there may be impurities, and the impurities may take only normal proportion in content.

It shall be noted that, when the open-ended mode or close-ended mode expressions are used, they must be supported by the description. For example, the claim of a composition is A + B + C. If there is, in fact, no other component described in the description, it shall not be presented in an open-ended mode.

It shall also be pointed out that if the independent claim of a composition is A + B + C, where the claims following it is A + B + C + D, if the claim A + B + C is in open-ended mode, the claim involving component D shall be a dependent claim; if the claim A + B + C is in close-ended mode, the claim involving component D shall be an independent claim.

#### 4.2.2 Definition of Component and Content in Claim of Composition

Rule 20.2

(1) If the substance or improvement of an invention lies in the components per se, the solution to the technical problem only depends on the selection of the components, and a person skilled in the art can determine the contents of the components according to the prior art or by simple experiment, it is permitted to only define the components in the independent claim. However, if the substance or improvement of an invention lies both in the components and relates to the contents thereof, the solution to the technical problem depends not only on the selection of the components, but also on the determination of the particular contents of said components. In this case, both the components and the contents shall be defined in the independent claim, otherwise the claim

is not complete, and lacks essential technical features.

Rule 20.2

(2) In certain technical fields, such as the field of alloys, both the necessary components and the contents thereof usually shall be defined in the independent claim.

Art. 26.4

(3) No ambiguous or vague words such as "about", "or so", "approximately", etc., shall be used to define the content of a component. Usually, such words shall be deleted whenever they appear. The content of the component may be indicated by "0-X", "$< X$" or "less than X", etc. The component indicated by "0-X" is optional component. By "$< X$" or "less than X", etc., "$X = 0$" is also included. It usually shall not be allowed to use "$> X$" to indicate the range of content.

Art. 26.4

(4) The total sum of the content in percentage of each component of a composition shall be equal to 100% and the ranges of the contents of the components shall meet the following requirements:

the maximum value of the content of one component + minimum values of the contents of all the other components $\leqslant 100$;

the minimum value of the content of one component + maximum values of the contents of all the other components $\geqslant 100$.

Art. 26.4

(5) Where it is difficult to indicate the particular relations among the components of a composition by words or by numerical value, the claim may be defined by a formula showing the characteristic relation or amount relation or by the use of a diagram. The specific meaning of the diagram shall be explained in the description.

Art. 26.4

(6) Qualitative written description instead of numeric quantitative expressions is acceptable if it is clear in meaning and known in the relevant field of technology, such as "the content is sufficient to make certain material moistened", "catalytic amount", etc.

Art. 26.4

### 4.2.3 Other Definition for Claim of Composition

Generally, there are three types of claims of a composition: non-defining, function-defining and use-defining. Examples are:

(1) "A hydrogel composition comprising polyvinyl alcohol of molecular formula (I), saponifier and water" (the molecular formula (I) is omitted here);

(2) "A magnetic alloy comprising 10%-60% by weight of A and 90%-40% by weight of B"; and

(3) "A butene dehydrogenation catalyst comprising $Fe_3O_4$ and $K_2O$...".

Among the above, (1) is a non-defining type, (2) is a function-defining type and (3) a use-defining type.

When the composition possesses two or more applicable properties or application fields, the use of a non-defining claim is permitted. For example, according to the description, the hydrogel composition in above-mentioned (1) possesses such properties as formability, hygroscopicity, film-formability, adhesivity and high caloricity; hence, it can be used in such fields as a food additive, a gluing agent, an adhesive, a coating material, a microorganism culture medium or a heat insulation medium.

If there is only one property or use of the composition disclosed in the description, the composition shall be drafted as the function-defining or use-defining type, such as (2) or (3) mentioned above. In certain fields, such as the field of alloys, the intrinsic property and/or use of the invented alloy usually shall be specified. Most pharmaceutical claims shall be drafted as the use-defining type.

### 4.3 Claim of Chemical Product Which Cannot Be Clearly Characterized Merely by Features of Structure and/or Composition

As for a claim of a chemical product which cannot be clearly characterized merely by features of structure and/or composition, it is permitted to further use physical/chemical parameter (s) and/or the manufacturing process to characterize the claim.

Art. 26.4

(1) Circumstances where it is permitted to use physical/chemical parameter (s) to characterize the claim of a chemical product are: the chemical product has unclear structure and cannot be precisely characterized merely by using its chemical name, structural formula or composition. The said parameter (s) shall be clear enough.

(2) Circumstances where it is permitted to use the manufacturing process to characterize the claim of a chemical product are: the chemical product cannot be sufficiently characterized by the features other than the manufacturing process.

### 4.4 Claim of Chemical Process

The claim of the process invention in the field of chemistry, be it a process for preparing a substance or another process (e. g., method of application, process method or treatment method of a substance), may be defined by the features of the process relating to procedure, substance and apparatus.

The process features relating to procedure include process steps (it may also be reaction steps) and process conditions, such as temperature, pressure, time, catalysts or other auxiliaries used in process steps.

The process features relating to substance include the chemical component, chemical-structural formula, physical/chemical property parameters of the raw material used in the process and the product.

The process features relating to apparatus include the type of the apparatus specially adapted in said process and the property or function of the apparatus relating to said process invention.

In the case of a specific process claim, one of the three types of technical features may be selected depending on the subject matter claimed, the technical problem to be solved and the substance or improvement of an invention.

## 4.5 Use Claim

### 4.5.1 Types of Use Claim

The invention relating to the use of a chemical product is made on the basis of discovery of a new property of the product and the use of such property. Regardless of a new or known product, its property is inherent in the product per se. The essence of the use invention does not lie in the product per se, but in the application of its property. Hence, a use invention is an invention of process, and its claim is a process claim.

If product B is invented by making use of product A, the application shall be based on product B per se, and its claim is a product claim rather than a use claim.

The examiner shall take notice of the wording to distinguish a use claim from a product claim. For example, "using compound X as an insecticide" or "the use of compound X as an insecticide" is a wording used in use claim, which is of type of process claim, while the wording "an insecticide made of compound X" or "the insecticide containing compound X" is not a use claim, but a product claim.

It shall also be clarified that "the use of compound X as an insecticide" shall not be construed as equivalent to "the compound X for an insecticide". As the latter is a product claim defining the use, it is not a use claim.

### 4.5.2 Claim of Medical Use of Substance

An application relating to the medical use of a substance shall not be granted if its claim is drafted in the wording "use of substance X for the treatment of diseases", "use of substance X for diagnosis of diseases" or "use of substance X as a medicament", because such claim is one for "method for the diagnosis or for the treatment of diseases" as referred to in Article 25.1(3). However, since a medicament and a method for the manufacture thereof are patentable according to the Patent Law, it shall not be contrary to Article 25.1(3) if an application for the medical use of a substance adopts pharmaceutical claim or use claim in the form of method for preparing a pharmaceutical, such as "use of substance X for the manufacturing of a medicament", "use of substance X for the manufacturing of a medicament for the treatment of a disease" and so on.

The above-mentioned use claim in the form of method for manufacturing a medicament may be drafted as "use of compound X for manufacturing a medicament for the treatment of disease Y" or the like.

## 5. Novelty of Chemical Invention

Art. 22.2

### 5.1 Novelty of Compound

(1) For a compound claimed in an application, if it has been referred to in a reference document, it is deduced that the compound does not possess novelty, unless the applicant can provide evidence to verify that the compound is not available before the date of filing. The word "refer to" mentioned above means to define clearly or explain the compound by the chemical name, the molecular formula (or structural formula), the physical/chemical parameter(s) or the manufacturing process (including the raw materials to be used).

For example, if the name and the molecular formula (or structure formula) of a compound disclosed in a reference document are difficult to be identified or unclear, but the document discloses the same physical/chemical parameter(s) or any other parameters used to identify the compound as those of the claimed compound of an application, it is deduced that the claimed compound does not possess novelty, unless the applicant can provide evidence to verify that the compound is not available before the date of filing.

If the name, molecular formula (or structure formula) and physical/chemical parameter(s) of a compound disclosed in a reference document are unclear, but the document discloses the same method of preparation as that of the claimed compound of an application, it is deduced that the claimed compound does not possess novelty.

(2) A general formula cannot destroy the novelty of a specific compound included in the general formula. However, the disclosure of a specific compound destroys the novelty of a claim for said general formula containing said specific compound, but it does not affect the novelty of a compound other than the specific compounds contained in said general formula. A series of specific compounds may destroy the novelty of the corresponding compounds in the series. The compounds in a range (such as $C_{1-4}$) destroy the novelty of the specific compounds at the two ends of that range ($C_1$ and $C_4$). However, if the compound $C_4$ has several isomers, the compounds $C_{1-4}$ cannot destroy the novelty of each single isomer.

(3) The existence of a natural substance per se does not destroy the novelty of the invented substance. A natural substance destroys the novelty of said invented substance only when it is disclosed in a reference document and is identical with or directly equivalent to the invented substance in structure and morphology.

Art. 22.2

### 5.2 Novelty of Composition

(1) Judgment of novelty on a composition merely defined by its components

Composition X consisting of components (A + B + C) is disclosed in a reference document,

(i) if the subject matter of an invention application relates to composition Y (components: A + B), and the claim for composition Y is presented in the close-ended mode, for example, it is described as "consisting of A + B", the claim possesses novelty even if the technical problem solved by the invention is the same as that of composition X;

(ii) if the claim for composition Y is presented in the open-ended mode as "containing A + B", and the technical problem solved by the invention is the same as that of composition X, then the claim does not possess novelty;

(iii) if the exclusive method is used to present the claim of composition Y, i. e., when it is indicated that "C" is not contained in it, the claim possesses novelty.

(2) Judgment of novelty on a composition defined by its components and contents

For the judgment of novelty on a composition defined by its components and contents, the provisions of Chapter 3, Section 3.2.4 of this Part shall apply.

Art. 22.2

### 5.3 Novelty of Chemical Product Characterized by Physical/Chemical Parameter(s) or Manufacturing Process

(1) For the claim of a chemical product characterized by physical/chemical parameter(s), if it is impossible to compare the product characterized by said parameter(s) with that disclosed in a reference document based on the parameter(s) described and to determine the difference between them, it is deduced the product claim characterized by said parameter(s) does not possess novelty as required in Article 22.2.

(2) For the claim of a chemical product characterized by manufacturing process, the novelty shall be determined on the product per se, rather than merely comparing the manufacturing process therein with the process disclosed in a reference document to find whether or not the two processes are identical. A different manufacturing process does not always result in the change of a product per se.

If, compared with a product disclosed in a reference document, the difference of said claimed product lies only in the manufacturing process, having neither parameters disclosed in the application, which may be used to prove its difference, nor indications of any change in its function and/or nature resulting from the difference of the process, then it is deduced that the product claim characterized by the process does not possess novelty as required in Article 22.2.

Art. 22.2

### 5.4 Novelty of Use Invention of Chemical Product

Since a chemical product is novel, the use invention of the novel product will naturally possess novelty.

A known product is not rendered novel merely because a new application thereof has been put forward. For example, if product X is known as a detergent, then the product X used as a plasticizer does not possess novelty. However, a known product does not destroy the novelty of its new use if the new use per se is an invention. This is because such use invention is an invention of method of application, and the substance of the invention lies in how to apply the product rather

than the product per se. For example, said product X is originally used as a detergent. Then, someone discovers from research that it can be used as a plasticizer after adding to it certain additives. Then its preparation, the kind of additives selected and the proportion etc., are the technical features of the method of application. Under such circumstances, the examiner shall assess whether the method per se possesses novelty and shall not consider that the method of application does not possess novelty on the grounds that product X is known.

As for a medical-use invention relating to a chemical product, the following aspects shall be taken into consideration when the examination of novelty is carried out.

(1) Whether or not the new use is different in substance from the known use. The use invention does not possess novelty when the difference between the new use and the known use lies merely in the form of expression, but the substance of them is the same.

(2) Whether or not the new use is revealed directly by the mechanism of action or pharmacological action of the known use. The use does not possess novelty if it is directly equivalent to the mechanism of action or pharmacological action of the known use.

(3) Whether or not the new use belongs to generic (upper level) term of the known use. The known use defined by specific (lower level) term may destroy the novelty of the use defined by generic (upper level) term.

(4) Whether or not the features relating to use, such as the object, mode, route, usage amount, interval of administration can define the procedure of manufacture of a pharmaceutical. The distinguishing features merely present in the course of administration do not enable the use to possess novelty.

Art. 22. 3

## 6. Inventive Step of Chemical Invention

### 6.1 Inventive Step of Compound

(1) When a compound is novel, not similar in structure to a known compound, and has a certain use or effect, the examiner may deem it to involve an inventive step without requiring that it shall have an unexpected use or effect.

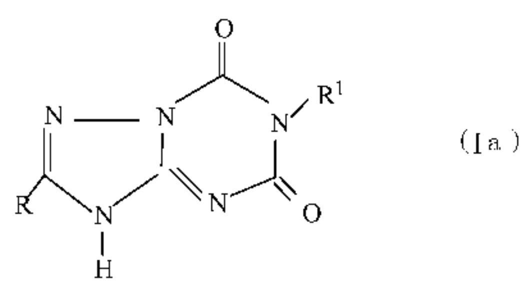
(2) For a compound that is similar in structure to a known compound, it must have unexpected use or effect. The said unexpected use or effect may be a use different from that of the known compound, the

substantive progress or improvement of a known effect of a known compound, or a use or effect which is not clear in the common general knowledge or cannot be deduced from the common general knowledge.

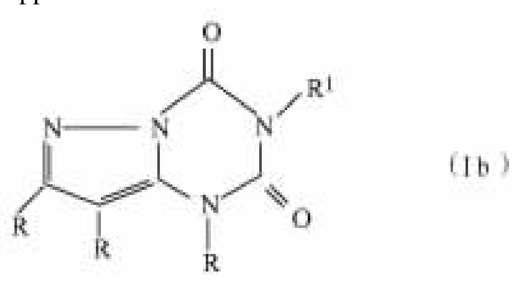
(3) Whether two compounds are similar in structure has relation to the technical field of the compounds, the examiner shall apply different criteria to different technical fields. The following are some examples:

[Example 1]

Prior art:




Application:




The compounds with similar structures must have the identical basic core structure or basic rings. As the structure of (Ⅰb) is not similar to that of (Ⅰa), when determining the inventive step of (Ⅰb), no evidence is necessary to show that (Ⅰb) has an unexpected use or effect compared with (Ⅰa).

[Example 2]

Prior art: $N_2N\text{-}C_6H_4\text{-}SO_2NHR^1$ (Ⅱa)

Application: $H_2N\text{-}C_6H_4\text{-}SO_2\text{-}NHCONHR^1$ (Ⅱb)

Sulfonamide (Ⅱa) is an antibiotics, and sulfonyolurea (Ⅱb) an antidiabetic. They are similar in structure but different in pharmaceutical effect. The (Ⅱb) involves an inventive step because it has unexpected use or effect.

[Example 3]

Prior art: $H_2N\text{-}C_6H_4\text{-}SO_2NHCONHR^1$ (Ⅲa)

Application: $H_3C\text{-}C_6H_4\text{-}SO_2NHCONHR^1$ (Ⅲb)

The structure of amino-sulfonyolurea (Ⅲa) is similar to that of methyl-sulfonyolurea (Ⅲb). The difference lies in $NH_2$ and $CH_3$ only. Being short of unexpected use or effect, (Ⅲb) does not involve an inventive step.

(4) It shall be noted that the inventive step of a compound ought not to be denied simply on the grounds of structural similarity. It is necessary to further explain that its use or effect can be expected or is predictable, or that a person skilled in the art is able to produce or use that compound by logical analysis, inference or limited experiment on the basis of the prior art.

(5) If the effect of a technical solution is caused by something known and inevitable, the technical solution does not involve an inventive step. For example, an insecticide A-R is in the prior art, wherein, R is $C_{1\text{-}3}$ alkyl. It has been pointed out in the prior art that the effectiveness of insecticide is improved with the increase of the number of atom in the alkyl. If the insecticide in an application is A-$C_4H_9$, the effectiveness has been obviously improved compared with the prior art. The application does not involve an inventive step because it has been pointed out in the prior art that the improved effectiveness of the insecticide is inevitable.

Art. 22. 3

### 6.2 Inventive Step of Use Invention of Chemical Product

(1) Inventive step of use invention of new product

A use invention of a new chemical product is regarded as involving an inventive step if the use cannot be expected from the known product having a similar structure or composition.

(2) Inventive step of use invention of known product

A use invention of a known product is regarded as involving an inventive step if the new use cannot be derived or expected from the structure, composition, molecular weight, known physical/chemical property and existent use of the product, but utilizes a newly discovered property of the product, and produces unexpected technical effect.

Art. 22. 4

## 7. Practical Applicability of Chemical Invention

### 7.1 Dishes and Cooking Methods

A dish which cannot be made industrially and implemented repeatedly does not possess practical applicability, and thus shall not be

granted a patent right. A cooking method which depends on such uncertain factors as skills and creativity of the cooker cannot be implemented repeatedly and thus cannot be used industrially, and therefore it does not possess practical applicability and shall not be granted a patent right.

### 7.2 Medical Prescription

The prescriptions of a doctor refer to the prescriptions made by the doctor according to the concrete conditions of a particular patient. As the prescriptions of a doctor, the making up of a prescription by a doctor and the process of medicine dispensation merely according to the prescription of a doctor do not possess practical applicability, they shall not be granted the patent right.

Art. 31.1
Rule 34

## 8. Unity of Chemical Invention

### 8.1 Unity of Markush Claim

#### 8.1.1 Basic Principle

Where a single claim of an application is defined by a number of alternative elements, the "Markush" claim is formed. The Markush claim shall also comply with the provisions on unity as provided for in Article 31.1 and Rule 34. If the alternative elements in a Markush claim possess similar nature, they shall be regarded as technical-related and having the same or corresponding special technical features, and the claim may be considered as meeting the requirements of unity. Such alternative elements are called Markush elements.

Where the Markush elements are for alternatives of compounds, they shall be regarded as being of a similar nature, and at the same time the Markush claim possesses unity if they meet the following standards:

(1) all alternative compounds possess a common property or activity; and

(2) all alternative compounds possess a common structure, which constitutes the distinguishing feature between the compounds and those in the prior art, and is essential to the common property or activity of the compounds of general formula, or under the circumstances that they do not have a common structure, all of the alternative elements belong to the same class of compounds recognized in the technical

field to which the invention pertains.

A "recognized class of compounds" means there is an expectation from the knowledge in the art that members of the class belong to the same class of compounds with the same performance in the context of the claimed invention, i. e. , each member may be substituted by another, with the expectation that the same intended result will be achieved.

### 8.1.2 Examples

[Example 1]

Claim 1: The compounds of the general formula:

Wherein, $R^1$ is pyridyl; $R^2$-$R^4$ are methyl, tolyl or phenyl… the compounds are used as a pharmaceutical for further enhancing the oxygen-intaking capacity of blood.

Explanation: in the general formula, indolyl moiety constitutes the common moiety to all of the Markush compounds, but the prior art has disclosed the compounds which possess a common structure, i. e. , said indolyl moiety, and are capable of enhancing the oxygen-intaking capacity of blood, therefore, the indolyl moiety cannot constitute the distinguishing feature between the compounds of general formula claimed in claim 1 and those in the prior art, the unity of claim 1 cannot be determined on the basis of indolyl moiety.

The compounds of general formula claimed in claim 1 change the $R^1$ group of the indolyl into 3-pyridyl, thereby possess the function of further enhancing the oxygen-intaking capacity of blood, therefore, the 3-pyridyl indolyl moiety may be regarded as an essential part to the function of the compounds of general formula, and the moiety is a common structure which is distinguished from the prior art, so the Markush claim possesses unity.

[Example 2]

Claim 1: The compounds of general formula:

Wherein, $100 \geqslant n \geqslant 50$, X is:

$$\text{(cyclohexyl)}-CH_2O- \quad (\text{I})$$

or

$$CH_2=C(H)-C_6H_4-CH_2O- \quad (\text{II})$$

Explanation: it is indicated in the description that said compound is prepared via esterifying the terminal group of known polyhexamethylene terephthalate. It possesses anti-pyrolysis property when it is esterized into (I). However, when it is esterized into (II), it does not possess the anti-pyrolysis property due to the existence of "$CH_2$ = CH-". Therefore, (I) and (II) have no common property, and the Markush claim does not possess unity.

[Example 3]

Claim 1: A nematocide composition comprising a compound with the following general formula as an active component:

$(R^3)_m$ X $R^1$ Y $R^2$ n

Wherein, m, n = 1, 2 or 3; X = O, S; $R^3$ = H, $C_1$-$C_8$ alkyl; $R^1$ and $R^2$ = H, halogen, $C_1$-$C_3$ alkyl; Y = H, halogen, amine; ...

Explanation: although all of the compounds in this formula have the same function of killing nematode, but they are five-, six- or seven-member rings compound respectively, and they belong to heterocycle compounds in different classes; hence, they have no common structure; at the same time, there is not an expectation from the prior art in the relevant technical field of this invention that these compounds have same performance in the context of the claimed invention, i. e., each member may be substituted by another with the same result achieved. This Markush claim does not possess unity.

[Example 4]

Claim 1: A herbicide composition including the mixture of compounds A and B in effective amount and a diluent or inert carrier, wherein, A is 2, 4-dichlorophenoxyacetic acid and B is selected from

the following compounds: cupric sulfate, sodium chloride, ammonium sulfamate, sodium trichloroacetate, dichloropropyl acid, 3-amino-2, 5-dichlorobenzoic acid, diphenamide, ioxynil, 2-(1-methyl-n-propyl)-4, 6-dinitrophenol, dinitroaniline and triazine.

Explanation: under such circumstances, the Markush elements B have no common structure, and there is not an expectation from the prior art in the relevant technical field of this invention that the compounds with these Markush elements B used as components of the herbicide composition may be substituted one for the other with the same result achieved; hence, they cannot be regarded as the compounds of the same class in the relevant technology of this invention, but compounds of the following different classes: (a) inorganic salt: cupric sulfate, sodium chloride, ammonium sulfamate; (b) organic salt or acid: sodium trichloroacetate, dichloropropyl acid, 3-amino-2, 5-dichlorobenzoic acid; (c) amide: diphenamide; (d) nitrile: ioxynil; (e) phenol: 2-(1-methyl-n-propyl)-4, 6-dinitrophenol; (f) amine: dinitroaniline; and (g) heterocycle: triazine. Accordingly, unity does not exist between the inventions claimed in claim 1.

[Example 5]

Claim 1: A hydrocarbon catalyst for gaseous oxidation comprises X or X + A.

Explanation: in the description, $RCH_3$ is oxidized to $RCH_2OH$ with X; $RCH_3$ is oxidized to RCOOH with X + A. These two catalysts have the same function---for oxidation of $RCH_3$. Although X + A makes the oxidation of $RCH_3$ more sufficient, the function is the same, and both of the two catalysts have common component X which is distinguished from the prior art and is essential to the common function, therefore claim 1 possesses unity.

### 8.2 Unity Between Intermediate and Final Product

An application relating to an intermediate shall also comply with the provisions on unity as provided for in Article 31.1 and Rule 34.

#### 8.2.1 Basic Principle

(1) Unity exists between an intermediate and a final product if the following two conditions are simultaneously met:

(i) the intermediate and the final product have the same basic structure unit, or their chemical structures are technically closely related, and the basic structure unit of the intermediate is incorporated into

the final product;

( ii) the final product is prepared or separated directly from the intermediate.

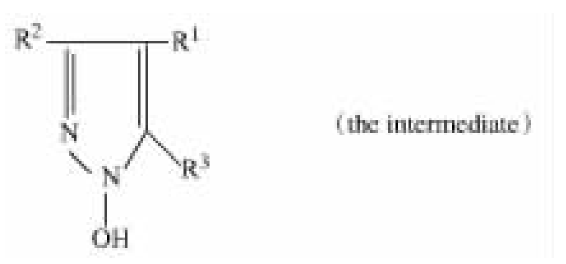
(2) For several processes for preparing the same final product from the different intermediates, if these different intermediates possess the same basic structure unit, these processes may be claimed for protection in one application.

(3) The different intermediates of different structural parts of the same final product shall not be claimed in one application.

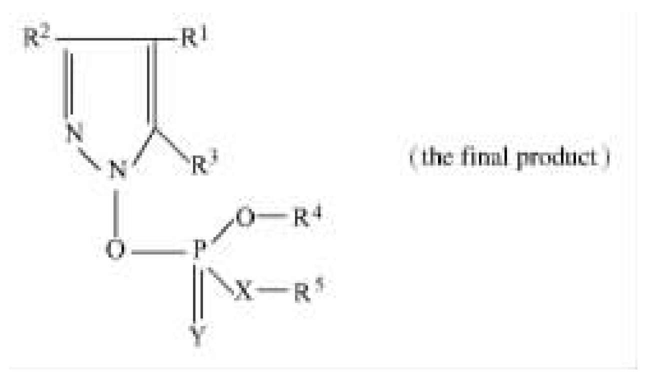
### 8.2.2 Examples

[Example 1]

Claim 1:




Claim 2:




Explanation: the chemical structures of the intermediate and the final product mentioned above are technically closely related, the basic structure unit of the intermediate is incorporated into the final product, and the final product can be prepared directly from the intermediate. Therefore, unity exists between claim 1 and claim 2.

[Example 2]

Claim 1: An amorphous polyisoprene (the intermediate).

Claim 2: A crystalline polyisoprene (the final product).

Explanation: in this example, the crystalline polyisoprene is obtained directly by way of stretching the amorphous polyisoprene. As

their chemical structures are identical, unity exists between claim 1 and claim 2.

## 9. Examination of Invention Application in the Field of Biotechnology

In this section, the term “biological material” means any material containing genetic information and capable of reproducing itself or being reproduced in a biological system, such as gene, plasmid, microorganism, animal, plant, and so on.

For the definition of the term “animal” and “plant”, the provisions of Chapter 1, Section 4. 4 of this Part shall apply. The said animal and plant therein may be a taxon of any rank of animal and plant, such as kingdom, phylum, classis, order, family, genus, species, and so on.

### 9. 1 Examination of Claimed Subject Matters

#### 9. 1. 1 Examination of Claimed Subject Matters According to Article 5

Some inventions concerning biotechnology are exemplified in Chapter 1, Section 3. 1. 2 of this Part which cannot be granted the patent right in accordance with the provisions of Article 5. Furthermore, the following inventions shall not be granted the patent right in accordance with the provisions of Article 5.

##### 9. 1. 1. 1 Embryonic Stem Cell of Human Beings

Both an embryonic stem cell of human beings and a preparing method thereof shall not be granted the patent right in accordance with the provisions of Article 5. 1.

##### 9. 1. 1. 2 Human Body at the Various Stages of Its Formation and Development

The human body, at the various stages of its formation and development, including a germ cell, an oosperm, an embryo and an entire human body shall not be granted the patent right in accordance with the provisions of Article 5. 1.

##### 9. 1. 1. 3 Inventions-Creations Mentioned in Article 5. 2

Where an invention-creation is developed relying on the genetic

resources, the acquisition or use of which is not consistent with the provisions of the laws and administrative regulations, it belongs to the inventions-creations excluded from patent protection under Article 5.2. For examination of such invention-creation, the provisions of Chapter 1, Section 3.2 of this Part shall apply.

### 9.1.2 Examination of Claimed Subject Matters According to Article 25

#### 9.1.2.1 Microorganism

The term "microorganism" includes bacteria, actinomycetes, fungi, viruses, protozoa and algae, etc. Because a microorganism is neither an animal nor a plant, it is not listed in Article 25.1(4).

Art. 25.1(1)

A microorganism existing in the nature without the involvement of any artificially induced technical treatment is, however, a scientific discovery. Hence, it is unpatentable. Microorganism per se constitutes a subject matter of patent protection only when it is isolated into pure culture and has particular industrial use.

#### 9.1.2.2 Gene or DNA Fragment

No matter it is a gene or a DNA fragment, it is, in substance, a chemical substance. The said gene or DNA fragment includes those isolated from microorganism, plant, animal or human body, as well as those obtained by other means.

As stated in Section 2.1 of this Chapter, a gene or DNA fragment found in the nature and existing in its natural state is merely a discovery. It falls into "scientific discoveries" as provided for in Article 25.1 and is unpatentable. However, a gene or a DNA fragment per se and the process to obtain it are subject matters of patent protection if it is isolated or extracted for the first time from the nature, its base sequence is unknown in the prior art and can be definitely characterized, and it can be exploited industrially.

#### 9.1.2.3 An Animal, a Plant and a Constitutive Part Thereof

An embryonic stem cell of an animal, an animal at the various stages of its formation and development, such as a germ cell, an oosperm, an embryo and so on, belong to the category of the "animal variety" said in Chapter 1, Section 4.4 of this Part, they are unpatentable in accordance with the provisions of Article 25.1(4).

A somatic cell of an animal as well as a tissue and an organ of an animal (except an embryo) are not in conformity with the definition of "animal" said in Chapter 1, Section 4. 4 of this Part, so they do not belong to the subject matters excluded according to the provisions of Article 25. 1(4).

A single plant and its reproductive material (such as seed, etc.), which maintains its life by synthesizing carbohydrate and protein from the inorganic substances, such as water, carbon dioxide and mineral salt and so on through photosynthesis, belong to the category of the "plant variety" said in Chapter 1, Section 4. 4 of this Part, and they are unpatentable in accordance with the provisions of Article 25. 1(4).

If a cell, a tissue and an organ of a plant do not possess the above-mentioned characteristic, they cannot be regarded as "plant varieties", therefore, they do not belong to the subject matters excluded according to the provisions of Article 25. 1(4).

#### 9. 1. 2. 4 Transgenic Animal and Plant

Transgenic animal or plant is those obtained by biological method, such as DNA recombination technology of the genetic engineering. The animal or plant per se still belongs to the category of the "animal variety" or "plant variety" defined in Chapter 1, Section 4. 4 of this Part. In accordance with the provisions of Article 25. 1(4), no patent right shall be granted to them.

Art. 26. 3

### 9. 2 Sufficient Disclosure of the Description

#### 9. 2. 1 Deposit of Biological Material

(1) It is stipulated in Article 26. 3 that the description shall set forth the invention or utility model in a manner sufficiently clear and complete so as to enable a person skilled in the art to carry it out.

In general, the description shall sufficiently disclose in writing the invention for which the patent protection is sought. In the particular field of biotechnology, it is sometimes difficult to describe the specific feature of a biological material in writing, and the biological material per se cannot be made available even if there is such a description, hence, a person skilled in the art may remain unable to carry out the invention. Under this circumstance, in order to meet the requirements as set forth in Article 26. 3, the biological material shall be deposited with a depositary institution designated by the State Intellectual Proper-

ty Office according to relevant provisions.

Where a biological material, which is involved in the application and indispensable for the invention to be completed, is not available to the public and has not been deposited according to Rule 24 by the applicant, or although it has been deposited according to the relevant provisions, the certificate of deposit and the certificate of viability provided by the depositary institution have not been submitted at the date of filing, or, at the latest, within four months from the date of filing, the examiner shall reject the application for its non-compliance with the provisions of Article 26. 3.

Rule 24(3)

Where an application relates to a biological material which is not available to the public, it shall indicate, in the request and the description, the taxonomic denomination and Latin scientific name of the biological material, the name and address of the depositary institution, the date on which the sample of the biological material was deposited and the accession number of the deposit. In addition to the taxonomic denomination and Latin scientific name of the biological material, the date on which the sample of the biological material was deposited, the whole name and its abbreviation of the depositary institution in which the biological material is deposited and the accession number of the deposit shall be indicated when the biological material is mentioned for the first time in the description. Moreover, such information shall be presented as part of the description in the position corresponding to the description of the drawings. If the applicant submitted on time, the request, certificate of deposit and certificate of viability which complied with the provisions of Rule 24, but failed to indicate the information about the deposit in the description, it is permitted for the applicant to add the relevant information in the request to the description in the stage of substantive examination.

(2) "Biological material which is not available to the public" mentioned in Rule 24 includes the biological material held by an individual or entity, deposited with a depositary institution not for the purpose of patent procedures and not released to the public; or although the process for producing the biological material is described in the description, a person skilled in the art still cannot repeat the process so as to obtain said biological material, e. g. , new microorganisms created by means of screening, mutation, etc. , which cannot be repeated. All these biological materials shall be deposited according to relevant provisions.

The following are the circumstances in which a biological material shall be regarded as available to the public and the deposit thereof is not required:

(i) as for the biological material commercially available to the public at home and abroad, the commercial supplier of it shall be indicated in the description, and if necessary, the evidence shall be submitted to show that the biological material is commercially available to the public before the date of filing (or the priority date where priority is claimed);

(ii) biological materials which have been deposited with a depositary institution recognized by the patent offices of various countries or by international patent organizations for the purposes of patent procedures, and have been published in the patent Gazette or have been granted the patent right before the date of filing (or the priority date where priority is claimed) of the application filed in China; and

(iii) the biological material that must be used in an application has been disclosed in a non-patent document before the date of filing (or the priority date where priority is claimed), with the source of the document indicated in the description, the public access to the biological material described, and the proof of guaranteeing the biological material accessible to the public for twenty years from the filing date provided by the applicant of the application.

(3) For the biological materials deposited with the depositary institution designated by the State Intellectual Property Office, the institution shall confirm its viability. If the biological material is confirmed dead, polluted, inactive, or variant, the applicant shall deposit the biological material identical with that initially deposited together with the original sample, and notify the Patent Office. The latter deposit is then deemed as the continuation of the original deposit.

(4) The depositary institutions designated by the State Intellectual Property Office refer to the international depository institutions for biological material samples acknowledged by the Budapest Treaty, including the Center for General Microorganism of the Administration Committee of the China Microbiological Culture Collection (CGMCC) based in Beijing and the China Center for Type Culture Collection (CCTCC) based in Wuhan.

### 9.2.2 Inventions Relating to Genetic Engineering

The term "genetic engineering" here means the technology which

manipulates genes artificially by gene recombination, cell fusion, etc. Inventions relating to genetic engineering include those of a gene( or a DNA fragment), a vector, a recombinant vector, a transformant, a polypeptide or a protein, a fused cell, a monoclonal antibody, etc.

### 9.2.2.1 Inventions of Product

As for the inventions relating to a gene, a vector, a recombinant vector, a transformant, a polypeptide or a protein, a fused cell, a monoclonal antibody per se, the description shall disclose the identification, preparation and use and/or technical effect of the product.

(1) Identification of product

For an invention of a gene, a vector, a recombinant vector, a transformant, a polypeptide or a protein, a fused cell, a monoclonal antibody, etc., the description shall indicate the structure of the product, such as base sequence of a gene, amino acid sequence of a polypeptide or protein, etc. When the structure of the product cannot be clearly described, the description shall describe the physical/chemical parameters, biological property and/or preparation method of the product, etc.

(2) Preparation of product

The way of making the product shall be described in the description except where the product can be made by a person skilled in the art without such description when taking into account the overall description of the initial description, claims, drawings and the prior art.

For an invention of a gene, a vector, a recombinant vector, a transformant, a polypeptide or a protein, a fused cell, a monoclonal antibody, etc., when it is not possible to describe a process for producing said product in the description in such a manner that a person skilled in the art can reproduce it, the obtained transformant (including a transformant which produces a recombinant polypeptide or protein) or fused cell, etc., into which the gene, the vector, the recombinant vector has been introduced, shall be deposited in accordance with the provisions of Rule 24. The provisions of Section 9.2.1 of this Chapter shall apply to the details of the deposit.

For an invention of a process for producing a gene, a vector, a recombinant vector, a transformant, a polypeptide or a protein, a fused cell, a monoclonal antibody, etc., if the process involves the use of a biological material which is not available to the public before the date of filing( or the priorty date where priorty is claimed), the biological

material shall be deposited in accordance with the provisions of Rule 24. The provisions of Section 9. 2. 1 of this Chapter shall apply to the details of the deposit.

Specifically, the invention may be described as follows:

( i) Gene, vector or recombinant vector

A process for producing a gene, a vector or a recombinant vector shall be described by respective origin or source, means for obtaining said gene, vector or recombinant vector, an enzyme to be used, treatment conditions, steps for collecting and purifying it, and means for identification, etc.

( ii) Transformant

A process for producing a transformant shall be described by a gene or a recombinant vector introduced, a host ( a microorganism, a plant or an animal), a method for introducing the gene or the recombinant vector into the host, a method for selectively collecting the transformant, or means for identification, etc.

( iii) Polypeptide or protein

A process for producing a polypeptide or a protein by gene recombination shall be described by stating means for obtaining a gene encoding the polypeptide or the protein, means for obtaining an expression vector used, means for obtaining a host, a method for introducing the gene into the host, a method for selectively collecting the transformant, steps for collecting and purifying the polypeptide or the protein from the transformant into which the gene has been introduced, or means for identification of the polypeptide or the protein, etc.

( iv) Fused cell

A process for producing a fused cell ( such as a hybridoma) shall be described by stating source of the parent cells, pretreatment of the parent cells, fusion condition, a method for selectively collecting the fused cell, or means for identification, etc.

( v) Monoclonal antibody

A process for producing a monoclonal antibody shall be described by stating means for obtaining or producing immunogen, a method for immunization, a method for selectively obtaining antibody producing cells, or means for identification of the monoclonal antibody, etc.

When the invention relates to a monoclonal antibody which satisfies specific conditions, ( e. g. , a monoclonal antibody whose affinity to the antigen A is specified by the specific coupling constant), even if a process for preparing a hybridoma which is capable of producing

said monoclonal antibody is described according to above-mentioned disclosure in "(iv) Fused cell", it is random and unable to be reproduced to carry out said process for obtaining a specific result. Therefore, said hybridoma shall be deposited in accordance with the provisions of Rule 24, except where the applicant can submit sufficient evidence to show that the hybridoma can be created repeatedly by a person skilled in the art on the basis of the disclosure in the description.

(3) Use and/or technical effect of a product

For an invention of a gene, a vector, a recombinant vector, a transformant, a polypeptide or a protein, a fused cell, a monoclonal antibody, etc., the description shall describe the use and/or technical effect of the product, and specify the technical means, condition, etc., which is needed to obtain said effect.

For instance, the applicant shall submit evidence in the description to show that the gene has the special function, in case of a structural gene, the polypeptide or the protein encoded by said gene has the specific function.

### 9.2.2.2 Inventions of Process for Producing Product

For an invention of a process for producing a gene, a vector, a recombinant vector, a transformant, a polypeptide or a protein, a fused cell, a monoclonal antibody, etc., the description shall describe said process in a manner sufficiently clear and complete so as to enable a person skilled in the art to prepare the product by using said process, and at least one use of said product shall be described in the description when said product is novel. For the specific requirement of the description, the provisions of Section 9.2.2.1 of this Chapter shall apply.

### 9.2.3 Nucleotide or Amino Acid Sequence Listing

Rule 17.4

(1) When an invention relates to a nucleotide sequence consisting of 10 or more nucleotides, or an amino acid sequence of a protein or peptide consisting of 4 or more L-amino acids, a "Sequence Listing" prepared in accordance with "Standard for the presentation of nucleotide and/or amino acid sequence listing and its electronic file" issued by the State Intellectual Property Office shall be submitted.

Rule 17.4

(2) The "Sequence Listing" shall be arranged at the end of the description as a separate part of it. Furthermore, the applicant shall submit computer-readable copy recording the nucleotide or amino acid sequence listing. For submission of sequence listing, see Chapter 1,

Section 4.2 of Part I.

If the nucleotide or amino acid sequence listing recorded in computer-readable copy submitted by applicant is not consistent with that written sequence listing disclosed in the description and claims, the written sequence listing shall prevail.

Rule 24

#### 9.2.4 Inventions Relating to Microorganism

(1) The deposited microorganism shall be described by the strain denomination, the species denomination and genus denomination in accordance with microbiological nomenclature. Where it is not identified with a species denomination, a genus denomination shall be provided. The Latin scientific denomination of a microorganism involved in the invention shall be provided in brackets when it is referred to for the first time in the description. Where that microorganism has been deposited with the depositary institution designated by the State Intellectual Property Office according to Rule 24, the date of deposit, the whole name and its abbreviation of the depositary institution and the access number of the deposit shall be indicated in the description according to Section 9.2.1 of this Chapter. In other parts of the description, the microorganism deposited may be represented by the abbreviation of the depositary institution and the access number of the microorganism, such as *Staphylococcus Aureus* CCTCC8605.

(2) Where the microorganism involved is a new species, its taxonomic characteristics shall be described in detail, the reason to classify it as a new species shall be clarified, and the relevant document on which the classification is based shall be indicated.

### 9.3 Claims of Inventions in the Field of Biotechnology

The claims shall comply with the provisions of Article 26.4and Rule 20.2.

#### 9.3.1 Inventions Relating to Genetic Engineering

For an invention of a gene, a vector, a recombinant vector, a transformant, a polypeptide or a protein, a fused cell, a monoclonal antibody, etc., the claim of the invention may be described as indicated below.

##### 9.3.1.1 Gene

(1) A gene may be defined directly by specifying its base se-

quence.

(2) A structural gene may be defined by specifying an amino acid sequence of the polypeptide or protein encoded by said gene.

(3) Where the base sequence of the gene or the amino acid sequence of the polypeptide or protein encoded by said gene is set forth in the "Sequence Listing" or drawing of the description, reference may be made to the sequence by use of the sequence identifier in the "Sequence Listing" or the number of the drawing.

[Example]

A DNA molecule whose base sequence is represented by SEQ ID NO: 1( or Fig. 1).

(4) Where a gene has a special function, for example, the protein encoded by it has the activity of enzyme A, the gene may be defined by a combination of the terms "substitution, deletion or addition" and functions of the gene.

[Example]

A gene encoding a protein of (a) or (b) as follows:

(a) a protein whose amino acid sequence is represented by Met-Tyr-...-Cys-Leu,

(b) a protein derived from the protein of (a) by substitution, deletion or addition of one or several amino acids in the amino acid sequence defined in (a) and having the activity of enzyme A.

The above-mentioned expression of the gene is permissible only if:

I. the said derived protein of (b) is exemplified in the description, for instance in the examples; and

II. the description states the technical means used for producing the derived protein of (b) and verifying its function (otherwise, the description does not sufficiently disclose the gene).

(5) Where a gene has a special function, for example, the protein encoded by it has the activity of enzyme A, the gene may be defined by a combination of the terms "hybridize under stringent conditions" and functions of the gene.

[Example]

A gene selected from the group consisting of:

(a) a DNA molecule whose nucleotide sequence is represented by ATGTATCGG...TGCCT,

(b) a DNA molecule which hybridizes under stringent conditions to the DNA sequence defined in (a) and encodes the protein having the

activity of enzyme A.

The above-mentioned expression of the gene is permissible only if:

I. “stringent conditions” are described in detail in the description; and

II. the said DNA molecule defined in(b) is exemplified in the description, for instance in the examples.

(6) When the above-mentioned expressions of (1)-(5) cannot be used, a gene may be described by specifying functions, physiochemical properties, origin or source of said gene, a process for producing said gene, etc.

### 9.3.1.2 Vector

(1) A vector may be defined by specifying a base sequence of its DNA.

(2) A vector may be described by specifying a cleavage map of DNA, molecular weight, number of base pairs, source of the vector, process for producing the vector, function or characteristics of the vector, etc.

### 9.3.1.3 Recombinant Vector

A recombinant vector may be described by specifying at least one of the gene and the vector.

### 9.3.1.4 Transformant

A transformant may be described by specifying its host and the gene (or the recombinant vector) which is introduced.

### 9.3.1.5 Polypeptide or Protein

(1) A polypeptide or protein may be defined by specifying an amino acid sequence or a base sequence of structural gene encoding said amino acid sequence.

(2) Where the amino acid sequence of the polypeptide or protein is set forth in the “Sequence Listing” or drawing of the description, reference may be made to the sequence by use of the sequence identifier in the “Sequence Listing” or the number of the drawing.

[Example]

A protein whose amino acid sequence is represented by SEQ ID NO: 2 ( or Fig. 2).

(3) Where a protein has a special function, for example, it has the activity of enzyme A, the protein may be defined by a combination of the terms "substitution, deletion or addition" and functions of the protein.

[Example]

A protein of (a) or (b) as follows:

(a) a protein whose amino acid sequence is represented by Met-Tyr-...-Cys-Leu,

(b) a protein derived from the protein of (a) by substitution, deletion or addition of one or several amino acids in the amino acid sequence in (a) and having the activity of enzyme A.

The above-mentioned expression of the protein is permissible only if:

I. the said derived protein of (b) is exemplified in the description, for instance in the examples; and

II. the description states the technical means used for producing the derived protein of (b) and verifying its function (otherwise, the description does not sufficiently disclose the protein).

(4) When the above-mentioned expressions of (1)-(3) cannot be used, a polypeptide or protein may be described by specifying functions, physiochemical properties, origin or source of said polypeptide or protein, a process for producing said polypeptide or protein, etc.

#### 9.3.1.6 Fused Cell

A fused cell may be described by specifying parent cells, function and characteristics of the fused cell, or a process for producing the fused cell, etc.

#### 9.3.1.7 Monoclonal Antibody

A claim directed to a monoclonal antibody may be defined by specifying hybridoma which produces it.

[Example]

A monoclonal antibody against antigen A, produced by a hybridoma having CGMCC Deposit No. xxx.

### 9.3.2 Inventions Relating to Microorganism

Art. 26.4

(1) A microorganism involved in a claim shall be described according to the microbiological taxonomic denomination. It shall be described by its Chinese denomination if it has a specific Chinese name,

and its Latin scientific name shall also be provided in brackets where it is first mentioned. Where the microorganism has been deposited with a depositary institution designated by the State Intellectual Property Office, the abbreviation of that institution and the access number shall also be indicated in the description of the microorganism.

Art. 26.4

(2) If a specific mutant strain of a microorganism is not mentioned in the description, alternatively, the specific mutant strain is mentioned rather than a corresponding mode for it to be carried out being provided by the description, any claim for that mutant strain shall not be permissible.

Art. 26.4

As for a claim for "derivative" of a microorganism, the meanings of "derivative" may refer to not only a new strain derived from the microorganism, but also the metabolites produced by the microorganism, so the meanings of it are indefinite, which makes the protection extent of such claim unclear.

## 9.4 Examination of Novelty, Inventive Step and Practical Applicability

Art. 22.2

### 9.4.1 Novelty of Inventions Relating to Genetic Engineering

(1) Genes

If a protein per se possesses novelty, the invention of the gene encoding the protein also possesses novelty.

(2) Recombinant protein

If a protein as an isolated and purified single substance is known, an invention concerning a recombinant protein defined by a different preparation process and having an identical amino acid sequence does not possess novelty.

(3) Monoclonal antibody

If antigen A is novel, a monoclonal antibody of antigen A is considered novel. However, if a monoclonal antibody of a known antigen A' is known and that the antigen A involved in the invention has the same epitope as that of antigen A', it is deduced that the monoclonal antibody of the known antigen A' is capable of binding to antigen A. In such a case, the invention of the monoclonal antibody of antigen A does not possess novelty except where the applicant can verify, according to the disclosure of the application or the prior art, that the monoclonal antibody defined by the claim of the application is different from those disclosed in reference documents.

Art. 22.3

## 9.4.2 Inventive Step

### 9.4.2.1 Inventions Relating to Genetic Engineering

(1) Gene

Where a protein is known, but its amino acid sequence is not, an invention of a gene encoding the protein does not involve an inventive step if a person skilled in the art can readily determine the amino acid sequence at the time of filing. However, when the gene has a specific base sequence and has technical effects compared with other genes having a different base sequence encoding said protein, which a person skilled in the art cannot expect, the invention of said gene involves an inventive step.

If the amino acid sequence of a protein is known, an invention of a gene encoding the protein does not involve an inventive step. However, if the gene has a particular base sequence and has technical effects compared with other genes having a different base sequence encoding said protein, which a person skilled in the art cannot expect, the invention of said gene involves an inventive step.

If the claimed structural gene of an invention is the naturally obtainable mutant of a known structural gene and that the claimed gene is derived from the same species as that of the known structural gene and has the same properties and functions as those of the known structural gene, then the invention does not involve an inventive step.

(2) Recombinant vector

If both a vector and an inserted gene are known, an invention of a recombinant vector obtained by a combination of the two usually does not involve an inventive step. However, if an invention of a recombinant vector with a specific combination of them can produce unexpected technical effects compared with the prior art, the invention involves an inventive step.

(3) Transformant

If both a host and an inserted gene are known, an invention of a transformant obtained by a combination of them generally does not involve an inventive step. However, if an invention of a transformant obtained from a specific combination of them can produce unexpected technical effects compared with the prior art, it involves an inventive step.

(4) Fused cell

If parent cells are known, an invention of a fused cell produced

by fusing the parent cells does not involve an inventive step. However, if the fused cell has an unexpected technical effects compared with the prior art, the invention of the fused cell involves an inventive step.

(5) Monoclonal antibody

If an antigen is known and it is clearly known that the antigen has immunogenicity (for example, said antigen clearly has immunogenicity because a polyclonal antibody of the antigen is known or the antigen is a polypeptide with a large molecular weight), the invention of a monoclonal antibody of the antigen does not involve an inventive step. However, if the invention is further defined by other features, and hence has unexpected technical effects, the invention of that monoclonal antibody involves an inventive step.

#### 9.4.2.2 Inventions Relating to Microorganism

(1) Microorganism per se

For a microorganism, if its taxonomic characteristics are remarkably different from those of the known species (i.e., a new species), it involves an inventive step. If for an invention of a microorganism, though there is no substantive difference between the taxonomic characteristics of the microorganism involved in the invention and those of the known species, so long as the microorganism produces technical effects that cannot be expected by a person skilled in the art, it involves an inventive step.

(2) Invention relating to the use of microorganism

An invention relating to the use of a microorganism does not involve an inventive step if the microorganism used in the invention is known and that said microorganism belongs to the same genus as that of another known microorganism of the same use. However, if said invention produces unexpected technical effects compared with the latter microorganism, it involves an inventive step.

An invention relating to the use of a microorganism shall involves an inventive step if the microorganism used in the invention is remarkably different from a microorganism of known species with taxonomic characteristics (i.e., the microorganism used in the invention is a new species), even if the use is the same.

Art. 22.4

### 9.4.3 Practical Applicability

In the field of biotechnology, since some inventions cannot be repeated, they do not possess practical applicability, and shall not be

granted the patent right.

#### 9.4.3.1 Processes for Screening Particular Microorganisms from Natural Environment

Under most circumstances, the process to screen a particular microorganism from the natural environment is not repeatable because it is limited by the objective condition and is very random. For example, a particular microorganism has been isolated and screened from the soil in some place of some county of some province. The indeterminate geographic position, constant change of the natural and artificial environment and the contingency of the existence of such microorganism even in the same piece of soil may render it impossible to repeatedly screen out the microorganism with the exact same biochemical hereditary feature in the same species of the same genus within the valid term of twenty years of the patent right. Therefore, the process for screening a particular microorganism from natural environment generally does not possess practical applicability. Unless the applicant can provide sufficient evidence to prove the repeatability of the process, no patent right shall be granted to it.

#### 9.4.3.2 Processes for Producing New Microorganism through Artificial Mutagenesis by Physical/Chemical Process

This type of process mainly depends on the random mutation of the microorganism occurring under the condition of mutagenesis. This mutation is in fact a change of one or more bases during DNA replication, and a bacterial strain with certain characteristics is then screened out. Because the base changes at random, even if the condition of mutagenesis has been clearly disclosed, it is difficult to achieve exactly the same result by repeating the condition of mutagenesis. Under most circumstances, such process does not comply with the provisions of Article 22.4. Unless the applicant provides sufficient evidence to prove that the microorganism with desired characteristics can be definitely produced by mutagenesis under certain mutagenic conditions, no patent right shall be granted to this type of processes.

Art. 26.5
Rule 26.2

## 9.5 Source Indication of Genetic Resources

### 9.5.1 Interpretation of Terms

Direct source of the genetic resources referred to in the Patent

Law means the direct channel to obtain the genetic resources. When indicating the direct source of the genetic resources, the applicant shall provide such information as the time, place, means and provider, etc. , on acquisition of the genetic resources.

Original source of the genetic resources referred to in the Patent Law means the place in the in-situ conditions where the organism to which the genetic resources belong is collected. Where the organism naturally occurs, the in-situ conditions refer to the natural habitats where this organism grows. Where the organism is a cultivated or domesticated species, the in-situ conditions refer to the surroundings where this organism has developed its distinctive traits or characteristics. When indicating the original source of the genetic resources, the applicant shall provide such information as the time, place and collector, etc. , on the collection of the organism to which the genetic resources belong.

### 9.5.2 Specific Requirements for the Source Indication

Where an application for patent is filed for an invention-creation the development of which relies on the use of genetic resources, the applicant shall state that fact in the request, and fill in the specific information of the direct and original source of the genetic resources in the *Registration Form for Indicating Source of Genetic Resources* (hereafter referred to as registration form) prepared by the Patent Office.

The applicant's indication of the direct and original source shall be in conformity with the requirements for filling in the registration form, and gives relevant information clearly and completely.

Where the genetic resources are directly obtained from a certain institution, such as depository institution, seed bank (germ plasm bank), gene library etc. , if the institution knows and can provide the original source, the applicant shall provide the information of the original source of the genetic resources. Where the applicant fails to indicate the original source, he shall state the reasons thereof, and provide relevant evidence if necessary, for example, state "the seed bank does not make a record of the original source of the genetic resources", or "the seed bank can not provide the original source of the genetic resources", and provide relevant written certificate issued by the seed bank.

### 9.5.3 Examination of the Source Indication of Genetic Resources

When examining according to Article 26.5 and Rule 26.2, the examiner shall, at first, read the description and claims carefully to understand the invention-creation accurately. On this basis, the examiner shall determine whether the development of the invention-creation relies on the genetic resources, as well as on which genetic resources the invention-creation relies.

For invention-creation developed relying on the genetic resources, the examiner shall examine whether the applicant has submitted the registration form.

If the applicant fails to submit any registration form, the examiner shall notify him in the Office Action to make a supplementary submission, and also specify which genetic resources shall be indicated regarding its source and explain the reasons thereof.

If the registration forms submitted by the applicant only indicate sources of part of the genetic resources, the examiner shall notify him in the Office Action to additionally submit the registration form(s) for the other genetic resources, and also specify the genetic resources the source of which shall be additionally indicated and explain the reasons thereof.

If the applicant has submitted the registration form, the examiner shall examine whether the direct and original source of the genetic resources are indicated in the registration form. Where no original source is indicated, the examiner shall examine whether the reason thereof is stated. If the registration form completed by the applicant is not in conformity with the relevant provisions, the examiner shall point out the defects existing in the registration form in the Office Action. Where the patent application is still not in conformity with the provision of Article 26.5 after the applicant has made observations or amendments, the examiner shall reject it.

It should be noted that the contents in the registration form do not belong to the disclosure contained in the initial description and claims. Therefore, it can neither be used as the basis to judge whether the description has sufficiently disclosed the claimed invention, nor as the basis to amend the description and claims.

# Part III

# Examination of International Applications Entering the National Phase

# Chapter 1 Preliminary Examination of International Applications Entering the National Phase and Processing of Procedural Matters Therefore

## 1. Introduction

Any international application filed in accordance with the Patent Cooperation Treaty( hereinafter called "the PCT" or "the Treaty") and indicating the desire to obtain patent protection for invention or utility model in China, after completing the procedure of the international phase, shall according to Rules 103 and 104 go through the formalities before the Patent Office for entering the Chinese national phase ( hereinafter called"the national phase"), and thus initiate the procedure of the national phase. The procedure of the national phase covers the following processes: preliminary examination to the extent as permitted under PCT, national publication, substantive examination with reference to the results of the international search and the international preliminary examination, grant or rejection and other processes as may occur.

This Chapter concerns the examination on the conditions for an international application to enter the national phase, preliminary examination on an international application in the national phase, and processing for an international application of procedural matters in the national phase, etc. Only special issues of the above contents are given explanations and made stipulations for in this Chapter; for other issues which are the same as those in national applications, if no explanations or provisions are given in this Chapter, Chapters 1 and 2 of Part I, and Part V shall apply mutatis mutandis respectively.

The main contents of preliminary examination and processing of general matters concerned in this Chapter are the following:

(1) according to Rule 105, examining whether or not an alleged international application entering the national phase satisfies the provided conditions; and processing of any application which has no effect or the effect of which is lost in China;

(2) according to Rule 104, examining whether or not the Chinese translation( hereinafter called translation) or documents of the original

application of an international application have been satisfactorily submitted at the time of entering the national phase; according to Rule 44, examining whether or not the translation and documents meet the prescribed requirements, and processing of those failing to meet the requirements;

(3) according to Rule 106, examining whether or not the time when the applicant submits translation of any amendment made in the international phase meets the provided requirements, and processing of those failing to meet the requirements;

(4) according to Rules 104, 107, 108, 109, 110, 112 and 113, and Articles18 and 19. 1, examining whether or not other documents related to the application have been submitted and meet the prescribed requirements; and processing of those having defects; and

(5) according to Rule 114, processing of such general matters as national publication for an international application.

## 2. Examination of the Formalities of International Application Entering the National Phase

Where the applicant wishes to obtain patent protection for international application in China, he shall go through the formalities for entering the national phase within the time limit as provided for in Rule 103. Where an international application has no effect in China or the effect has lost in China, the international application can not enter the Chinese national phase. When the applicant goes through the formalities for entering the Chinese national phase, he shall fulfill the requirements in accordance with the provisions of Rule 104.

Where the applicant withdraws the priority claim at the time of going through the formalities for entering the national phase, the time limit for going through the said formalities shall be still calculated from the original earliest priority date.

Where the priority of the international application is invalid in national phase due to China's reservations to the relevant provisions of the Patent Cooperation Treaty and its Regulations, consequently, the time limit for going through the formalities for entering the national phase shall be still calculated from the original earliest priority date.

For the location and manner of submission of documents of the international application entering the national phase, the provisions in Chapter 3 of Part V of these Guidelines shall apply. For payment of fees of the international application entering the national phase, subject

to the provisions in this Chapter, the provisions in Chapter 2 of Part V of these Guidelines shall apply.

### 2.1 Having No Effect in China

Any international application which has been accorded a filing date must have passed the examination by the receiving Office on whether it conforms with Article 11 of the Treaty and have had an affirmative conclusion. Therefore, so long as an international application designates China, according to Rule 102, the Patent Office shall accept its effect as a regular national application. The examiner shall examine whether the designation of China by the alleged international application entering the national phase continues to be effective.

If, for an alleged international application entering the national phase, there is no indication of the designation of China in its international publication document, then it has no effect in China, and the examiner shall issue the *Notification of the Failure of the International Application to Enter the Chinese National Phase* to notify the applicant that the formalities for the international application to enter the national phase are not admissible.

### 2.2 Loss of Effect in China

#### 2.2.1 Loss of Effect as Notified by the International Bureau

PCT Art. 24(1)(i) – (ii)

For an alleged international application entering the national phase, if, during the international phase, the *Notification of Withdrawal of International Application* (PCT/IB/307), or the *Notification that International Application Considered to be Withdrawn* (PCT/IB/325), or the *Notification of Withdrawal of Designations*(PCT/IB/307) to China of the international application has been transferred to the Patent Office by the International Bureau, the effect in China of the said international application has ceased in accordance with the provisions of Rule 105.1(1), and the examiner shall issue the *Notification of the Failure of the International Application to Enter the Chinese National Phase* to notify the applicant that the formalities for entering the national phase of the international application shall not be accepted.

PCT Art. 24(1)(iii)

#### 2.2.2 Delay in Going through Formalities for Entering National Phase

Where the applicant fails to go through the formalities for ente-

ring the national phase within the time limit as provided for in Rule 103; or where, though the formalities for entering the national phase have been gone through, the requirements of Rule 104. 1(1) to (3) are not complied with, the effect of the said international application shall cease in China in accordance with the provisions of rule 105. 1(2) or (3). The examiner shall issue the *Notification of the Failure of the International Application to Enter the Chinese National Phase* to notify the applicant that the formalities for entering the national phase shall not be accepted.

Where the formalities for entering the national phase, which the applicant goes through within the time limit as prescribed in Rule 103, fails to meet the prescribed requirements, the examiner shall notify the applicant that the formalities for entering the national phase are not acceptable due to defects in them. Where the applicant, before the expiration of the prescribed time limit, goes through the formalities for entering the national phase again and the above-mentioned defects are corrected, the said international application shall remain valid in China.

Where, due to delay in meeting the time limit as provided for in Rule 103, the effect of an international application ceases in China, and the applicant has submitted a request for restoration of right in accordance with Rule 6. 2, the examiner shall notify the applicant that the request is not acceptable according to Rule 105. 2. If the applicant indicates that the delay in meeting the time limit is caused by *force majeure*, the examiner shall process with the reference to Rule 6. 1.

**2. 2. 3 Election**

PCT Rule 54 bis

Where an international application elects China within the prescribed time limit and the election remains valid until the international application enters the national phase, the applicant shall go through the formalities for entering the national phase within the time limit as provided for in Rule 103.

As to whether or not China is elected, it depends on the *Notification of Election*(PCT/IB/331) sent by the International Bureau.

Where, after transmitting the *Notification of Election*, the International Bureau transmits the *Notification of Withdrawal of Demand or Elections*(PCT/IB/339) or the *Notification that Demand is Considered Not to Have Been Submitted or Made* (PCT/IB/350), and the above-mentioned notifications involve the withdrawal of election or the election deemed not to have been made, the election of China of the interna-

tional application is invalid if there is "CN" in the indicated States.

Rule 104. 2

**2. 3 Processing of International Application Entering the National Phase**

Where any international application, which has gone through the formalities for entering the national phase according to the provisions, is confirmed its effect in China after examination, and meets the requirements of the provisions of Rule 104. 1(1) to (3), the Patent Office shall accord national application number, indicate clearly the date of entry of the international application into the Chinese national phase (hereinafter called the date of entry) and issue the *Notification of International Application Entering the Chinese National Phase*. The date of entry refers to the date on which the formalities for entering the national phase have been gone through before the Patent Office and meet the requirements prescribed in Rule 104. 1(1) to (3). Where the above formalities for entering the national phase, which meet the requirements, are completed on the same day, the date shall be the date of entry. Where the above formalities for entering the national phase, which meet the requirements, are completed on different dates, the last date of completing the formalities shall be the date of entry. In the follow-up examination and approval procedures, the national application number shall be indicated when various formalities are gone through by the applicant or when the notifications are issued by the examiner.

## 3. Examination of the Application Documents Submitted at the Time of Entering the National Phase

### 3. 1 Written Statement Concerning the Entry into the National Phase

#### 3. 1. 1 International Filing Date

Rule 102

The international filing date is accorded by the receiving Office in the international phase. Where the international filing date is amended for any reason in the international phase, the amended date shall be regarded as the right one. The international filing date indicated in the *Written Statement Concerning the Entry into the National Phase* (hereinafter called "the entering statement") shall be the same as the one written on the front page of the international publication document. Where the inconsistency appears, the examiner shall correct it *ex officio* ac-

cording to the date as recorded in the international publication document and notify the applicant accordingly.

The international filing date, which has been accorded by the receiving office, is deemed as the actual filing date in China, except that the filling date in China needs to be redetermined as China makes reservations to the relevant provisions of the Treaty and the PCT Regulations.

### 3.1.2 Kind of Protection

Rule 104.1(1)
PCT Rule 4.9(a)

Article 9.1 stipulates that for any identical invention-creation, only one patent right shall be granted. Therefore, when an international application designating China is under the procession of formalities of entering national phase, it shall be indicated with either "patent for invention" or "patent for utility model" for kind of protection, which means the applicant can only choose one from the two. In this respect, it is not permitted to request "patent for invention" and "patent for utility model" at the same time. If the requirements are not complied with, the examiner shall issue the *Notification of the Failure of the International Application to Enter the National Phase*.

### 3.1.3 Title of Invention

The title of the invention in the entering statement shall be consistent with that indicated on the front page of the international publication documents. Where the international application is published in a foreign language, the translation shall not only be exact in expressing the original meaning of the title of the invention, but also be brief. Where there are no redundant words in the translation, the number of words of the title of the invention shall not be limited by the provisions of Chapter 1, Section 4.1.1 of Part I of these Guidelines.

The title of the invention indicated on the front page of the international publication document is usually derived from the request of the original international application, and a few are decided by the examiner of the International Search Authority. Where the title of the invention was decided by the examiner of the International Search Authority, the title of the invention in the entering statement shall be the translation thereof decided by the said examiner.

Where the amendment to the title of the invention is requested at the time of entering the national phase, it shall be submitted in the form of amendment to the application documents. It is not allowed to

fill in directly, in the entering statement, the amended title of the invention. The national publication does not publish the amended title of the invention.

### 3.1.4 Inventor

#### 3.1.4.1 Determination of Information on Inventor

Rule 104.1(4)

Except that the change of the inventor has been recorded by the International Bureau in the international phase, the inventor filled in the entering statement shall be the one indicated in the request of the international application. According to the provisions of the Treaty, where there are more than one inventor in an international application, different inventors may be indicated for different designated States. Under such circumstances, the inventor to be indicated in the entering statement shall be the inventor for China. Where the international publication is in a foreign language, the name of the inventor shall be translated into Chinese in an accurate way. The examiner shall compare the name of the inventor indicated in the entering statement with that recorded on the front page of the international publication document. If the requirements are not complied with, the examiner shall issue the *Notification to Make Rectification* to notify the applicant to correct it. Where no rectification is made within the time limit, the examiner shall issue the *Notification that Application Deemed to be Withdrawn*.

Where, in the international phase, the *Notification of the Recording of a Change* (PCT/IB/306) has been transferred by the International Bureau to inform the change of the inventor or of his name, the change shall be regarded as having been reported to the Patent Office, and the changed information shall be filled in the entering statement directly. The examiner shall, based on the notifications of the International Bureau, compare the relevant contents indicated in the entering statement with the information recorded in the international publication document and the notification. If the requirements are not complied with, the examiner shall issue the *Notification to Make Rectification* to notify the applicant to correct it. Where no rectification is made within the time limit, the examiner shall issue the *Notification that Application Deemed to be Withdrawn*.

Where the inventor for China is deceased and such information is recorded by the International Bureau, his name shall still be indicated

in the entering statement as the inventor.

#### 3.1.4.2 No Inventor Indicated in the International Application

Rule 104.1(4)

Where the name of the inventor is not recorded in the international publication document of an international application, the name of the inventor shall be added in the entering statement when the application enters the national phase. If the requirements are not complied with, the examiner shall issue the *Notification to Make Rectification* to notify the applicant to correct it. Where no rectification is made within the time limit, the examiner shall issue the *Notification that Application Deemed to be Withdrawn*.

It is not necessary for the examiner to examine the qualification of the inventor.

#### 3.1.4.3 Translation of the Name of Inventor

In the international phase, the family name of the inventor shall be indicated before the given name(s). The translation of the name of the inventor in the entering statement shall be written in a way that is consistent with the customary practice of the State to which he belongs.

Where the applicant believes that the translation of the name of the inventor filled in the entering statement is not accurate, he may request to make rectification on his own initiative before the completion of technical preparations for publication of the application for patent for invention or announcement of patent right for utility model by the Patent Office. Where, after examination, the examiner believes that the rectified translation of the name is consistent with the name in the original, the rectification shall be accepted, and the rectified translation of the name shall be used in the national publication or in the announcement. Where, after the preparations are completed by the Patent Office, the applicant requests to rectify the translation of the name of the inventor, he shall go through the formalities for change in the bibliographic data.

### 3.1.5 Applicant

#### 3.1.5.1 Determination of Information on Applicant

Rule 104.1(4)

Except that the change of the applicant has been recorded by the International Bureau in the international phase, the applicant who is

filled in the entering statement shall be the one indicated in the request of the international application. According to the provisions of the PCT, Where there are more than one applicant for the international application, different applicants may be indicated for different designated States. Applicants to be mentioned in the entering statement shall be the applicants for China. Where a foreign language is used in the international publication, the name or the address of the applicant shall be translated into Chinese in an accurate way. Where the applicant is an enterprise or other organization, the full name of the formal Chinese translation shall be utilized as its name. The examiner shall check the contents indicated in the entering statement with those recorded on the front page of the international publication document. If the requirements are not complied with, the examiner shall issue the *Notification to Make Rectification* to the applicant for rectification. Where no rectification is made within the time limit, the examiner shall issue the *Notification that Application Deemed to Be Withdrawn.*

Where, in the international phase of an international application, the *Notification of the record of a change* (PCT/IB/306) has been transferred by the International Bureau to inform the change of the applicant or the change of the name or address of the applicant, the change shall be regarded as having been reported to the Patent Office and the changed information shall be filled directly in the entering statement. The examiner shall, based on the notifications of the International Bureau, compare the relevant contents indicated in the entering statement with the information recorded in the international publication document and the notification. If the requirements are not complied with, the examiner shall issue the *Notification to Make Rectification* to the applicant for rectification. Where no rectification is made within the time limit, the examiner shall issue the *Notification that Application Deemed to Be Withdrawn.*

Where the applicant is deceased and such information is recorded by the International Bureau, his name shall not appear in the entering statement at the time of entering the national phase, except that the inheritor of deceased applicant is not determined.

According to the provisions of the Treaty, the receiving Office, based on the national law, shall check and determine whether or not the information provided by the applicant concerning his nationality or residence is true. The information after the examination of the receiving Office shall be indicated on the front page of the international pub-

lication document published by the International Bureau. Generally speaking, the examiner shall not have questions about it any more.

### 3.1.5.2 Qualification of Applicant

Where the applicant is a foreign individual, enterprise or other type of organization, the provisions of Article 18 shall apply to examine whether the applicant is entitled to file an application.

Where an international application has only one applicant, the applicant is usually a national or resident of a State party of the PCT, or at least a national or resident of a country party to the Paris Convention. Therefore, if there is no change in the applicant, there is no need to examine whether or not the applicant meets the requirements of Article 18. According to the provisions of the Treaty, where an international application is filed by two or more applicants, at least one of them shall be a national or resident of a State party of the PCT. Therefore, it is possible that when the international application is filed, the applicant for China is not a national or resident of a State party to the PCT. Besides, the Treaty has requirements only for the State to which the applicant filing the international application belongs, and does not have any requirements for the State to which the assignee belongs when there is any change in the applicant.

It is possible that the States to which some or all of the applicants belong are States not party to the PCT at the time of entering the national phase. Under such circumstances, the examination shall be conducted in accordance with the provisions of Chapter 1, Section 4.1.3.2 of Part I of these Guidelines. Where all of the applicants do not meet the requirements prescribed in Article 18, the application shall be rejected. Where only some of the applicants do not meet the requirements prescribed in Article 18, the examiner shall issue the *Office Action* to notify the applicant to delete the applicants who are not entitled to file the application. Where the applicant refuses to do it, the application shall be rejected.

### 3.1.5.3 Translation of the Name of Applicant

In the international phase, where the applicant is an individual, the family name shall be indicated before the given name(s). In the entering statement, the translation of the name of the applicant shall be written in a way that is consistent with the customary practice of the State to which he belongs.

Where the applicant believes that the translation of his name filled in the entering statement is not accurate, he may request to make rectification on his own initiative before the completion of technical preparations for publication of the application for patent for invention or announcement of patent right for utility model by the Patent Office. Where, after examination, the examiner believes that the rectified translation of the name is consistent with the name in the original, the rectification shall be accepted, and the rectified translation of the name shall be used in the national publication or in the announcement. Where, after the preparations are completed by the Patent Office, the applicant requests to rectify the translation of the name, he shall go through the formalities for change in the bibliographic data.

### 3.1.6 Statement of Basis Text for Examination

In the international phase, the applicant may make amendments to the claims under Article 19 of the Treaty after receiving the international search report. Such amendments shall be submitted to the International Bureau within the prescribed time limit. In the course of the international preliminary examination, the applicant may also amend the description, drawings and claims under Article 34 of the Treaty. Such amendments shall be submitted to the International Preliminary Examination Authority. In addition, when an international application enters the national phase, the applicant may also file amendments under Article 28 or 41 of the Treaty.

Thus, when an international application enters the national phase, in addition to the original application documents, it may contain one or more amended texts. The applicant shall indicate the text which shall serve as the basis text for subsequent procedures in the entering statement, i. e. , make a statement concerning the basis for examination.

Where no amendments have been made both in the international phase and after entering the national phase, the basis for examination shall be the original application. Where there have been some amendments either in the international phase or at the time of entering the national phase and the amendments have been indicated in the statement concerning the basis for examination, the text to be used for examination shall be the original application having the corresponding part replaced by the amended documents. Where the amendments have been made in the international phase but have not been indicated in the statement concerning the basis for examination, the amendments shall

be regarded as being abandoned and shall not be taken into consideration by the Patent Office.

The amendments made under Article 19 of the Treaty in the international phase, referred to in the statement concerning the basis for examination, shall have corresponding contents in the international publication document. The corresponding contents of the amendments made under Article 34 of the Treaty shall be attached to the international preliminary report on patentability. Where it is found that the amendments made in the international phase which are referred to in the statement concerning the basis for examination do not exist, the examiner shall issue the *Notification to Make Rectification* to notify the applicant to correct the relevant contents in respect of basis for examination in the entering statement.

Rule 106

Where the amendments in the international phase have been referred to in the statement concerning basis for examination, the Chinese translation of the amendments shall be submitted within two months from the date of entry. If the documents have not been submitted at the expiration of the time limit, the amendments indicated in the statement shall not be taken into consideration, and the examiner shall issue the *Notification of Non-consideration of the Amendment*.

### 3.2 Translation and Drawings of the Original Application

In accordance with the provisions of Rule 104.1(3), where an international application is filed in a foreign language, the translation of the description and the claims of the original international application shall be submitted at the time of entering the national phase. Where obvious inconsistency occurs between the translation and the original, the translation shall not be the basis for determining the date of entry.

In accordance with the provisions of Rule 104.1(5), where the international application is filed in a foreign language, the translation of the abstract shall be submitted. Where there are drawings and the drawing of the abstract, a copy of the drawings and a copy of the drawing of the abstract shall be submitted. The text matter in the drawings, if any, shall be replaced by the corresponding text matter in Chinese.

#### 3.2.1 Translation of Description and the Claims

The translation of the description and the claims shall be consistent with the contents of the description and the claims in the interna-

tional publication document transferred by the International Bureau. The translation shall be complete and authentic to the original. The applicant shall not add any content of the amendment in the translation of the original.

The contents of the "replacement sheet" or "rectified sheet" marked in the international publication document are regarded as the contents of the original application in general. For the contents filed as part of the description or the claims of an international application, and which has been declared "not to be taken into consideration" after the examination of the receiving Office and has been marked as such in the international publication document, the similar mark shall be made in Chinese in the translation. For example, where the references to the drawings are made in the description with no drawings actually provided in the application.

Where the description (including the drawings) and the claims contain the contents that are contrary to social morality or public order, or contain other belittling statement which, after the examination of the International Bureau, have been deleted from the international publication, the said contents shall not be added into the translation of the original application again. If such contents appear in the translation again, the examiner shall issue the *Notification to Make Rectification* to notify the applicant to correct the translation errors. Where such contents have not been deleted in the international publication and appear in the translation, the provisions of Chapter 1, Section 7 of Part I of these Guidelines shall apply.

PCT Rule 49.5 (a – bis)

Where, in the international phase, the description and the claims of an international application contain a nucleotide and/or amino acid sequence and that the sequence listing is submitted as a separate part of the description, at the time of submitting the translation, its translation shall also be submitted as a separate part of the description and the pages shall be numbered separately. The applicant shall also submit a copy in computer-readable form which is consistent with the said sequence listing. If the sequence listing recorded in the copy in computer-readable form is not consistent with the sequence listing stated in the description, the sequence listing stated in the description shall prevail. Where no such copy in computer-readable form has been submitted or the submitted copy is obviously not in conformity with the sequence listing stated in the description, the examiner shall issue the *Notification to Make Rectification* to the applicant for rectification. Where

no rectification is made within the time limit, the examiner shall issue the *Notification that Application Deemed to Be Withdrawn.*

Where the free text of the sequence listing has been included in the main part of the description, no translation of the free text is needed for such sequence listing.

In the international phase, where the description of an international application contains a nucleotide and/or amino acid sequence listing part with more than 400 pages, the sequence listing in the computer-readable form in accordance with the provisions may be submitted only at the time of entering the national phase.

It is unnecessary to translate the language of a computer program cited in the description. It is acceptable if the translation of the editors' name and the title of the document in the cited reference materials are in consistency with the requirements for national publication.

### 3.2.2 Drawings

In accordance with the provisions of Rule 104.1(5), where an international application filed in a foreign language contains the drawings, a copy of the drawings shall be submitted. The text matter in the drawings, if any, shall be replaced by the corresponding text matter in Chinese, and a new copy of the drawings shall be furnished with text matter in Chinese marked in proper place instead of the original language. Even if the contents of the text in the drawings do not comply with the provisions of Rule 18, it shall be translated according to the original application. The new drawings shall be identical with the drawings in the international publication document and shall meet the formal requirements for the drawings of Chapter 1, Section 4.3 of Part I of these Guidelines.

It may not be required to translate the word "Fig." in the drawings into Chinese. The same is for the language of a computer program or certain text for screen images in the drawings.

If the requirements are not complied with, the examiner shall issue the *Notification to Make Rectification* to the applicant for rectification. Where no rectification is made within the time limit, the examiner shall issue the *Notification that Application Deemed to Be Withdrawn*.

### 3.2.3 Translation of Abstract and Figure Accompanying the Abstract

Rule 104.1(5)

The translation of the abstract shall be consistent with the content of

the abstract on the front page of the international publication document. Where the examiner of the International Search Authority has amended the abstract submitted by the applicant, the translation of the amended abstract shall be submitted. For example, where the international search report is contained in the re-published international publication document A3 later rather than in the first published international publication document A2, and the content of the abstract on the front page of international publication document A3 is different from that of the international publication document A2, the translation shall be made on the basis of the content of the abstract in the international publication document A3.

The translation shall be brief on condition that the content of the original application is not changed. So long as there are no unnecessary words or sentences, the examiner shall not request the applicant to amend or amend *ex officio* the translation on the grounds of not complying with the requirement on the number of words in the abstract as provided for in Rule 23. 2.

Where the international publication document contains no abstract, the applicant shall submit the translation of the original abstract of the international application at the time of entering the national phase.

Where the international application contains the drawing of the abstract, a copy of the drawing of the abstract shall be submitted. The copy of the drawing of the abstract shall be consistent with the corresponding drawing of the international publication. Where there are text matters in the drawing, they shall be replaced by the corresponding text matters in Chinese. A new copy of the drawings shall be furnished with Chinese words marked in proper place instead of the original language. Where the search report is not contained in the first publication, and the drawing of the abstract in the first published international publication document A2 is different from that in re-published international publication document A3 later, the drawing of the abstract for re-publication shall prevail.

If the requirements are not complied with, the examiner shall issue the *Notification to Make Rectification* to the applicant for rectification. Where no rectification is made within the time limit, the examiner shall issue the *Notification that Application Deemed to be withdrawn.*

Rule 104.1

### 3.3 International Application of Which the International Publication is in Chinese

For an international application of which the international publication is in Chinese, at the time of entering the national phase, it is necessary to submit only the entering statement, a copy of the abstract and the drawing of the abstract(if any) of the original application. It is not necessary to submit the copies of the description, claims and drawings. But, before the international publication of the international application has been completed, if the applicant requests early processing and early national publication of the international application, the applicant shall still submit the copies of the description, claims and drawings(if any).

### 3.4 Processing Before Expiration of Time Limit

According to Article 23(1) of the Treaty, no designated Office shall process or examine the international application prior to the expiration of the applicable time limit under Article 22, and the said applicable time limit is within thirty months from the date of priority. Article 23(2) of the Treaty also provides that not withstanding the provisions of paragraph(1), any designated Office may, on the express request of the applicant, process or examine an international application at any time. For the elected Office, corresponding stipulations are provided in Article 40 of the Treaty.

#### 3.4.1 Early Processing

According to Rule 111, if the Patent Office is requested to handle and examine an international application before the expiration of thirty months from the date of priority, the applicant, in addition to going through the formalities for entering the Chinese national phase as provided for in Rules 103 and 104, shall also go through the following formalities:

(1) an express request shall be submitted in accordance with Article 23(2) of the Treaty.

(2) where the International Bureau has not transferred the international application to the Patent Office, a certified copy of the international application shall be submitted to the Patent Office, the said copy is a copy of the "home copy" certified by the receiving Office or the "record copy" certified by the International Bureau.

(3) the applicant may request the International Bureau to transfer

the copy of the international application document to the Patent Office in accordance with the provisions of Rule 47. 4 of the PCT Regulations, or the Patent Office requests the International Bureau to transfer the copy of the international application document when the applicant files a request with the Patent Office.

Where an international application meets above-mentioned requirements, the examiner shall handle and examine it in time.

#### 3. 4. 2 Delaying of the Processing

As for an international application, where, before the expiration of thirty months from the date of priority, the formalities for entering the national phase have been gone through, but the formalities provided in Rule 111 have not been gone through, in accordance with the provisions of the Treaty, the Patent Office shall not process the international application.

## 4. Examination of Translation of Amended Documents in the International Phase

### 4. 1 Translation of Claims Amended under Article 19 of PCT

Where, according to the statement of the applicant, the claims amended under Article 19 of the Treaty are served as the basis for examination, and the international publication of the amendments is in a language other than Chinese, the applicant shall submit its translation at the time of entering the national phase, or at the latest within two months from the date of entry. In accordance with the provisions of Rule 106, the amendments of which the translation is submitted after the said period shall not be taken into consideration. The examiner shall issue the *Notification of Non-consideration of the Amendment*. Where an international publication document contains the statement concerning amendments under Article 19(1) of the Treaty and the applicant requests the examiner to take the said statement into consideration, the applicant shall submit the translation of the statement at the same time when the translation of the amended claims is furnished.

The translation of the amended claims (including amendment, addition or deletion of the claim (s)) shall be consistent with the content of the corresponding part recorded in the international publication document. For amendments which were submitted in the international phase but were refused by the International Bureau for not being in-

conformity with the provisions of Rule 46 of the PCT Regulations, they shall not be submitted as amendments under Article 19 of the Treaty at the time of entering the national phase.

The translation of the amendments shall be made in the form of the amendment sheet that can replace the corresponding part of the translation of the original application. The words "Claims (amended under Article 19 of the PCT)" shall be indicated on the top of the first page of the translation of the amended claims.

For the translation of the amended documents which are submitted after entering the national phase, the *Form to Supplement the Translation of Amended Document or the Amended Document* shall be attached. The applicant shall indicate in the Form that he intends to use the amended contents as the basis for examination.

The translation of the claims amended under Article 19 of the Treaty shall be published together with the translation of the claims of the original application. The translation of the amended claims shall meet the requirements concerning the form of publication as provided for in these Guidelines.

Where the translation of the amended documents fails to meet the requirements, the examiner shall issue *the Notification of Defects of the Amended Document* to notify the applicant to make rectifications. If the applicant fails to submit the rectifications within the specified time limit, the examiner shall issue the *Notification of Non-consideration of the Amendment*.

Where the claims amended under Article 19 of the Treaty is also used as the basis for international preliminary examination, and the applicant has submitted it as the translation of the annexes of the international preliminary report on patentability at the time of entering the national phase, the said translation shall not be published in the national publication.

### 4.2 Translation of Amendments under Article 34 of the PCT

Rule 106

Where, according to the statement of the applicant, the amendments made under Article 34 of the Treaty are served as the basis for examination, and the amendments are made in a language other than Chinese, the translation shall be submitted at the time of entering the national phase, and at the latest within two months from the date of entry. The translation of the amended part submitted after the said period shall not be taken into consideration. The examiner shall issue the *Noti-*

*fication of Non-consideration of the Amendment*.

The content of the translation of the amended part shall be consistent with the content of the amendment sheet attached to the international preliminary report on patentability transferred by the International Bureau. Where, in the international phase, the applicant declares that the amendments have been made under Article 34 of the Treaty, but the amendments fail to be accepted by the examiner, and thus have not been transferred as the annexes of the international preliminary report on patentability, the applicant shall not submit such contents to the Patent Office at the time of entering the national phase as amendments made under Article 34 of the Treaty.

The translation of the amendments shall be made in the form of the amendment sheet that can replace the corresponding part of the translation of the original application. If, as the result of the amendment, there is an addition of the content in a page, one or more pages may be inserted after that page. The pages shall be numbered as "Xa", "Xb" or"X-1", "X-2". If, as the result of the amendment, there is a cancellation of an entire page, the indication shall be made in the explanation of the amendments. Where a certain claim is deleted from the claims, the original numbering may stay, with the word"deletion" indicated. The amended claims may also be renumbered in a continuous way, with explanation attached to illustrate it. Brief explanation of the amendments shall be attached in front of the translation of the amendments. On top of that page, there shall indicate the words "translation of annexes of international preliminary report on patentability". Explanation of the amendments shall indicate only the parts where the amendments are involved.

For the translation of the annexes of the international preliminary report on patentability submitted after entering the national phase, the *Form to Supplement the Translation of Amended Document or the Amended Document* shall be attached. The willing to use the amendments as the basis for examination shall be indicated in the said Form.

Where the translation of the amended documents fails to meet the requirements, the examiner shall issue the *Notification of Defects of the Amended Document* to notify the applicant to make rectifications. If the rectifications are not submitted within the specified time limit, the examiner shall issue the *Notification of Non-consideration of the Amendment*.

The translation of the annexes of the international preliminary re-

port on patentability shall not be published in the national publication.

## 5. Examination of Other Documents

### 5.1 Appointment and Power of Attorney

#### 5.1.1 Appointment

Art. 19.1

For a foreign applicant who has no habitual residence or business office in Mainland China, he shall, at the time of entering the national phase, appoint a patent agency to handle the relevant matters. If no patent agency is appointed, the examiner shall handle the matter according to the relevant provisions of Chapter 1, Section 6.1.1 of Part I of these Guidelines.

For an applicant who has habitual residence or business office in Mainland China, he is not obliged to appoint a patent agency at the time of entering the national phase.

#### 5.1.2 Power of Attorney

Rule 15.3

When an international application enters the national phase, in addition to meeting the requirements prescribed in Chapter 1, Section 6.1.2 of Part I of these Guidelines, the submitted power of attorney shall also indicate the international application number, and the name or title of the applicant (i.e., consignor) both in the original and in its Chinese translation. Except in cases where there are changes, the original name or title of the applicant shall be in the same language as and be identical in content with that recorded on the front page of the international publication document; where a change has been made in the international phase, the change shall be identical with the changed content recorded in the *Notification of the Recording of a Change* (PCT/IB/306). The translation of the name or title shall be identical with that recorded in the entering statement.

Where, at the time when the international application enters the national phase the formalities for the change of applicant are gone through, the applicant may submit only the power of attorney signed by the changed applicant.

Where, for an international application, no power of attorney is submitted at the time of entering the national phase, or the submitted power of attorney has some defects, the relevant provisions of Chapter 1, Section 6.1.2 of Part I of these Guidelines shall apply.

## 5.2 Claiming Priority

### 5.2.1 Declaration of Claiming Priority

According to Rule 110.1, where the applicant claims one or multiple priorities in the international phase and such claims remain valid at the time when the application enters the national phase, the applicant shall be deemed to have submitted the written declaration in accordance with the provisions of Article 30.

As China makes reservations to the relevant provisions of the Treaty and its Regulations, the Patent Office shall not recognize the priority restored in the international phase of the international application (for example, the international filing date is later than twelve months but within fourteen months from the priority date), and the corresponding priority claim will lose effect in China, in respect of which the examiner shall issue the *Notification that Claim to Priority Deemed Not to Have Been Made*.

The applicant shall accurately indicate in the entering statement the date of filing, the application number of the earlier application and the title of the authority with which the earlier application was filed. Except for cases mentioned in the next paragraph, the indicated contents shall be consistent with that recorded on the front page of the international publication document. Where any inconsistency is found in the entering statement, the examiner may correct it *ex officio* according to that recorded on the front page of the International publication document, and notify the applicant promptly.

The priority claim referred to in the *Notification of Withdrawal of Priority Claim* (PCT/IB/317) or *Notification that Priority Claim Considered not to Have Been Made* (PCT/IB/318) transferred by the International Bureau to the Patent Office shall be regarded as having lost its effect and shall not be included in the entering statement. If the requirements are not complied with, the examiner shall issue the *Notification that Claim to Priority Deemed Not to Have Been Made* regarding the priority claim.

Where, in the international phase, the receiving Office has already conducted an examination on the validity of the priority claim, i. e., whether or not the earlier application serving as the basis of the priority has been filed in a contracting state to the Paris Convention or the World Trade Organization (WTO), whether or not the applicant is a

national or resident of a contracting state to the Paris Convention and whether or not the filing date of the earlier application is within twelve months before the international filing date, and has declared that the priority claim is deemed not to have been made for the reason of failing to meet above-mentioned requirements, the Patent Office will not doubt the decision.

Where, in the international phase, the applicant fails to provide the application number of the earlier application, he shall indicate the application number in the entering statement. If the requirements are not complied with, the examiner shall issue the *Notification to Rectify Formalities*. Where no rectification is made within the time limit or the rectification is still not in conformity with the requirements after the applicant makes rectification, the examiner shall issue the *Notification that Claim to Priority Deemed Not to Have Been Made* regarding the priority claim.

Where the applicant believes that there is a clerical error somewhere in the written declaration of priority claim made in the international phase, the applicant may file a request for correction at the time of going through the formalities for entering the national phase or within two months from the date of entry. Such request shall be submitted in the written form, and the corrected priority claim shall be indicated. At the time when the request for correction is submitted, where the applicant has not submitted a copy of the earlier application to the International Bureau, a copy of the earlier application shall be attached to serve as the basis of correction. If the requirements are not complied with, the request for correction shall be deemed not to have been made.

A new priority claim shall not be allowed to submit after entering the national phase.

### 5.2.2 Submission of a Copy of the Earlier Application

Rule 110.3

In accordance with the provisions of Rule 17 of the PCT Regulations, where the applicant has submitted a copy of the earlier application to the receiving Office or requested the receiving Office to prepare a copy of the earlier application, the Patent Office shall not request the applicant himself to submit the copy of the earlier application. The International Bureau shall be requested to provide the said copy by the Patent Office. Where the examiner of the Patent Office deems necessary to check the copy of the earlier application, he shall request the In-

ternational Bureau to transfer the copy of the earlier application. For example, where, under the item of relevant documents in the international search report, there are documents marked with "PX" or "PY", etc. or where documents of "PX" or "PY" are not found by the examiner of the International Search Authority, but are found by the examiner of the Patent Office who is responsible for the substantive examination in the process of supplementary search.

Where the Patent Office is notified by the International Bureau that the applicant has not submitted a copy of the earlier application according to the provisions in the international phase, the examiner shall issue the *Notification to Rectify Formalities* to notify the applicant to submit them within the prescribed time limit. Where such documents have not been submitted at the expiration of the time limit, the examiner shall issue the *Notification that Claim to Priority Deemed Not to Have Been Made* in respect of the corresponding priority claim.

### 5.2.3 Examination of a Copy of Earlier Application

Where the International Bureau has provided a copy of earlier application or where the applicant has supplemented a copy of earlier application, the examiner shall conduct the examination to the copy of earlier application.

#### 5.2.3.1 Inconsistent with Declaration of Priority

The examiner shall examine each item contained in the declaration of priority based on the earlier application documents. If one or two items are inconsistent with that recorded in the earlier application documents, the examiner shall issue the *Notification to Rectify Formalities*. Where no rectification is made within the time limit or the rectification is still not in conformity with the requirements after the applicant makes rectification, the examiner shall issue the *Notification that Claim to Priority Deemed Not to Have Been Made*.

#### 5.2.3.2 Submission of Certification of Enjoying Right of Priority

The examiner shall check whether or not the applicant of the international application has right to claim the right of priority of the earlier application indicated in the application at the filing date. Where the earlier application is not filed with the Patent Office, the applicant shall be considered to have right to claim the right of priority if one of the following requirements has been met:

(1) the applicant of the later application is the same as that of the earlier application;

(2) the applicant of the later application is one of the applicants of the earlier application;

(3) the applicant of the later application enjoys the right of priority as the result of assignment or gift of the applicant of the earlier application or transfer of right in other form.

For cases under item (3), except that the applicant has made a declaration of enjoying the right of priority in the international phase and the declaration meets the requirements, the applicant shall submit the relevant certifying documents. The certifying documents shall be signed or sealed by the assignor. The certifying documents shall be the original documents or the certified copy of the original documents.

Where, through examination, the applicant of an international application is found not in conformity with the requirements mentioned in(1) or(2), the examiner shall check whether or not a declaration of having the right to claim priority of the earlier application made by the applicant is included in the international publication document. If there is such a declaration, and the examiner believes it is true and credible, the applicant shall not be asked to submit the certifying documents. If there is no such declaration or if the declaration fails to meet the requirements, the examiner shall issue the *Notification to Rectify Formalities*. Where no rectification is made within the time limit or the rectification is still not in conformity with the requirements after the applicant makes rectification, the examiner shall issue the *Notification that Claim to Priority Deemed Not to Have Been Made*.

Where the earlier application is filed in China, the provisions of Section 5. 2. 6 of this Chapter shall apply for examining whether the applicant of the later application has the right to claim the priority of the earlier application indicated in the application.

### 5.2.4 Fee for Priority Claim

Rule 110. 2

Where any priority claim is made, the applicant shall pay the fee for priority claim within two months from the date of entry. If the fee is not paid or not paid in full within the time limit, the priority claim shall be deemed not have been made, and the examiner shall issue the *Notification that Claim to Priority Deemed not to Have Been Made*.

### 5.2.5 Restoration of Claim to Right of Priority

Where an international application occurs the circumstance under Rule 26bis. 2 of the PCT Regulations in the international phase, and the International Bureau or the Receiving Office declares that the priority claim is considered not to have been made, the applicant may, at the time of going through the formalities for entering the national phase, request for restoration of the priority claim, pay the restoration fee and where the applicant has not submitted a copy of the earlier application to the International Bureau, in the meantime attach the copy of the earlier application as the basis of restoration, provided that the information concerning the priority claim considered not to have been made has been published together with the international application. The request for restoration submitted after entering the national phase shall not be taken into consideration.

After the international application enters the national phase, the applicant may request to restore the right of claiming priority in accordance with the provisions of Rule 6 if the priority claims is deemed not to have been made due to the following circumstances:

(1) where the applicant fails to provide the application number of the earlier application in the international phase, and still fails to indicate it in the entering statement;

(2) where the declaration of claiming priority is in conformity with the provisions, but the copy of the earlier application or the document certifying the assignment of the right of priority has not been submitted within the prescribed time limit;

(3) where in the declaration of claiming priority, one or two items of the date of filing, the filing number and the title of the receiving authority with which the earlier application was filed are inconsistent with the copy of the earlier application; and

(4) where the declaration of claiming priority is in conformity with the provisions, but the fee for claiming priority is not paid or not paid in full within the prescribed time limit.

The provisions of Chapter 7, Section 6 of Part V of these Guidelines shall apply concerning dealing with the request for restoration of right.

Except for the above circumstances, the right of priority that is deemed not to have been made due to other reasons shall not be restored.

### 5.2.6 Earlier Application Being Filed in China

Where the earlier application is a national application filed in China, of which the priority has been claimed by an international application, the requirements to be satisfied in the preliminary examination of the priority of the said international application shall be, except the provisions of Section 5.2.3.2 of this Chapter, the same as those of other international applications.

Where the earlier application was filed in China, the applicant of the later application claiming the priority shall be the same as that of the earlier application, or the person to whom all of the applicants of the earlier application have assigned the right of priority. Where these requirements are not satisfied, the priority shall be considered not to have been made.

Where the earlier application was filed in China, when an international application claiming the priority of the earlier application enters into the Chinese national phase, it shall be considered as claiming domestic priority. If, at the time of filing, an international application claims the priority of an earlier application, and the subject matter of the earlier application falls into one of the situations listed in Rules 32.2(1)-(3), the examiner shall issue the *Notification that Claim to priority Deemed not to Have Been Made*. Due to special proceedings for the international applications, the examiner shall not handle the earlier application of which the priority is claimed according to the provisions of Rule 32.3. Similarly, the examiner shall not handle the situation concerning the grant of patent right to the earlier application after the international application is filed, though it may lead to double patenting of both the earlier application and the later application. All these issues shall be left to be handled during the subsequent procedures.

### 5.3 Incorporation by Reference

According to the provisions of the PCT Regulations, where some elements or parts, which are missing when the applicant files the international application, they may be incorporated by reference of the corresponding parts in the earlier application, and the original filing date shall be retained. Here, "elements" refer to all the description or claims, and "parts" refer to part of the description, part of claims or all or part of drawings.

As China makes reservations to the above provisions of the Treaty

and its Regulations, when the international applications enters the Chinese national phase, where the original international filing date is retained through incorporating the missing elements or parts by reference from earlier application, the Patent Office shall not recognized it.

For the application documents which contain the elements or parts incorporated by reference, where, at the time of going through the formalities for entering the national phase, the applicant indicates it in the entering statement and requests to amend the filing date for China, the elements or parts incorporated by reference can be retained in the application documents. The examiner shall redetermine the filing date in China based on the records in the *Notification on Decision of Confirmation of Incorporation by Reference of Element or Part* (Form PCT/RO/114) delivered by the International Bureau, and issue the *Notification of Redetermination of the Filing Date*. With regard to the application whose filing date exceeds twelve months from priority date due to redetermination of the filing date, the examiner shall issue the *Notification that Claim to Priority Deemed Not to Have Been Made* in respect of the relevant priority claim. For the application documents which contain the elements or parts incorporated by reference, where, at the time of going through the formalities for entering the national phase, the applicant does not indicates it, or does not request to amend the filing date in China, the elements or parts incorporated by reference are not permitted to be retained in the application documents. The examiner shall issue the *Notification to Make Rectification* to notify the applicant to delete the elements or parts incorporated by reference. Where no rectification is made within the time limit, the examiner shall issue the *Notification that Application Deemed to be Withdrawn*. The applicant cannot request to retain the elements or parts incorporated by reference by the means of requesting to amend the filing date in China in subsequent procedures.

### 5.4 Non-Prejudicial Disclosures

In accordance with the provisions of Rule 107, where any invention-creation to which the international application relates has one of the events referred to in Article 24(1) or(2), and where statements have been made in this respect when the international application is filed, the applicant shall indicate it in the entering statement, and furnish the relevant certifying documents as prescribed in Rule 30.3 within two months from the date of entry. If the applicant fails to indicate

it or furnish the relevant certifying documents within the time limit, the provisions of Article 24 of the Patent Law shall not apply to his international application.

Where the applicant indicates in the entering statement that the grace period for keeping novelty has been requested at the time of filing the international application, there shall be corresponding indication on the front page of the international publication document, which includes the date and venue of the disclosure, kind of disclosure and the name of the exhibition or meeting in respect of the non-prejudicial disclosure. The exhibition indicated in the entering statement shall fall under Rule 30. 1, and the academic or technological meeting indicated shall fall under Rule 30. 2. If the requirements are not complied with, the examiner shall issue the *Notification that Grace Period Concerning Novelty Deemed Not to Have Been Claimed.*

Where the indication is contained in the international publication document other than the entering statement, the applicant may rectify it within two months from the date of entry.

Because of the special procedure for the international application, the time limit for submitting the certifying materials is within two months from the date of entry. For requirements for the certifying materials, the provisions in Chapter 1, Section 6. 3 of part I of these Guidelines shall apply.

### 5.5 Matter Relating to Deposit of Sample of Biological Material

#### 5.5.1 Indication in the Entering Statement

In accordance with the provisions of Rule 108. 1, where the reference has been made to the deposit of sample of biological material according to the provisions of the Treaty, the applicant shall indicate such reference in the entering statement. The indication shall include the kind of documents in which the particulars of the deposit are recorded, and, where necessary, the accurate location of the relevant content in the said documents.

Where the particulars of the deposit are included in the description in a way other than the form, the applicant shall indicate, in the entering statement under the specified items, the location, i. e. , the page number and number of lines of the content concerning the deposit in the translation of the description. The examiner shall check the corresponding content of the translation. Where the particulars of the de-

posit are indicated in the *Indications Relating to Deposited Microorganism or Other Biological Material* (PCT/RO/134) or other separate sheet, such form or sheet shall be included in the international publication document. Where the examiner finds, after verification, that there is no indication concerning the particulars of the deposit in the corresponding location of the translation indicated in the entering statement, or where the *Indications Relating to Deposited Microorganism or Other Biological Material*(PCT/RO/134) or other separate sheet indicated in the entering statement is not included in the international publication document, the *Notification that Biological Material Sample Deemed Not to Have Been Deposited* shall be sent, and the reference to the deposit of sample of biological material shall be considered not to have been made.

Rule 108.2

Where the reference to the deposit of sample of biological material has been made in the international phase according to the provisions of the Treaty, but such reference is not indicated or is not accurately indicated in the entering statement, the applicant may rectify it on his own initiative within four months from the date of entry. Where no rectification is made at the expiration of the time limit, such reference shall be considered not to have been made, and the examiner shall issue the *Notification that Biological Material Sample Deemed Not to Have Been Deposited* to notify the applicant that the said sample of biological material shall be considered not to have been deposited.

### 5.5.2 Reference to Deposit of Sample of Biological Material

In accordance with the provisions of Rule 108, where the applicant has made reference to the deposit of sample of biological material according to the provisions of the Treaty, the requirements in Rule 24(3) shall be deemed to have been satisfied.

PCT Rule 13 bis.3 (a) & 13 bis.4(a)

According to the provisions of the PCT Regulations, the reference to deposited biological material shall include the title and the address of the depositary institution, the date on which the sample of biological material is deposited, the accession number given to the deposit by that institution. So long as the reference reaches the International Bureau before the preparations for the international publication have been completed, such reference shall be considered to have been furnished in time. To this end, where the reference to the deposit of the sample of biological material indicated in the entering statement is included in the international publication document as part of the description or in

the form of separate sheet, and the content of the reference include the above prescribed particulars, the examiner shall regard the reference as meeting the requirements. Where the applicant makes no reference to the deposit of the sample of biological material in the international phase, but declares in the entering statement that the application relates to the deposit of sample of biological material, the examiner shall issue the *Notification that Biological Material Sample Deemed Not to Have Been Deposited* to notify the applicant that the sample of biological material shall be deemed not to have been deposited.

Where the certificate of deposit of the biological material sample is submitted by the applicant on the filing date, and it is included as part of the international application in the international publication document by the International Bureau, when a request is made by the applicant to make rectification to the missing part of the reference to the deposit of the sample of biological material, the examiner may allow the applicant to make supplement or correction based on the certificate of deposit in the international publication document.

Where it is found that the reference to the deposit of the sample of biological material is not in conformity with the particulars of the deposit recorded in the certificate of deposit, and it can be assured that the inconsistency is caused by the clerical error in the reference, the examiner shall issue the *Notification to Rectify Formalities* to notify the applicant to make rectification. Where no rectification is made at the expiration of the time limit, the examiner shall issue the *Notification that Biological Material Sample Deemed not to Have Been Deposited* and the sample of biological material shall be considered not to have been deposited.

Where the reference to the deposit of the sample of biological material is submitted in the form of the *Indications Relating to Deposited Microorganism or Other Biological Material* (PCT/RO/134) or in the form of separate sheet other than the description, it shall be translated into Chinese as part of the international application at the time of entry into the national phase. Where no Chinese translation is submitted, the examiner shall issue the *Notification to Rectify Formalities* to notify the applicant to rectify it. Where no rectification is made at the expiration of the time limit, the reference to the deposit of the sample of biological material shall be deemed not to have been made and the examiner shall issue the *Notification that Biological Material Sample Deemed Not to Have Been Deposited* to notify the applicant that the said

sample of biological material is deemed not to have been deposited.

### 5.5.3 Certificate of Deposit of Biological Material Sample

Rule 108.3

Because of the special procedure of the international application, the time limit for submitting the certificate of deposit and the certificate of viability of the biological material is within four months from the date of entry. For examination of the contents of the certificate of deposit and the certificate of viability of the biological material, the provisions in Chapter 1, Section 5.2.1 of Part I of these Guidelines shall apply.

## 5.6 Source of Genetic Resources

Art. 26.5
Rule 109

Where an invention-creation has been developed relying on the use of genetic resources for which the international application is filed, the applicant shall indicate the fact in the entering statement, and fill in the *Registration Form of Indicating Source of Genetic Resources*. If the requirements are not complied with, the examiner shall issue the *Notification to Make Rectification* to notify the applicant for rectification. Where no rectification is made within the time limit, the examiner shall issue the *Notification that Application Deemed to be Withdrawn* . Where it is still not in conformity with the requirements after rectification, the patent application shall be rejected.

## 5.7 Amendment to the Application Documents after Entering the National Phase

According to Rule 112, the applicant may file requests to amend the patent application documents within the prescribed time limit after going through the formalities for entering the national phase, and such amendments are called the amendments in the national phase.

For an international application pursuing a patent right for utility model, the applicant may file a request on his own initiative to amend the patent application documents within two months from the date of entry.

For an international application pursuing a patent right for invention, the applicant may amend the application documents on his own initiative according to Rule 51.1.

When an international application enters the national phase, if the applicant requests definitely that the amendments made under Article28 or 41 of the Treaty serve as the basis of examination, the amendments

may be submitted together with the translation of the original application, and such amendments are considered as the amendments submitted on the applicant's own initiative according to Rule 112.

The applicant shall enclose the detailed explanation of the amendments when submitting the amendments. The explanation may be in the form of a table of comparison on the contents before and after amendment or the marked notes of amendments on the copy of the original. Where the amendments are submitted at the time of entering the national phase, the words of "amendments made under Article 28 (or 41) of the Treaty" shall be marked on top of the explanation of the amendments.

The contents of the amendments shall be submitted in the form of replacement sheets. The contents of the replacement sheets shall correspond with those of the replaced sheets and shall be consistent with the context in meaning.

### 5.8 Correction of Translation Errors

PCT Art. 11(3)

In accordance with the provisions of the Treaty, an international application shall have the effect of a regular national application in each designated State from the international filing date. Thus, the international application transferred by the International Bureau to the designated Office or the elected Office is the text which has the legal effect. Where, on the basis of the said text, it is found that there are translation errors submitted at the time of entering the national phase, the applicant shall be allowed to correct the translation errors provided that the provisions of Rule 113 are fulfilled.

The translation errors refer to cases where terms, sentences or paragraphs of the translation text are omitted or inaccurate compared with the original text transferred by the International Bureau. Where the obvious inconsistency appears between the translation text and the original text transferred by the International Bureau, the rectification in the form of correcting the translation errors shall not be allowed.

The applicant may go through the formalities for correcting the translation errors before the completion of technical preparations for publication of the application for the patent for invention or announcement of the patent for utility model by the Patent Office.

At the time of correcting the translation errors, in addition to submitting the corrected sheet, the applicant shall file a written request for correcting the translation errors and pay the prescribed handling fee for

correction of the translation. If the requirements are not complied with, the examiner shall issue the *Notification that Request Deemed Not to Have Been Submitted*.

The corrected sheet of the translation and the corresponding sheet of the original translation shall be mutually replaceable, i. e., the corrected content shall be consistent with the context in meaning.

If inconsistency exists in the nonverbal part, such as in a mathematical or chemical formula, etc., it shall not be handled as a translation error. The applicant shall be asked to make rectification only.

### 5.9 Request for Substantive Examination

Art. 35

For an international application which enters the national phase and designates China for a patent for invention, the request for substantive examination shall be submitted within three years from the date of priority, and the fee for substantive examination shall be paid. The examiner shall conduct the examination in accordance with the provisions of Chapter 1, Section 6.4 of Part I of these Guidelines.

### 5.10 Changes in Bibliographic Data

#### 5.10.1 Changes Recorded by the International Bureau

##### 5.10.1.1 Effect of Notification of the International Bureau

In the international phase, upon the request of the applicant or the receiving Office, the International Bureau records the change of the applicant or his name, residence, nationality or address in the request, or the change of the inventor or his name in the request and notifies the designated Office in a written form. So long as the Patent Office has received the *Notification of the Recording of a Change* (PCT/IB/306) from the International Bureau, the applicant shall be considered to have reported the change in the bibliographic data to the Patent Office. This means there is no need for the applicant to submit a statement for the change in the bibliographic data and pay the handling fee for such change. When the international application enters the national phase, the changed bibliographic data shall be used directly.

##### 5.10.1.2 Supplement of Certifying Materials

Where a change is made under the item of "applicant" (entity only) as indicated in the *Notification of the Recording of a Change* (PCT/

IB/306) transferred by the International Bureau, the applicant shall, at the time of entering the national phase, in accordance with Rule 104. 1(6), submit the contract on the assignment or gift of the right to apply for a patent, the certifying document on the merger of the company provided by the administrative authority of industry and commerce, or other certifying documents relating to transfer of right. The certifying documents may be the original or the copy certified by the public notary organ. The examiner shall examine the validity of the certifying documents. Where the certifying documents are not provided, the examiner shall issue the *Notification to Make Rectification* to notify the applicant to supplement them. If no documents are supplemented at the expiration of the time limit, the examiner shall issue the *Notification that Application Considered to Be Withdrawn*.

Where, in the *Notification of the Recording of a Change* (PCT/IB/306) transferred by the International Bureau, the recorded change refers to the assignment of the right to apply for a patent by an entity or individual of Mainland China to a foreign individual, enterprise or other type of organization, the provisions prescribed in Chapter 1, Section 6. 7. 2. 2(3)(ii) of Part I of these Guidelines shall apply.

Where, in the *Notification of the Recording of a Change*(PCT/IB/306) transferred by the International Bureau, the indicated change refers to the change in name, address of the applicant, and the name of the inventor, no certifying documents are necessary. The change shall be deemed to have taken effect.

### 5. 10. 2 Changes in Bibliographic Data in the National Phase

Where the formalities of the change in the bibliographic data are gone through at the time of or after entering the national phase, Chapter 1, Section 6. 7. 1 of Part I of these Guidelines shall apply.

In addition to the certifying documents of the several kinds of changes in the bibliographic data as indicated in Chapter 1, Section 6. 7. 2 of Part I of these Guidelines, under the following two circumstances, the statement made by the party concerned himself (applicant or inventor) may also be used as the certifying documents for request for change.

(1) The applicant states that the wrong name of the applicant, or the wrong name of the inventor is filled at the time of filing the international application, and a request is filed to correct the error after entering the national phase.

(2) The applicant states that different titles or names of the applicant or inventor of an international application are used for different States (not just the language difference) and he intends to use a title or name different from that recorded in the international publication for China, and files the request for change in China. For example, a Chinese American uses the name of "xxx, Tom" in the U. S. A. and has filed an international application in this name, but requests to use "xxx" as his name at the time of entering the Chinese national phase.

## 5.11 Request for Review

### 5.11.1 Submission of Request for Review

PCT Art. 25

According to the provisions of the Treaty, the circumstances under which submission of a request for review to the Patent Office as designated Office or elected Office by the applicant may be allowed are as follows:

(1) where the receiving Office has refused to accord an international filing date or has declared that the international application is considered withdrawn; and

(2) where the International Bureau has declared that the international application is deemed withdrawn because it has not received the registered copy of the application within the prescribed time limit.

Rule 116
PCT Rule 51

The request for review shall be submitted to the Patent Office within two months from the date of receiving the notification of the above-mentioned decision. In the request, the reason for the request for review shall be indicated and the copy of the decision which is the subject for review shall be attached. Upon the request of the applicant, the copy of the relevant documents of the file will be transferred by the International Bureau to the Patent Office later.

### 5.11.2 Other Formalities

At the time of submitting the request for review according to Section 5.11.1 of this Chapter, the applicant shall go through the formalities for entering the national phase prescribed in Rules 103 and 104 before the Patent Office. He shall indicate in the entering statement the fact that the request for review has been submitted.

### 5.11.3 Review and Follow-Up Processing

Where the examiner believes the request for review is submitted

in accordance with the provisions of the Treaty and its Regulations, and the formalities for entering the national phase have been gone through in accordance with the provisions, he shall review the decision made by the International Bureau or receiving Office to find whether or not it is correct.

Where the examiner believes the decision made by the said International Authority is correct and the effect of the said international application in China has ceased, the provisions of Section 2. 2. 1 of this Chapter shall apply.

Where the examiner believes the decision made by the International Authority is incorrect, he shall confirm that the international application has effect in China, and continue the processing and examination of it in the national phase. For the international application of which the international filing date has not been accorded by the receiving Office, the examiner shall notify the applicant that the application is deemed to be filed with the Patent Office on the date on which the international filing date shall be accorded.

Where the international application has not been published in the international publication because of interruption of the proceedings in the international phase, the examiner, at the time of conducting the examination prescribed in this Chapter, shall use the copy of the registered copy of the documents in the files transferred by the International Bureau instead of the international publication document mentioned in these Guidelines.

## 5. 12 Rectification of Errors Made by the International Authority

### 5. 12. 1 Statement on Rectification of Errors Made by the International Authority

Where, in the processing of the international application, as the result of the error of the International Authority, a wrong notification is issued, the wrong record appears in the international publication document, the wrong text is published concerning the international publication, or there is an omission in issuing a notification or an omission in making a record, therefore, after entering the national phase, the examiner has made The decision of“effect of the international application ceases in China”, “rectification”, or “right of priority deemed not to have been made”, etc. , the applicant may request for rectification of errors made by the International Authority within six months from the

date of the issuance of the corresponding notification by the examiner. The request may be submitted in the form of observations.

### 5.12.2 Appendix

At the time of submitting the statement of observation requesting the rectifications of errors made by the International Authority, the applicant shall furnish a copy of the corresponding document showing that the International Bureau has rectified or has agreed to rectify the said errors as the appendix, such as the rectified copy of the international publication document, or the rectified sheet of the *Notification of the Recording of a Change* (PCT/IB/306), the rectified sheet of the *Notification of Election* (PCT/IB/331), etc. The request for rectification without the said appendix shall not be acceptable.

### 5.12.3 Processing after Rectification

Where it is confirmed after examination or contact with the International Bureau that it is indeed an error made by the international authority and has been rectified by the International Bureau, the Patent Office shall acknowledge the rectified conclusion. Where the decision of "effect of the international application ceases in China" has been made out of the errors caused by the International Authority, the Patent Office shall accept again the translation and the fees, and the date on which the formalities for entering the national phase are gone through and in conformity with the requirements under Rules 104.1(1) to (3) for the first time shall be regarded as the date of entering the national phase. Where during the process waiting for the International Authority to rectify the errors, the time limit for going through certain formalities has expired, and the said formalities can not be gone through in time because the errors are not rectified (such as the submission of the request for substantive examination, the submission of the certificate of deposit and the certificate of viability of the biological material sample, the submission of the certifying materials of non-prejudicial disclosure, etc.), the applicant shall, at the time of submitting his observation of requesting the rectifications of errors made by the International Authority, complete the various formalities that have been delayed. The examiner shall consider such formalities being completed within the prescribed time limit.

For other conclusions made out of errors caused by the International Authority and leading to the loss of rights of the applicant, the

corresponding rights shall be restored after the International Bureau notifies that the errors have been rectified.

### 6. National Publication

National publication applies only to the international application for patent for invention which has entered into China. In accordance with the provisions of Rule 114.1, with regard to any international application for a patent for invention, if after the preliminary examination, the Patent Office considers it in compliance with the provisions of the Patent Law and its Implementing Regulations, it shall be published in the Invention Patent Gazette. Where the international application is filed in a language other than Chinese, the Chinese translation of the international application shall be published.

Before entering the national phase, the international publications of most of the international applications have been completed by the International Bureau at the expiration of eighteen months from the date of priority. According to the provisions prescribed in the Treaty, where the language used in the international publication is different from that used for publication in the designated State according to the national law, as far as the protection of right is concerned, the designated State may provide that the publication does not take effect till the translation using the latter language is published according to the national law. It is clearly prescribed in Rule 114.2 that for the international application filed in a language other than Chinese, the right for requiring provisional protection as provided for in Article 13 shall begin after the national publication.

Another purpose of the national publication is to notify the public the information on the entry into the national phase of the application.

### 6.1 Time of Publication

Except for the situations described in Section 3.4 of this Chapter, most international applications enter the national phase after the expiration of eighteen months from the date of priority, and the provisions of Article 34 shall not apply to them. Where, after the preliminary examination to the international application which has entered the national phase, the Patent Office believes that all the requirements are met, the preparatory work for national publication shall begin in time. The time for the Patent Office to complete the preparatory work of the national publication of an international application shall not be earlier than two

months from the date of entering the national phase.

## 6.2 Form of Publication

### 6.2.1 Application of Which International Publication is in a Foreign Language

The national publication shall be in the form of the publication in the Invention Patent Gazette and the pamphlet of the application for Patent for invention.

### 6.2.2 Application of Which International Publication is in Chinese

The national publication shall be in the form of publication in the Invention Patent Gazette. Where, before the international publication of the international application filed in Chinese is completed, the applicant request early processing and early national publication of the international application, the national publication shall be in the form of the publication in the Invention Patent Gazette and the pamphlet of the application for Patent for invention.

## 6.3 Contents of Publication

### 6.3.1 Contents of National Publication in Invention Patent Gazette

The national publication of the international application is an independent part in the Invention Patent Gazette, which is separated from the publication of the national application. The national publication of the international application consists of the bibliographic data, abstract and drawing of the abstract (when necessary). The bibliographic data includes the IPC symbol, application number, publication number, filing date, international application number, international publication number, date of international publication, priority matters, matters of patent agent, matters of applicant, matters of inventor, title of the invention, and nucleotide and/or amino acid sequence listing information published in electronic form, etc.

The index of the Invention Patent Gazette is compiled in the prescribed order in which the published international applications and the published national applications are combined.

### 6.3.2 Contents of the Pamphlet of the Application for Patent for Invention

The contents of the pamphlet of the application for Patent for in-

vention of an international application consists of the front page, the translation of the description and claims, the translation of the abstract, as well as the drawings and the translation of the text matter of the drawings. Where necessary, it shall contain a nucleotide and/or amino acid sequence listing part, the translation of *Indications Relating to Deposited Microorganism or Other Biological Material* (PCT/RO/134) in which the particulars of the deposit of the sample of biological material are recorded, the translation of the claims amended under Article 19 of the Treaty and the translation of the statement concerning the amendment. The translation of the amended claims shall follow the translation of the original ones. The contents on the front page shall be the same as the published contents of the same application in the Invention Patent Gazette which is published at the same time.

## 7. Special Provisions for Payment of Fees

### 7.1 Filing Fee, Printing Fee for Publishing the Application, Additional Fee for Filing Application, and Surcharge for the Late Entry

The filing fee, printing fee for publishing the application, and surcharge for the late entry shall be paid within the time limit prescribed in Rule 103.

After the applicant receives the *Notification of International Application Entering the Chinese National Phase*, relevant fees shall be paid with the national application number. Otherwise, relevant fees may be paid with the international application number.

Where the additional fee for filing the application is not paid or is not paid in full by the applicant at the time of going through the entering formalities, the examiner shall notify the applicant to pay the said fee within the prescribed time limit. Where the fee is not paid or not paid in full at the expiration of the time limit, the application shall be deemed to be withdrawn.

### 7.2 Reduction and Exemption of Fees

#### 7.2.1 Exemption of Filing Fee

The filing fee and the additional fee for filing the application of an international application filed with the Patent Office as receiving Office shall be exempted at the time of entering the national phase.

### 7.2.2 Reduction and Exemption of the Substantive Examination Fee

When an international application enters the national phase and the applicant submits the request for substantive examination, if the international search report and international preliminary report on patentability of the international application are made in China, the substantive examination fee shall be exempted.

When an international application enters the national phase and the applicant submits the request for substantive examination, if the international search report of the international application is made by one of three International Searching Authorities, the European Patent Office, Japanese Patent Office and Swedish Patent Office, the applicant only needs to pay 80% of the substantive examination fee.

Where the request for substantive examination is submitted while the Patent Office does not receive the international search report, the substantive examination fee shall not be reduced and exempted. However, where the applicant submits the international search report accomplished by one of the above-mentioned three International Search Authorities, i. e., the European Patent Office, Japanese Patent Office and Swedish Patent Office, before the Patent Office issues the *Notification of Entering the Substantive Examination Stage of the Application for Invention*, the applicant may request the refund of overpaid fee.

### 7.2.3 Reduction or Postponement of Reexamination Fee and Annual Fee

Rule 100

Where the applicant of an international application has difficulties in paying the re-examination fee and the annual fee, he may submit a request to the Patent Office for a reduction or postponement of the payment in accordance with the measures for the reduction and postponement of patent payment.

### 7.3 Other Special Fees

During the proceedings of the national phase for an international application, in addition to the fees indicated in Chapter 2, Section 1 of Part V of these Guidelines and the surcharge for the late entry indicated in Section 7.1 of this Chapter, there are some kinds of special fees as the following:

(1) handling fee for correction of translation errors (i. e., fee for

correction of translation), which shall be paid at the time of submitting the request for correction of translation errors;

(2) restoration fee for unity, which shall be paid within the time limit prescribed in the *Notification Concerning the Payment of Restoration Fee for the Unity Sent by the Examiner*(see Chapter 2, Section 5.5 of this Part for details of restoration fee for unity); and

(3) where the description contains a nucleotide and/or amino acid sequence listing with more than 400 pages and the applicant only submits the sequence listing in computer-readable form at the time of entering the national phase, the additional fee for the description of the said nucleotide and/or amino acid sequence listing shall be charged as that of 400 pages.

# Chapter 2 Substantive Examination of International Applications Entering the National Phase

## 1. Introduction

Substantive examination of an international application entering the national phase refers to the substantive examination of an international application seeking for patent protection for invention which has entered the national phase in accordance with the Patent Law and its Implementing Regulations. An international application entering the national phase may be an international application which has not gone through the international preliminary examination under Article 22 of the Treaty, or an international application which has gone through the international preliminary examination under Article 39 of the Treaty.

## 2. Principles of Substantive Examination

### 2.1 Basic Principles of Substantive Examination

In accordance with the provisions of Article 27(1) of the Treaty, no national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in the Treaty and its Regulations. It is further stipulated in Article 27(5) of the Treaty that nothing in the Treaty and its Regulations is intended to be construed as prescribing anything that would limit the freedom of each contracting State to prescribe such substantive conditions of patentability as it desires. In particular, any provision in the Treaty and its Regulations concerning the definition of prior art is exclusively for the purposes of the international procedure and, consequently, any contracting State is free to apply, when determining the patentability of an invention claimed in an international application, the criteria of its national law in respect of prior art.

On the basis of the provisions of the Treaty, the examination of the international application which has entered the national phase shall be conducted according to the following principles.

(1) For the form and contents of the application, in principle, the provisions of the Patent Law, its Implementing Regulations and these

Guidelines shall apply. Where there is a difference between the above provisions and the provisions of the Treaty and its Regulations, the latter shall apply.

(2) For substantive requirements for granting of patent right, the provisions of the Patent Law, its Implementing Regulations and these Guidelines shall apply.

### 2.2 Provisions Having Relevance with Substantive Requirements for Grant of Patent Right

"Substantive requirements for grant of patent right" provided for in Section 2.1(2) of this chapter relates to the following provisions of the Patent Law and its Implementing Regulations:

Article 2.2: definition of invention;

Article 5: invention-creation that is contrary to the laws, social morality or that is detrimental to public interest; invention-creation where the acquisition or use of the genetic resources, on which the development of the invention-creation relies, is not consistent with the requirements of the laws and administrative regulations

Article 9.1 and Rule 41: avoidance of double-patenting;

Article 9.2: principle of first-to-file;

Article 20: confidentiality examination;

Article 22: novelty, inventive step and practical applicability;

Article 25.1(1)-(5): subject matters excluded from patentability;

Article 26.3: sufficient disclosure of an invention;

Article 26.4: claims shall be supported by the description and shall define the extent of the patent protection asked for in a clear and concise manner;

Article 26.5, Rules 26 and 109: disclosure of source of genetic resources;

Article 29: the right of priority;

Article 31, Rules 34 and 42: unity;

Article 33 and Rule 43.1: an amendment and a divisional application shall not go beyond the scope described in the initial description and claims;

Rule 20.2: an independent claim shall contain all of the essential technical features of an invention.

## 3. Determination of Text Forming Basis for Substantive Examination

### 3.1 Request of Applicant

At the time of entering the national phase, the applicant of an international application shall indicate, in the written entering statement, the text which he wishes the Patent Office use for examination.

The substantive examination of the international application in the national phase shall be performed, upon the request of the applicant, on the basis of the text indicated in the written entering statement and other texts submitted in a later stage which meet the relevant requirements.

### 3.2 Text Forming Basis for Substantive Examination

The texts used as the basis for substantive examination may include:

(1) where the international publication of an international application is in Chinese, the international application as originally filed; where the international publication of an international application is in a foreign language, the Chinese translation of the international application as originally filed;

(2) where the international publication of an international application is in Chinese, the claims as amended and submitted under Article 19 of the Treaty; where the international publication of an international application is in a foreign language, the Chinese translation of the claims as amended and submitted under Article 19 of the Treaty;

(3) where the international publication of an international application is in Chinese, the claims, description and drawings as amended and submitted under Article 34 of the Treaty; where the international publication of an international application is in a foreign language, the Chinese translation of the claims, description and drawings as amended and submitted under Article 34 of the Treaty;

(4) the text as rectified and submitted under Rule 44 and/or Rule 104;

(5) the text as amended and submitted under Rule 112.2 or Rule 51.1;

The claims, description and drawings as amended and submitted under Articles 28 or 41 of the Treaty is considered as amended and

submitted text under Rule 112. 2 or Rule 51. 1.

The text used as the basis for substantive examination shall be the one indicated in the statement concerning the basis for examination. The statement shall contain indications in the prescribed items of the Written Statement Concerning the Entry into the National Phase (hereinafter called the entering statement) at the time of entering the national phase, and complementary indications in the complementary statement concerning the basis for examination after the international application has entered the national phase. The latter is a complement and a correction to the former.

If the applicant indicates in entering statement that there are elements or parts incorporated by reference in the application documents and the filing date for China has been redetermined in the preliminary examination stage, the elements or parts incorporated by reference shall be considered as part of the application documents originally submitted. The applicant shall not be permitted to retain the elements or parts incorporated by reference by the means of requesting to amend the international application date for China in the process of substantive examination.

Where, the amendments made in the international phase fail to be indicated as the basis for the examination at the time of entering the national phase, or where the Chinese translation of the amendments is not submitted according to the provisions although the indication has been made, it shall not be used as the basis for substantive examination.

Rule 112. 2

Furthermore, after an international application has entered the national phase and at the time when a request for substantive examination is made, or within three months from the receipt of the *Notification of Entering the Substantive Examination Stage of the Application for Invention* issued by the Patent Office, the applicant may amend the application documents according to Rule 51. 1.

For the determination of the text to be used as the basis for the examination, the provisions of Chapter 8, Section 4. 1 of Part II of these Guidelines shall apply. For the examination on above-mentioned amended document or the amended document submitted according to the provisions of Rule 51, the provisions of Chapter 8, Section 5. 2 of Part II of these Guidelines shall apply.

### 3.3 Legal Effect of International Application Documents as Originally Filed

Where the international publication of an international application is in a language other than Chinese, the substantive examination shall be conducted according to its Chinese translation. The examiner, generally speaking, need not check the original. Nevertheless, the international application documents as originally filed shall have legal effect and form the basis for any amendment to the application documents.

For an international application, the original description and claims indicated in Article 33 refer to the claims, description and drawings of the international application as originally filed.

## 4. Search in Substantive Examination

### 4.1 General Principles

Generally, a comprehensive search shall be conducted with an international application entering substantive examination in the national phase. For requirements concerning the search, the provisions of Chapter 7 of Part II of these Guidelines shall apply.

### 4.2 Principle of Practicing Economy

From the principle of practicing economy, the examiner shall take into consideration the information provided in the international search report and the international preliminary report on patentability. However, attention needs to be paid to whether the text which the applicant requests to be used as the basis for substantive examination is consistent with the text used as the basis for the international search report and the international preliminary report on patentability and whether the subject matters for which protection is sought is searched all-roundly in international phase.

If, compared with the text which the applicant requests to be used as the basis for substantive examination, there are amendments to the text which form the basis for the international search report and the international preliminary report on patentability so far as the claimed subject matter is concerned, or the subject matter for which protection is sought is not searched all-roundly in the international phase, instead of just simply using the results of the international search report and the international preliminary report on patentability in the examina-

tion, the examiner shall reconsider the results of the search and conduct supplementary search when necessary.

Where the reference documents listed in the international search report and the reference documents introduced by the international preliminary report on patentability are sufficient to destroy the novelty or inventive step of a patent application, there is no need to conduct further search in respect of the patent application.

It is to be noted that the meanings of certain document categories listed in the international search report are different from the corresponding document categories listed in the search report made in the procedure of substantive examination in the Chinese national phase, e. g. documents of category P and category E. In the international search report, the letter "P" represents documents published prior to the international filing date but later than the priority date as claimed; the letter "E" represents patent documents of which filing date is earlier than the filing date (not priority date) of the international application, and published on or later than the international filing date, and which contents relate to the novelty of the international application. The documents of category E listed in the international search report may change into documents of category PE or E in the search report of national phase.

## 5. Contents of Substantive Examination and Requirements of Examination

This section focuses mainly on the differences between substantive examination of an international application which has entered the national phase and that of a regular national application. For the same points of their substantive examination, references are made to the corresponding sections that are applicable.

### 5.1 Exploitation of International Preliminary Report on Patentability

The international preliminary examination of an international application is to formulate a preliminary and non-binding opinion in accordance with Article 33(1) of the Treaty as to whether the claimed invention appears to be novel, to involve an inventive step(be non-obvious) and to posses practical applicability. Article 33(2)-(4) of the Treaty set specific criteria for requirements of novelty, inventive step and practical applicability. At the same time, Article 33(5) of the Treaty indicates clearly that the criteria provided in Article 33(2)-(4) mere-

ly serve the purpose of international preliminary examination. Any contracting State may apply additional or different criteria in deciding whether or not, in that State, the claimed invention is patentable.

From the principle of economy, for an international application which is accompanied by an international preliminary report on patentability, the examiner shall make reference to the opinions provided in the report. However, attention needs to be paid to whether the text which the applicant requests to be used as the basis for examination is consistent with the text used as the basis for the international preliminary report on patentability. If, compared with the text which the applicant requests to be used as the basis for examination, there are amendments to the text which form the basis for the international preliminary report on patentability so far as the claimed subject matter is concerned, the examiner usually does not need to make reference to the judgment made in the international preliminary report on patentability on whether the invention meets the criteria of novelty, inventive step, practical applicability as well as other requirements for granting of patent right.

It is to be emphasized that the examiner shall not simply take the suggestive opinion provided in the international preliminary report on patentability as the conclusive opinion for the substantive examination in the national phase. He shall pay attention to whether other prior art documents which have not been listed in the international search report are cited in the international preliminary report on patentability.

For the substantive examination of an international application which has entered the national phase, the examiner shall make independent judgment on whether the patent application is in conformity with the substantive requirements of the Patent Law and its Implementing Regulations.

### 5.2 Examination as to Whether an Application Falls into Inventions-creations for Which No Patent Right shall be Granted

At the time of performing the substantive examination on an international application which has entered the national phase, the examiner shall first examine whether the subject matter of the application falls into the scope of Article 5 and Article 25, and whether meets the requirements of Article 2.2. In case where an international application falls into the invention-creations for which no patent right shall be granted as provided for in Article 5 and Article 25 (such as tool for

gambling or method of nuclear transformation), the application shall not be granted the patent right, even if the subject matter does not belong to the contents excluded in Rule 39 of the PCT Regulations.

For requirements of examination on this aspect, the provisions of Chapter 1 of Part II of these Guidelines shall apply.

### 5.3 Examination of Right of Priority

Where the reference documents indicated as category PX or PY have been listed in the international search report, the examiner shall verify the priority right of the international application.

Where the priority right of the international application can not be established, the examiner shall notify the applicant accordingly. In such cases, the reference documents indicated with letters of PX or PY shall be used as the prior art to evaluate the novelty and inventive step of the international application when the examination of novelty and inventive step of the international application is performed.

Where the right of priority can be established, verification shall be conducted to the reference documents indicated with letters PX. Where a reference document indicated with letters PX is a Chinese patent application (or patent) or an international application designating China and its filing date is earlier than the priority date of the international application, the examiner, at the time of performing the examination of novelty, shall estimate whether the reference document constitutes a conflicting application.

Where a reference document indicated as category E is listed in the international search report, and the reference document is a Chinese patent application (or patent) or an international application entering the Chinese national phase, and its filing date is between the filing date and priority date of the international application, the right of priority of such international application shall also be verified. Where the right of priority of the international application cannot be established, at the time of performing the examination of novelty of the international application, the examiner shall estimate whether the reference document constitutes a conflicting application.

Where, after search in the course of substantive examination of an international application entering the national phase, a reference document is found which was published between the priority date and the international filing date of the international application and is prejudicial to its novelty or inventive step, or where a published application or

patent is found which was filed between the priority date and the international filing date of the international application by any entity or individual with the Patent Office and is prejudicial to its novelty, the examiner shall verify the right of priority of the international application.

It shall be noted that, because the Patent Office has made reservation to some provisions of the Treaty and its Regulations, such as, provisions relating to the priority restored in international phase with respect to international application and Incorporation by reference (see Section 5.2.1 and 5.3 of Chapter 1 of this part), it is possible that the priority of the international application acknowledged in international phase is not be accepted after having entered national phase.

### 5.4 Examination of Novelty and Inventive Step

Where there are certain published documents and non-written disclosure which have been listed in the international preliminary report on patentability but are not taken into consideration in the opinion of the international preliminary examination, they shall be considered when novelty and inventive step of the invention are judged in the substantive examination of the international application after the entering of the national phase.

The non-written disclosure listed in international preliminary report on patentability refers to the disclosure to the public by means of oral disclosure, use, exhibition or other non-written means which occurred before the filing date or the valid priority date of the international application, and the date of such no-written disclosure is indicated in the written disclosure which is available to the public on a date which is the same as, or later than, the filing date or the valid priority date of the international application. Such non-written disclosure does not constitute prior art at the phase of international preliminary examination.

The certain published documents listed in the international preliminary report on patentability refer to the application documents or patent documents which were filed before the filing date or the valid priority date of the international application but published on or later than such date, or the published documents of a patent application claiming the priority of an earlier application which was filed before the said date. Such published applications or patents do not constitute prior art at the phase of international preliminary examination.

For the examination of novelty and inventive step of the interna-

tional application after entering the national phase, the provisions of Chapter 3 and Chapter 4 of Part II of these Guidelines shall apply respectively.

### 5.5 Examination of Unity

The examiner shall pay attention to whether, in the application documents submitted and requested to be used as the basis for the examination by the applicant, there are multiple claimed inventions between which unity does not exist.

For multiple inventions lacking unity, the following aspects shall be checked:

(1) whether the multiple inventions lacking unity contain any invention for which an international search or international preliminary examination has not been conducted because the applicant failed to pay the additional search or examination fee upon the request of the examiner;

(2) whether the multiple inventions lacking unity contain any invention which has been abandoned by the applicant due to failure to pay the additional search or examination fee in the international phase (such as an invention abandoned by an applicant in the international phase by restricting certain claims); and

(3) for situations indicated in point (1) or (2), whether the decision of lacking unity made by the International Authority is correct.

Rule 115.2

Where, after examination, it is confirmed that the decision made by the International Authority is correct; the examiner shall issue the *Notification to Pay Restoration Fee for Unity* to notify the applicant to pay the restoration fee for unity within two months. If the applicant fails to pay or pay in full the restoration fee for unity within the prescribed time limit, and fails to delete the invention(s) lacking unity, the examiner shall issue an Office Action to notify the applicant that the invention(s) for which an international search has not been conducted shall be deemed to have been withdrawn, and invite the applicant to submit an amended text after deleting such invention(s). The examiner shall continue the examination based on the text without such invention(s).

As for the invention(s) deleted due to failure to pay the restoration fee for unity by the applicant, according to the provisions of Rule 115.2 and Rule 42.1, the applicant shall not request for divisional application(s). Except for above circumstance, where the international

application contains more than two inventions, the applicant may file a divisional application in accordance with Rule115. 1.

Where, it is held after examination that there is no objection of unity between the claimed subject matters of the application in the text requested by the applicant as the basis for examination, and this conclusion is inconsistent with the decision made by the International Authority, the examination shall be conducted on all the claimed subject matters.

For circumstances where the International Authority has not raised an objection of unity during the search and examination in the international phase, but actually there is a defect of lacking unity in the application, the provisions in Chapter 6 of Part II of these Guidelines shall apply mutatis mutandis.

### 5. 6 Examination to Avoid Double Patenting

Where an international application entering national phase requests the priority of a previous application filed in China or that of a previous international application having already entered the Chinese national phase, double patenting may be caused. In order to avoid double patenting, the provisions in Chapter 3, Section 6 of Part II of these Guidelines shall apply to the examination of the two patent applications.

It shall be noted that, under the above two circumstances, if there appears circumstance that the claim for priority is deemed not to have been made or is not established, the previous application may become the prior art, or conflicting application, which may destroy the novelty of this international application.

Rule 113

### 5. 7 Correction of Translation Errors

Where the applicant finds by himself there are errors in the Chinese translation of the claims, the description or the text matter of the drawings as filed, he may request to correct the errors within the following time limit:

(1) before the completion of technical preparations for publication of an application for a patent for invention by the Patent Office;

(2) within three months from the date of receipt of the *Notification of Entering the Substantive Stage of the Application for Invention* issued by the Patent Office.

Where the applicant intends to correct the translation errors, he

shall file a written request for correction, submit a rectified sheet of the translation and pay the prescribed handling fee for correction of the translation errors. Where the fee is not paid as prescribed, the request for correction shall be deemed not to have been filed. Where the request for correction is filed and the handling fee is paid, the examiner shall determine whether it is a translation error( see Chapter 1, Section 5. 8 of this Part) . If not, the request for correction shall be refused. If it is a translation error, the examiner shall check whether or not the corrected translation is accurate. Where it is confirmed that the corrected translation is accurate, such corrected text shall be used as the basis for the further examination. Where the corrected translation is still inconsistent with the original, the examiner shall notify the applicant to submit the corrected translation in conformity with the original.

Where a divisional application is filed after the international application has entered the national phase, if, in the substantive examination stage, the applicant realizes by himself that the translation errors of the original application result in the translation errors of the divisional application, the applicant may go through the formalities of the correction of the translation errors, and correct the translation errors based on the international application text submitted at the time of filing the patent application. The examiner shall conduct the examination to the corrected translation text in accordance with above-mentioned provisions.

Where the international publication of an international application is in a foreign language, the substantive examination shall be conducted according to its Chinese translation. The examiner, generally speaking, need not check the original. However, where the examiner finds, in the course of substantive examination, that defects due to translation errors do not exist in the international application as originally filed or in the original which has been amended in the international phase, but exist in the translation, he shall indicate the existing defects in the Office Action, for example, the description is not in conformity with the provisions of Article 26. 3, or the claims are not in conformity with the provisions of Article 26. 4, and invite the applicant to clarify or go through the formalities of request for correction of the translation errors. Where the applicant submits the amended text beyond the scope described in the original Chinese translation when replying, but fails to go through the formalities of request for correction of the translation errors, the examiner shall issue the *Notification of Correcting Translation*

*Errors*. Where the applicant fails to go through the formalities of correcting the translation errors within the prescribed time limit, the application shall be deemed withdrawn.

# Part IV

# Examination of Requests for Reexamination and for Invalidation

# Chapter 1 General Provisions

## 1. Introduction

As pursuant to Article 41.1, the State Intellectual Property Office establishes the Patent Reexamination Board.

Rule 59

The Patent Reexamination Board is composed of the Director, Deputy Directors, principal examiners for reexamination, adjunct principal examiners for reexamination, examiners for reexamination, and adjunct examiners for reexamination. The Commissioner of the State Intellectual Property Office shall hold the office of the Director of the Patent Reexamination Board concurrently. The Deputy Directors, principal examiners for reexamination and adjunct principal examiners for reexamination shall be appointed by the Commissioner from experienced technical and legal experts in the Office. The examiners for reexamination and adjunct examiners for reexamination shall be selected by the Commissioner from experienced examiners and legal staff in the Office.

According to Article 41, the Patent Reexamination Board receives requests for reexamination, and performs examination and makes decisions accordingly. Cases of request for reexamination include those made out of dissatisfaction with the decisions of rejection in preliminary examination stage and in substantive examination stage.

According to Article 45 and 46.1, the Patent Reexamination Board receives requests for invalidation of patent right, and performs examination and makes decisions accordingly.

The Patent Reexamination Board may also appear in court where a party concerned according to law institutes a legal proceeding before the court out of dissatisfaction with a decision made by the Board.

## 2. Principles of Examination

The principles commonly applied to the procedure of examination on requests for reexamination (hereinafter the reexamination procedure) and to the procedure of examination on requests for invalidation (hereinafter the invalidation procedure) include principle of legality, principle of fair enforcement of law, principle of examination upon request, principle of conducting examination *ex officio*, principle of hear-

ing, and principle of publicity.

Art. 21. 1

### 2. 1 Principle of Legality

The Patent Reexamination Board shall exercise its administrative competence lawfully. The procedures and decisions of examination on both the cases of request for reexamination (hereinafter reexamination cases) and the cases of request for invalidation (hereinafter invalidation cases) shall be in conformity with the relevant provisions of the laws, regulations and ordinances.

Art. 21. 2

### 2. 2 Principle of Fair Enforcement of Law

The Patent Reexamination Board shall act in line with the principles of objectivity, fairness, appropriateness and timeliness, and base its judgment and decisions on facts and take the law as the criterion. It shall exercise its examination competence independently and impartially, and make just decisions after comprehensive, objective and rational analysis and judgment.

Art. 41. 1 & 45
Rules 64 & 72

### 2. 3 Principle of Examination upon Request

The reexamination procedure and the invalidation procedure shall be initiated at the request of the party concerned.

If the petitioner withdraws his request for reexamination or for invalidation before the Patent Reexamination Board makes a decision concerning the request, the corresponding examination procedure shall be terminated; except for invalidation cases, where based on the examination the Patent Reexamination Board has done, it finds that a decision of invalidating the whole patent or invalidating the patent in part can be made.

If the petitioner withdraws the request after the examination decision has been announced or the decision has been sent out in written form, the effectiveness of the examination decision shall not be affected.

### 2. 4 Principle of Conducting Examinations *Ex Officio*

The Patent Reexamination Board may conduct examination of the cases under examination *ex officio*, rather than confined by the scope, grounds or evidences raised by the parties.

### 2.5 Principle of Hearing

Before an examination decision is made, the party adversely affected by the examination decision shall be given an opportunity to make observations on the grounds, evidence, and the ascertained facts on which the examination decision is based, that is to say, the party adversely affected by the examination decision shall have been informed by means of communication, document exchange, or oral proceeding, of the grounds, evidence, and the ascertained facts on which the examination decision is based, and given the opportunity to make observations.

Where, before an examination decision is made, the patent applicant or patentee has been changed according to an effective judgment made by the People's Court or an effective mediation decision made by the People's Court or a local intellectual property administrative authority, the party concerned after the change shall be given the opportunity to make observations.

Rule 7

### 2.6 Principle of Publicity

For all other cases except those that need to be kept secret according to the laws and State Council regulations (including cases of request for reexamination made out of dissatisfaction with rejections in the preliminary examination stage), oral proceedings shall be public, and the examination decisions shall be published.

## 3. Collegiate Examination

Cases that are collegially examined by the Patent Reexamination Board shall be examined by a panel consisting of three or five members, including a chairman, a first member, and one or three second members respectively.

### 3.1 Composition of a Panel

The Patent Reexamination Board shall determine and change the composition of a panel to examine reexamination or invalidation cases in accordance with prescribed procedure and in the light of division of specialty, amount of cases, and the circumstances regarding the examiners participating in previous examination procedures of the same patent application or patent.

The heads of appealing divisions of the Patent Reexamination

Board and the principal examiners for reexamination are qualified to serve as the chairman of a panel; other members may serve as the chairman subject to the approval of the Director or one of the Deputy Directors of the Board.

Principal examiners for reexamination, examiners for reexamination, adjunct principal examiners for reexamination, and adjunct examiners for reexamination may serve as the first or second member of a panel.

Examiners invited from the examination departments of the Patent Office for specific cases may serve as the second member of the panel.

After a decision is made by the Patent Reexamination Board to uphold a patent right fully or partially, if the same petitioner filed a new request for invalidating the same patent on different grounds or on the basis of different evidence, the first member of the panel that made the previous decision shall not participate in the examination of the new case.

Where an examination decision is overturned by an effective judgment of the People's Court, for examination of the case anew, generally a new panel shall be established.

### 3.2 Provisions on Establishment of a Five-Member Panel

For the following cases, a five-member panel shall be established:

(1) cases of great influence in China or abroad;

(2) cases involving important difficult legal issues;

(3) cases involving great economic interests.

Where the circumstance so requires, a five-member panel may be established by a decision of the Director or one of the Deputy Directors, or on a proposal from the head of the relevant appealing division or a member of the relevant panel which shall be submitted in accordance with the prescribed procedure to the Director or one of the Deputy Directors of the Board for approval.

For cases examined by a five-member panel, if no oral proceedings have been held before the establishment of such a panel, oral proceedings shall be held.

### 3.3 Distribution of Responsibilities among Panel Members

The chairman is responsible for comprehensive examination on the reexamination or invalidation procedure, presides over oral pro-

ceedings, presides over panel meetings and vote casting, and decides on whether to submit the examination decisions of the panel to the Director or one of the Deputy Directors for approval.

The first member is responsible for comprehensive examination of the case and keeping the file, drafting communications and decisions, managing clerical affairs associated with the parties concerned, and preparing patent document to be published when a partial invalidation decision is made.

The second member shall participate in the examination and assist the chairman and the first member.

### 3.4 Formation of the Examination Opinion of a Panel

During the examination of reexamination or invalidation cases, the panel shall cast votes on issues including whether an evidence can be taken, an allegation of facts can be testified, and a ground of action can be accepted, and decide according to the majority.

## 4. Examination by a Single Examiner

Simple cases may be examined by a single examiner.

## 5. Recusal and Non-competition

Rule 37

Where a panel member of a reexamination or invalidation case falls into one of the circumstances as prescribed in Rule 37, the panel member shall recuse himself from the examination. Where the panel member fails to recuse, the party concerned may file a motion to recuse him.

The close relatives of the Director or Deputy Directors should not represent the parties of a reexamination or invalidation case during the tenure of the Director or Deputy Directors. The close relatives of the head of appealing division should not represent the parties of a reexamination or invalidation case that will be examined in the appealing division during the tenure of the head of appealing division. The close relatives referred to above means spouse, parent, child, sibling, grandparent, grandchild and other relatives with maintenance relationship.

The Director or Deputy Directors should not represent the parties of a reexamination or invalidation case within three years since his demission, and other members of the Patent Reexamination Board should not within two years since their demission.

Where the party concerned files a motion to recuse a member of

the panel, or he thinks the attorney appointed fall into the circumstances as prescribed above, he shall raise the recusation in written form and explain the causes therein, and attach relevant evidence if necessary. For any recusation raised by a party concerned, the Patent Reexamination Board shall make a decision in written form and notify the party who raised it.

## 6. Examination Decision

### 6.1 Approval of an Examination Decision

The panel shall take full responsibility for the recognition of facts, the application of laws, the conclusion, and the format and wording of the examination decision document.

For the following cases, the examination decision made by the panel shall be reviewed and subject to approval by the Director or one of the Deputy Directors of the Board:

(1) cases examined by a five-member panel;

(2) cases in which the panel members are divided in their votes; and

(3) cases which are examined anew after the previous examination decision being overturned by an effective judgment of the court.

Where the Director or Deputy Director of the Board in charge of approving the panel decision does not agree with the decision, he may comment and order the panel to conduct a second deliberation. If the panel does not agree with the opinion of the Director or Deputy Director after a second deliberation, and the Director or more than one Deputy Director of the Board considers necessary, an enlarged meeting shall be held which shall include at least two thirds of the members comprising the Director, the Deputy Directors, and the principal examiners for reexamination of the Patent Reexamination Board, and the examination decision shall be made according to the majority of the meeting.

The person in charge of approval on an examination decision shall be responsible for his approval on the application of laws and the conclusion of the examination decision.

### 6.2 Composition of an Examination Decision

An examination decision shall include the following parts:

(1) Bibliographic data of the examination decision

The bibliographic data of the examination decision on a reexamination case shall include the number and the date of the decision, the title of the application appealed, the IPC symbol( or classification code for design), the petitioner for the reexamination, the application number and the filing date of the application appealed, the publication date for invention applications, and the members of the panel.

The bibliographic data of the examination decision on an invalidation case shall include the number and the date of the decision, the title of the patent in dispute, the IPC symbol( or classification code of design), the petitioner for the invalidation, the patentee, the number and the filing date of the patent, the date of announcement of granting the patent, and the members of the panel.

(2) Legal bases

Legal bases of the examination decision mean the relevant provisions of laws or regulations applied as the causes of the examination decision.

(3) Main points of decision

This part is a summary and core statement of the Grounds of Decision in the main text. It is the criteria by which the issues in dispute or the difficult issues of the case are judged. In the main points of the decision, the applied provisions of the Patent Law and its Implementing Regulations shall be further explained and, based on the specific circumstances of the case, instructive conclusions shall be drawn as far as possible.

The main points of decision shall satisfy the following requirements in its form:

(i) the wording shall be simple and concise;

(ii) the statements shall be logical, accurate, well organized, well grounded and consistent with the conclusion of the decision;

(iii) it shall not be a conclusion simply reciting the relevant provisions of the Patent Law and its Implementing Regulations, nor a summary of the cause of action and the conclusion of the decision; key sentences satisfying the above requirements may be extracted from the main text of the decision.

(4) Brief of the case

This part shall describe in time order the following events or facts: the submission of the request for reexamination or invalidation, scope, cause and evidence of the request, acceptance of the request, submission and exchange of documents, the process of examination

and the main disputes. The content of this part shall be objective and true, and consistent with the corresponding records of the case. It shall reflect the course of examination and the main disputes accurately and briefly.

This part shall briefly and concisely outline and summarize the opinions of the parties, clearly and accurately represent the views of the parties, and shall specify all the reasons and evidence of the party to whom the decision is unfavorable.

For reexamination or invalidation cases concerning invention or utility model applications or patents, the decision shall clearly note the contents of the claims to which the decision is related.

(5) Grounds of decision

This part shall explain in detail the applied provisions of laws and regulations and the facts on which the examination decision is based, and elaborate the applicability of the provisions to the case. The elaboration in this part shall be detailed to the extent that on the basis of the provisions and facts it is sufficient to draw the conclusion. Specific analyses shall be made on all the causes, evidence and main opinions raised by the party to whom the conclusion is unfavorable so as to explain why the causes are not tenable and the opinions are not accepted.

For cases involving designs, the main contents of the design concerned shall be described objectively in words if necessary.

(6) Conclusion

This part shall state the examination conclusion of the case specifically, and instructions as to the follow-up remedies including the time limit of initiation and the competent authority of acceptance shall also be clearly and specifically indicated.

(7) Drawings

For cases involving designs, the pictures or photographs of the design shall be attached as the drawings of the decision if necessary.

### 6.3 Publication of an Examination Decision

The whole text of an examination decision made by the Patent Reexamination Board on a request for reexamination or invalidation shall be published unless where the patent application involved was not published. Where an examination decision shall be published but an action has been brought by the party concerned before the court and has been accepted, the examination decision will be published along

with the judgment of the People's Court after the judgment coming into effect.

## 7. Correction and Rejection of a Request

### 7.1 Correction of Decisions on Acceptance

Where a request for reexamination or invalidation was not accepted but should have been accepted, or was accepted but should not have been accepted, correction shall be made subject to the approval of the Director or one of the Deputy Directors, and the party concerned shall be notified accordingly.

### 7.2 Correction of Notifications

Where the Patent Reexamination Board finds that there exists a mistake in any of the various notifications issued by it and the mistake needs to be corrected, correction shall be made subject to the approval of the Director or one of the Deputy Directors, and the party concerned shall be notified accordingly.

### 7.3 Correction of Examination Decisions

Where it is found that there exists any obvious clerical error in an examination decision on requests for reexamination or invalidation and the error needs to be corrected, correction shall be made subject to the approval of the Director or one of the Deputy Directors, and the party concerned shall be notified by a notification attached with the substitution sheets.

### 7.4 Correction of Decisions of Deemed Withdrawal

Where it is found that a request for reexamination or invalidation shall not have been deemed withdrawn, correction shall be made and the corresponding reexamination or invalidation procedure shall be restored subject to the approval of the Director or one of the Deputy Directors, and the party concerned shall be notified accordingly.

### 7.5 Correction of Other Decisions

For all other decisions made by the Patent Reexamination Board, if necessary, correction may be made subject to the approval of the Director or one of the Deputy Directors.

### 7.6 Rejection of a Request

For any reexamination or invalidation case, which has already been accepted, when it is found after examination that the case fails to meet the requirements for acceptance, a decision of rejection of the request for reexamination or invalidation shall be made subject to the approval of the Director or one of the Deputy Directors.

## 8. Examination Procedures after an Examination Decision Being Overturned by an Effective Judgment of the Court

(1) If an examination decision on a request for reexamination or invalidation is overturned by an effective judgment of the People's Court, the Patent Reexamination Board shall make an examination decision anew.

(2) Where the examination decision is overturned for reasons of insufficient evidence or misapplication of laws, the Board shall not make a same decision as the previous one on the same grounds.

(3) Where the examination decision is overturned for reasons of violation of statutory procedures, the Patent Reexamination Board shall make an examination decision anew, with the procedural defects being remedied according to the judgment of the court.

# Chapter 2 Examination of Requests for Reexamination

## 1. Introduction

This Chapter is made pursuant to Article 41 and Rules 60 to 64.

The reexamination procedure is a relief procedure initiated by the applicant who is dissatisfied with the decision of rejection of the application by the Patent Office; meanwhile, it is a continuation of the examination procedure for a patent application. Therefore, on one hand, the Patent Reexamination Board normally restricts its examination to the grounds and evidence on which the decision of rejection is based, and is not obliged to undertake a comprehensive examination on the patent application; on the other hand, the Patent Reexamination Board may conduct examination *ex officio* on other obvious substantive defects than those mentioned in the decision of rejection, so as to improve the quality of the patent granted and avoid unreasonable prolongation of the examination and granting procedure.

## 2. Formal Examination of a Request for Reexamination

After the Patent Reexamination Board receives a request for reexamination, it shall carry out formal examination.

Art. 41.1
Rule 60.2

### 2.1 The Object of a Request for Reexamination

The applicant who is not satisfied with the decision of rejection by the Patent Office may file a request for reexamination with the Patent Reexamination Board. A request for reexamination shall not be accepted if it is not directed to a decision of rejection by the Patent Office.

Art. 41.1
Rule 60.2

### 2.2 Eligibility as a Petitioner for Reexamination

The applicant of a rejected application may file a request for reexamination with the Patent Reexamination Board. Where the person filing a request for reexamination is not the applicant of the rejected application, the request shall not be accepted.

Where a rejected application has two or more applicants and the petitioner for reexamination does not include all the applicants, the Patent Reexamination Board shall notify the petitioner to make rectifica-

tion within a specified time limit. If the defect is not rectified within the time limit, the request for reexamination shall be deemed not to have been made.

Art. 41. 1

### 2. 3 Time Limit

Rule 60. 2

(1) The applicant may file a request for reexamination with the Patent Reexamination Board within three months from the date of receipt of the decision of rejection by the Patent Office. The request for reexamination shall not be accepted if the time of filing the request does not meet this requirement.

(2) Where the time of filing the request for reexamination does not meet the above requirement and the petitioner files a request for restoration of right after the Patent Reexamination Board has made a decision of nonacceptance, if the request for restoration of right is in conformity with the provisions concerning restoration of right as provided in Rules 6 and 99. 1, the right shall be restored and the request for reexamination accepted; otherwise, the right cannot be restored.

(3) Where the time of filing the request for reexamination does not meet the above requirement and the petitioner files a request for restoration of right before the Patent Reexamination Board has made a decision of nonacceptance, the Patent Reexamination Board may handle the two requests together. If the request for restoration of right is in conformity with the provisions concerning restoration of right as provided in Rules 6 and 99. 1, the request for reexamination shall be accepted; otherwise, the request for reexamination shall not be accepted.

### 2. 4 Format of Documents

Rule 60. 1

(1) The petitioner shall submit request for reexamination and explain the causes therein, and attach the relevant evidence if necessary.

Rule 60. 3

(2) Request for reexamination shall comply with the prescribed format. Where the request for reexamination is not in the prescribed format, the Patent Reexamination Board shall notify the petitioner to make rectification within a specified time limit. If, within the time limit, no rectification is made or the defect has not been overcome after two rectifications, the request for reexamination shall be deemed not to have been made.

### 2. 5 Fees

Rules 93 & 94

(1) If the petitioner files the request for reexamination within

three months from the date of receipt of the decision of rejection, but has not paid, or not paid in full, the reexamination fee within the time limit, the request for reexamination shall be deemed not to have been made.

(2) Where a request for restoration of right is filed after the Patent Reexamination Board has made the decision that the request for reexamination is deemed not to have been made, if the request is in conformity with the provisions concerning restoration of right as provided in Rules 6 and 99.1, the right shall be restored and the request for reexamination accepted; otherwise, the right shall not be restored.

(3) Where the reexamination fee is paid in full after three months from the date of receipt of the decision of rejection and the request for restoration of right is filed before the decision of deeming the request for reexamination not to have been filed is made, the Patent Reexamination Board may handle the two requests together. If the request for restoration of right is in conformity with the provisions concerning restoration of right as provided in Rules 6 and 99.1, the request for reexamination shall be accepted; otherwise, the request for reexamination shall be deemed not to have been made.

### 2.6 Formalities Regarding Appointment of Representation

Rule 15.3

(1) As regards the appointment, dissolution or resignation of appointment in the reexamination procedure, formalities shall be settled before the Patent Office according to the provisions of Chapter 1, Section 6.1 of Part I. However, if the petitioner appoints a patent agency in the reexamination procedure and indicates in the power of attorney that the scope of the power entrusted is limited to matters in the reexamination procedure, the formalities concerning the appointment, dissolution or resignation of appointment shall be settled before the Patent Reexamination Board and the above provisions shall apply *mutatis mutandis*, without the need to change the bibliographic data.

Where the petitioner goes through the formalities concerning the appointment of a patent agency before the Patent Reexamination Board and fails to indicate in the power of attorney that the scope of the power entrusted is limited to matters in the reexamination procedure, a rectification shall be made within the specified time limit; otherwise, the appointment shall be deemed not to have been made.

(2) Where the petitioner has appointed more than one patent agency at the same time, he shall designate in written form one of the a-

gencies as the contact person. If no agency is designated, the Patent Reexamination Board will take the agency entrusted first in the reexamination procedure as the contact person; where more than one agency was entrusted first, the Patent Reexamination Board will take the agency in the first name order as the contact person; where there is no name order(separately entrusted on the same day), the Patent Reexamination Board shall notify the petitioner to designate within a specified time limit, and if no designation is made within the time limit, the appointment shall be deemed not to have been made.

Rule 60.2

(3) Where according to Article 19.1 the petitioner shall appoint a patent agency, if he fails to appoint any agency, the request for reexamination shall not be accepted.

### 2.7 Notification on Formal Examination

(1) Where, after formal examination, the request for reexamination is considered not in conformity with the relevant provisions of the Patent Law or its Implementing Regulations or these Guidelines and needs to be rectified, the Patent Reexamination Board shall issue *Notification to Make Rectification*, and invite the petitioner to make rectification within fifteen days from the date of receipt of the notification.

(2) Where the request for reexamination is deemed not to have been made or is not accepted, the Patent Reexamination Board shall respectively issue *Notification that Request for Reexamination Deemed Not to Have Been Made* or *Notification of Nonacceptance of Request for Reexamination* to notify the petitioner.

(3) Where, after formal examination, the request for reexamination is considered in conformity with the relevant provisions of the Patent Law and its Implementing Regulations and these Guidelines, the Patent Reexamination Board shall issue *Notification of Acceptance of Request for Reexamination* to notify the petitioner.

## 3. Interlocutory Examination

### 3.1 Procedure of Interlocutory Examination

According to Rule 62, the Patent Reexamination Board shall transfer the request for reexamination(including any proof document and the amended application document attached thereto) having passed formal examination to the previous examination department which made the decision of rejection for interlocutory examination, together

with the application dossier.

The previous examination department shall provide its opinion on interlocutory examination, and make a *Note of Interlocutory Examination Opinion*. Except in special situations, interlocutory examination shall be completed within one month after receipt of the dossier.

### 3.2 Types of Interlocutory Examination Opinion

There are three types of interlocutory examination opinion:

(1) that the request for reexamination is allowable, and the decision of rejection is agreed to be revoked;

(2) that the amended text of the application submitted by the petitioner has overcome the previous defects, and the decision of rejection is agreed to be revoked on the basis of the amendments; and

(3) that the observations and the amendments submitted by the petitioner are not sufficient to revoke the decision of rejection, and the decision of rejection is maintained.

### 3.3 Interlocutory Examination Opinion

(1) The previous examination department shall specify which of the above types its examination opinion is. Where the examination department maintains the decision of rejection, it shall explain in detail the grounds of rejection maintained and the defects concerned; where the grounds are the same as in the decision of rejection, a brief explanation shall suffice, without the need to repeat the same.

(2) Where the petitioner has made amendments to the application, the previous examination department shall examine following the guidelines of Section 4.2 of this Chapter. If the examination department believes that the amendments conform with the provisions as provided in Section 4.2 of this Chapter, it shall perform interlocutory examination on the basis of the amended document. Otherwise, it shall maintain the decision of rejection and, in addition to the explanation in detail why the amendments are not acceptable, explain the remained defects in the application to which the grounds of rejection are directed.

(3) Where the petitioner presents new evidence or raises new causes, the previous examination department shall examine the evidence or causes.

(4) The previous examination department shall not raise new grounds or evidence for the rejection, except in the following cases:

(i) supplementing the evidence of common knowledge such as those in a technical dictionary, a technical manual, or a text book well known in the skilled art, to support the allegation of common knowledge in the decision of rejection and the interlocutory examination opinion;

(ii) where the previous examination department believes the text of the application being examined has such defects that it is sufficient to reject the application on the basis of the fact, grounds and evidence of which the applicant has been notified, it shall specify the defects in the interlocutory examination opinion; and

(iii) where the previous examination department believes the defects indicated in the decision of rejection still exist and finds the text of the application being examined has other defects which are obvious and substantive or of the same nature with that indicated in the decision of rejection, it may specify them as well.

For example, the previous examination department once indicated in an office action that claim 1 is not in conformity with Article 22.3, but finally rejected the application on the ground that the amendment of the document is not in conformity with Article 33. If the applicant amends the application back to the original text, and the previous examination department believes the defect of noncompliance with Article 22.3 still exists, which falls into the above circumstance(ii), then the previous examination department shall specify the defect in the interlocutory examination opinion.

(5) Where an interlocutory examination opinion falls to be the first or second type as provided in Section 3.2 of this Chapter, the Patent Reexamination Board needs not to conduct collegiate examination. It shall make a reexamination decision according to the interlocutory examination opinion, and notify the petitioner. The previous examination department shall restore the examination procedure consequently. The previous examination department shall not directly restore the examination procedure without the reexamination decision being made by the Patent Reexamination Board.

## 4. Collegiate Examination of Request for Reexamination

### 4.1 Examination of Grounds and Evidence

In the reexamination procedure, the panel normally examines only the grounds and evidence on which the decision of rejection is based.

In addition to the grounds and evidence on which the decision of rejection is based, where the panel finds the text of the application being examined has one of the following defects, it may examine the grounds and evidence related to the defect, and if the panel confirms the existence of the defect after examination, it shall make a decision of upholding the rejection decision on the basis of said grounds and evidence:

(1) the defects for which it is sufficient to reject the application on the basis of other grounds and evidences of which the applicant has been notified before rejection; or

(2) the defects which are not indicated in the decision of rejection but are obvious and substantive or of the same nature with those indicated in the decision of rejection.

For example, where the decision of rejection indicated that claim 1 did not involve an inventive step, and the panel after examination found that the claimed subject matter was obviously a perpetual motion machine, it shall make a reexamination decision of upholding the decision of rejection on the ground that the claim is not in conformity with Article 22.4.

For another example, where the decision of rejection indicated that claim 1 was not clear because of indefinite terms and thus failed to define a clear extent of protection, and the panel found that claim 2 was also not clear for the use of the similar indefinite terms, it shall notify the petitioner of the defect as well in the reexamination procedure; if the response of the petitioner fails to overcome the defect of claim 2, the panel shall make a reexamination decision of upholding the decision of rejection on the ground that claim 2 is not in conformity with Article 26.4.

During the collegiate examination, the panel may introduce common knowledge of the skilled art into the examination, or supplement the evidence by providing common knowledge such as those in a technical dictionary, a technical manual, or a text book.

### 4.2 Examination of the Amendments to an Application

The petitioner may amend the application at the time of submitting the request for reexamination, responding to *Notification of Reexamination* (including *Notification of Oral Proceedings for Request for Reexamination*), or appearing in oral proceedings. Any amendment, however, shall meet the requirements of Article 33 and Rule 60.1.

According to Rule 60. 1, amendments by the petitioner shall be limited only to overcome the defects indicated in the decision of rejection or by the panel. Generally, the above requirement is not considered to be met in the following cases:

(1) where a claim amended extend the extent of protection as compared with the claim rejected in the decision of rejection;

(2) where a claim in the amendment is derived from the technical solution that lacks unity with the claims rejected in the decision of rejection;

(3) where the type of a claim is altered, or the number of claims is increased; or

(4) where the amendments are directed to the claims or the description that were not involved in the decision of rejection, unless they are intended merely to correct obvious clerical errors or to amend the defects of the same nature with that indicated in the decision of rejection.

In reexamination procedure, if the application document submitted by the petitioner is not in conformity with the provision of Rule 61. 1, the panel will generally refuse to accept it; and the panel should explain why the amended document is unacceptable in *Notification of Reexamination* and examine the previous acceptable document. If part of the content of the amended document is in conformity with the provisions of Rule 61. 1, the panel may provide examination opinions on this part, and notify the petitioner that he should amend other part of the text which is not in conformity with the provisions of Rule 61. 1 and submit document which is in conformity with the provisions, otherwise the panel will take the previous acceptable text as the basis of examination.

### 4.3 Manners of Examination

For a request for reexamination, the panel may conduct examination in written form, by oral proceedings, or in both ways.

According to Rule 63. 1, in any of the following circumstances, the panel shall issue *Notification of Reexamination* (including *Notification of Oral Proceedings for Request for Reexamination*) or take oral proceedings:

(1) where the decision of rejection is intended to be upheld;

(2) where the decision of rejection can be revoked on the condition that the petitioner makes amendments to the application document

in accordance with the relevant provisions of the Patent Law, its Implementing Regulations and these Guidelines;

(3) where further evidence or explanation is required to be submitted by the petitioner; or

(4) where new grounds or evidence that have not been provided in the decision of rejection need to be introduced.

Where the panel issues *Notification of Reexamination*, the petitioner shall respond in written form with respect to the defects indicated in the notification within one month from the date of receipt. If the petitioner fails to respond in written form within the time limit, the request for reexamination shall be deemed withdrawn. Any response without concrete contents is regarded as no objections to the examination opinions in *Notification of Reexamination*.

Where the panel issues *Notification of Oral Proceedings for Request for Reexamination*, the petitioner shall appear in the oral proceedings or respond in written form with respect to the defects indicated in the notification within one month from the date of receipt. If the notification has indicated the facts that the application fails to conform with the relevant provisions of the Patent Law and its Implementing Regulations and these Guidelines and has provided the grounds and evidence therefor, and the petitioner neither attended oral proceedings nor made response in written form within the time limit, then the request for reexamination is deemed withdrawn.

## 5. Types of Examination Decisions on Requests for Reexamination

There are three types of examination decisions on requests for reexamination (hereinafter reexamination decisions):

(1) a request for reexamination is not allowed, and the decision of rejection is upheld;

(2) a request for reexamination is allowed, and the decision of rejection is revoked; and

(3) where an application document has been amended and the defects indicated in the decision of rejection has been overcome, the decision of rejection is revoked on the basis of the amended text.

The second type as mentioned above includes the following circumstances:

(i) where the provisions of laws were misapplied in the decision of rejection;

(ii) where the grounds for rejection lacked necessary evidence

support;

(iii) where the process of examination failed to follow the statutory procedures. For example, the decision of rejection was based on an application document that had been abandoned by the applicant or on a technical solution not claimed; the applicant was not given a chance in the process of examination to make observations on the grounds, evidence or affirmed facts adopted in the decision of rejection; or the decision of rejection failed to comment on the evidence submitted by the applicant concerning the grounds of rejection, and thus might affect the impartiality of the examination; and

(iv) any other circumstances where the grounds of rejection are not tenable.

**6. Delivery of Reexamination Decision**

According to Article 41.1, the Patent Reexamination Board shall deliver the reexamination decision to the petitioner.

**7. Binding Force of a Reexamination Decision to the Previous Examination Department**

Where a reexamination decision revokes the decision made by the previous examination department, the Patent Reexamination Board shall remit the relevant dossier to the previous examination department, which shall continue the process of examination.

The previous examination department shall follow the decision of the Patent Reexamination Board, and shall not make a decision contrary to the reexamination decision on the same basis of facts, grounds and evidence.

Rule 88

**8. Suspension of the Reexamination Procedure**

In this regard, Chapter 7, Section 7 of Part V shall apply.

**9. Termination of the Reexamination Procedure**

Rule 63.1

The reexamination procedure is terminated where the request for reexamination is deemed withdrawn for lack of response within the time limit.

Rule 64

The reexamination procedure is terminated where the petitioner has withdrawn the request for reexamination before a reexamination decision is made.

The reexamination procedure is terminated where the request for

reexamination that has been accepted is rejected for inconformity with the requirements of acceptance.

If a petitioner is not satisfied with the reexamination decision, he may institute legal proceedings before the People's Court according to Article 41.2 within three months from the date of receipt of the reexamination decision; where no legal proceedings are instituted within the specified time limit, or the reexamination decision is upheld by an effective judgment of the People's Court, the reexamination procedure is terminated.

# Chapter 3 Examination of Requests for Invalidation

## 1. Introduction

This Chapter is made pursuant to Articles 45, 46, 47 and 59 and Rules 65 to 72.

The invalidation procedure is initiated on the request of the party concerned after the announcement of a patent being granted, and is usually an *inter parte* procedure.

## 2. Principles of Examination

In the invalidation procedure, in addition to the principles of examination provided in the part of General Provisions, the Patent Reexamination Board shall also follow the principle of *res judicata*, the principle of disposal by the party concerned, and the principle of confidentiality.

### 2.1 Principle of *Res Judicata*

Rule 66.2

After an examination decision on a request for invalidation of a patent has been made, any new request for invalidation of the same patent based on the same causes and evidence shall not be accepted or examined.

Where the causes of request for invalidation (hereinafter the invalidation causes) or evidence thereof for the new request have not been considered in the examination decision of the previous request for invalidation due to the reason of time limit etc., the new request shall not be regarded as inadmissible under the above-mentioned circumstance.

### 2.2 Principle of Disposal by the Party Concerned

The petitioner may renounce part or all of the scope, causes and evidence he has raised for the request for invalidation. For the scope, causes or evidence renounced by the petitioner, usually the Patent Reexamination Board will not investigate or examine them any more.

In the invalidation procedure, the party concerned is entitled to compromise with the opposite party at his own wish. In case where both the petitioner and the patentee have expressed to the Patent Reex-

amination Board their willingness to compromise, the Board may give the both parties a certain period of time to negotiate, and temporarily refrain from making an examination decision until requested by either party or the time limit as specified by the Patent Reexamination Board has expired.

In the invalidation procedure, if, in response to the request for invalidation, the patentee narrowed the extent of protection of the patent right on his own initiative and the corresponding amended text was accepted by the Patent Reexamination Board, then it shall be deemed that the patentee admitted a larger extent of protection did not conform to the relevant provisions of the Patent Law and its Implementing Regulations and acknowledged the request for invalidation concerning the claim, and thus the burden of proof on the petitioner for invalidation of said claim is exempted.

In the invalidation procedure, if the patentee renounced by declaration some of the claims or some of the multiple designs, it shall be deemed that the patentee admitted that the claims or designs did not conform to the relevant provisions of the Patent Law and its Implementing Regulations and acknowledged the request for invalidation concerning the claims or designs, and thus the burden of proof on the petitioner for invalidation of said claims or designs is exempted.

### 2.3 Principle of Confidentiality

Before an examination decision is made, any member of the panel without authorization shall neither explicitly nor implicitly reveal to any side of the parties the opinion on the case of himself, of any other Panel member, or of the Director or Deputy Director of the Board responsible for the approval of the case.

In order to ensure impartiality and confidentiality, any member of the panel in principle shall not individually meet with any side of the parties.

## 3. Formal Examination of a Request for Invalidation

After the Patent Reexamination Board receives a request for invalidation, it shall perform formal examination on it.

Art. 45

### 3.1 The Object of a Request for Invalidation

The object of a request for Invalidation shall be the granted patent. It can even be an expired patent or a renounced patent, but not a

patent renounced from the date of application. A request for invalidation shall not be allowable if it is not directed to a patent the grant of which has been announced.

Where, after the Patent Reexamination Board has made an examination decision of partial or whole invalidation of the patent right, the party concerned fails to institute legal proceedings before the People's Court within three months from the receipt of the examination decision, or the examination decision is upheld by an effective judgment of the People's Court, a request for invalidation directed to the patent right which has been invalidated by the examination decision shall not be accepted.

### 3.2 Eligibility as a Petitioner for Invalidation

Where the petitioner falls into one of the following cases, his request for invalidation shall not be accepted:

(1) the petitioner is not eligible to institute a civil action;

Rule 66.3

(2) where a request for invalidating a design patent is submitted on the ground that the design patent is in conflict with a legitimate right of another individual which was acquired prior to the filing date of the patent, the petitioner fails to prove himself the prior right holder or the interested party.

Wherein, the interested party refers to the person who is entitled to file a lawsuit before the People's Court or request the competent administrative authority to handle the matter regarding the dispute over infringement of the prior right in accordance with the relevant legal provisions;

(3) where the patentee files a request for invalidation of his own patent right and requests to invalidate the whole of the patent, the evidence submitted is not a publication, or not all the patentees of the patent have joined in filing the request for invalidation; and

(4) several petitioners jointly submit a request for invalidation, unless all the patentees request to invalidate their common patent right.

### 3.3 Scope, Causes and Evidence of a Request for Invalidation

(1) The scope to be requested for invalidation shall be clearly indicated in a request for invalidation. If not clearly indicated, the Patent Reexamination Board shall inform the petitioner to make a rectification within a specified time limit. If no rectification is made within the time

limit, the request for invalidation shall be deemed not to have been made.

Rules 65.2 & 66.1 (2) The causes for invalidation shall be limited to those prescribed in Rule 65.2 only, and the relevant specific provisions of the Patent Law and its Implementing Regulations shall be indicated as independent causes. A request for invalidation shall not be accepted if the causes for invalidation do not belong to any of those prescribed in Rule 65.2.

Rule 66.2 (3) A request for invalidating a patent shall not be accepted if the causes and evidence are the same as those of a previous request for invalidating the same patent that has been decided by the Patent Reexamination Board, unless the causes or evidence have not been taken into account in the previous decision due to the reason of time limit, etc.

Rule 66.3 (4) For a request for invalidating a patent for design based on the cause that the patent for design is in conflict with a legitimate right of another individual, which was acquired prior to the filing date of the patent, it shall not be accepted if no evidence is submitted to prove such conflict of rights.

Rules 65.1 & 66.1 (5) The petitioner shall explain the causes for invalidation concretely, making reference to all the evidence if applicable. For an invention or utility model patent, if a comparison of technical solutions is required, a specific description shall be given to the relevant technical solutions in the patent concerned and the reference documents, comparative analysis shall be made in that regard. For a design patent, if a comparison is required, a specific description shall be given to the product designs as shown in the drawings or photographs of the patent concerned and the reference documents, comparative analysis shall be made in that regard. For example, where the request for invalidation is based on Article 22.3 and more than one reference document is submitted, the petitioner shall indicate which one is the closest to the patent to be requested for invalidation, state whether the reference documents are used separately or in combination, give a specific description to the technical solutions in the patent concerned and the reference documents, and make comparative analysis. If they are used in combination and there exist two or more possibilities of combination, the specific manner of combination shall be indicated. For different independent claims, the respective closest reference document may be indicated separately.

Where the petitioner fails to explain concretely the causes for in-

validation, or fails to explain with reference to all the evidence or fails to indicate the corresponding evidence for each cause if there is evidence, the request for invalidation shall not be accepted.

Rules 65.1 & 66.4

### 3.4 Format of Documents

The request for invalidation and its attachments shall be made in duplicate and comply with the prescribed formal requirements. Where the request for invalidation is not in the prescribed form, the Patent Reexamination Board shall notify the petitioner to make rectifications within a specified time limit. If no rectification is made within the time limit or the defect is not overcome after two rectifications within the time limit, the request for invalidation shall be deemed not to have been made.

### 3.5 Fees

Rules 93, 94 & 99.3

Where the petitioner fails to pay in full the fee for request for invalidation within one month from the submitting date of the request, the request for invalidation shall be deemed not to have been made.

Rule 15.3

### 3.6 Formalities Regarding Appointment of Representation

(1) Where, during the invalidation procedure, the petitioner or the patentee appoints a patent agency, he must submit the power of attorney for invalidation procedure, and the patentee shall indicate in the power of attorney that the scope of the power entrusted is limited to matters in the invalidation procedure. In invalidation procedure, even if the patentee has appointed an agency for the whole term of the patent and continues to appoint the same one, he must also submit the power of attorney for invalidation procedure.

(2) Where, during the invalidation procedure, the petitioner or the patentee appoints a patent agency, and indicates in the power of attorney that the scope of the power entrusted is limited to matters in the invalidation procedure, the formalities concerning appointment, dissolution and resignation of appointment shall be settled before the Patent Reexamination Board, without the need to change the bibliographic data.

Where the petitioner or the patentee appoints a patent agency and fails to submit the power of attorney to the Patent Reexamination Board or the scope of the power entrusted is not indicated in the power of attorney, or the patentee fails to indicate in the power of attorney

the scope of the power entrusted is limited to matters in the invalidation procedure, the Patent Reexamination Board shall notify the petitioner or the patentee to make rectifications within a specified time limit. If no rectification is made within the time limit, the appointment shall be deemed not to have been made.

(3) Where the petitioner and the patentee have appointed the same patent agency, the Patent Reexamination Board shall notify the both parties to change their appointments within a specified time limit. If no change of appointment is made within the specified time limit, the later appointment shall be deemed not to have been made; if the both appointments were made on the same date, both of them shall be deemed not to have been made.

Rule 66.1

(4) Where the petitioner shall appoint a patent agency according to Article 19.1, but fails to meet this requirement, the request for invalidation shall not be accepted.

(5) Where the petitioner has appointed more than one patent agency at the same time, he shall designate in written form one of the agencies as the contact person. If no agency was designated, the Patent Reexamination Board will take the agency entrusted first in the invalidation procedure as the contact person; where more than one agency was entrusted first, the Patent Reexamination Board will take the agency in the first name order as the contact person; where there was no name order (separately entrusted on the same day), the Patent Reexamination Board shall notify the petitioner to designate within a specified time limit, and if no designation is made within the time limit, the appointment shall be deemed not to have been made.

(6) Where a party intends to appoint a citizen as his representative, the provisions governing the appointment of a patent agency shall apply *mutatis mutandis*. The scope of power for a citizen representative shall be limited to making observations and receiving documents in oral proceedings.

(7) The agent is required to submit a specially authorized power of attorney where:

(i) the agent of the patentee admits the petitioner's request for invalidation;

(ii) the agent of the patentee amends the claims of the patent;

(iii) the agents reach a settlement;

(iv) the agent of the petitioner withdraws the request for invalidation.

(8) For other matters not described in the above, Chapter 1, Section 6.1 of Part I of these Guidelines shall apply *mutatis mutandis*.

### 3.7 Notifications of Formal Examination

(1) Where the request for invalidation is found not in compliance with the provisions of the Patent Law, its Implementing Regulations or these Guidelines after formal examination and needs to be rectified, the Patent Reexamination Board shall issue *Notification to Make Rectification* to invite the petitioner to make a rectification within fifteen days from the date of receipt of the notification.

(2) Where the request for invalidation is deemed not to have been made or is not accepted, the Patent Reexamination Board shall issue *Notification that Request for Invalidation Deemed Not to Have Been Made* or *Notification of Nonacceptance of Request for Invalidation* to notify the petitioner.

Rule 68.1

(3) Where, after the formal examination, it is found that the request for invalidation conforms with the relevant provisions of the Patent Law, its Implementing Regulations and these Guidelines, the Patent Reexamination Board shall issue *Notification of Acceptance of Request for Invalidation* to both the petitioner and the patentee, and transfer copies of the request for invalidation and the relevant documents to the patentee and invite him to make response within one month from the date of receipt of the notification. Where the patentee has appointed an agency for the whole term of the patent, copies of the request and the relevant documents shall be transferred to said agency.

(4) Where the accepted request for invalidation has to wait for an earlier examination decision on request for invalidation declaring a patent right invalid in whole or in part to come into effect and thus cannot be examined for the time being, the Board shall issue a notification to notify the petitioner and the patentee; after the earlier examination decision has come into effect or is overturned by an effective judgment of the People's Court, the Board shall restore the examination timely.

(5) Where the accepted request for invalidation is involved in a patent infringement case, the Patent Reexamination Board may, at the request of the People's Court or a local intellectual property administrative authority or the party concerned, issue *Notification of Examination Status of Request for Invalidation* to the People's Court or the local intellectual property administrative authority which is handling the patent infringement case.

## 4. Collegiate Examination of Request for Invalidation

### 4.1 Scope of Collegiate Examination

In the invalidation procedure, the Patent Reexamination Board usually performs examination pursuant to the scope requested by the petitioner and only on the causes and evidence submitted by the parties concerned, and bears no obligation of a comprehensive examination on the validity of the patent.

Where the Patent Reexamination Board has made an examination decision of partial invalidation of a patent right, and the party concerned does not institute legal proceedings before the People's Court within three months from the receipt of the decision or the examination decision is upheld by an effective judgment of the People's Court, the examination on other requests for invalidation concerning the same patent right shall be directed to the claims maintained.

Rules 65.1 & 67

For causes which are not explained concretely or evidence which is not used to support any cause at the time of submission of the request for invalidation by the petitioner, if no further explanation is provided within one month from the date of filing the request, the Patent Reexamination Board will not take them into account.

For causes for invalidation the addition of which is not in conformity with the provisions of Section 4.2 of this Chapter or evidence by the petitioner the supplement of which is not in conformity with the provisions of Section 4.3 of this Chapter, or evidence by the patentee the submission or supplement of which is not in conformity with the provisions of Section 4.3 of this Chapter, the Patent Reexamination Board will not take them into account.

The Patent Reexamination Board may conduct examination *ex officio* in the following circumstances:

(1) where the causes raised by the petitioner are obviously inappropriate to the evidence submitted, the Patent Reexamination Board may inform the petitioner of the meanings of the relevant provisions, and allow him to change or change *ex officio* the causes to suitable ones. For example, where the evidence submitted by a petitioner is a patent for invention previously filed by the same patentee with the Patent Office and later published after the filing date of the patent in dispute, but the cause for invalidation is inconformity with Article 9.1, the Patent Reexamination Board may explain the meanings of Article 9.1

and Article 22. 2 and allow the petitioner to change the cause to inconformity with Article 22. 2, or *ex officio* change the cause to inconformity with Article 22. 2;

Art. 2, 5 & 25

(2) where a patent is found to have the defect that obviously falls within the subject matters excluded from patent protection and the defect is not indicated by the petitioner, the Board may introduce a corresponding cause into the invalidation, and perform examination in that regard;

(3) where a patent is found to have such a defect not indicated by the petitioner as to inhibit further examination on the causes raised by the petitioner, the Patent Reexamination Board may introduce *ex officio* a corresponding cause to the defect into the causes for invalidation, and perform examination on the cause. For example, where the cause for invalidation is that the independent claim 1 does not involve an inventive step, if the claim is not clear and the extent of protection can not be clearly defined, so that there is no base to examine the inventive step of the claim, the Patent Reexamination Board may introduce Article 26. 4 into the causes for invalidation and perform examination *ex officio*;

(4) where the petitioner requests for invalidating some of the claims which have reference relationship among them, does not request for invalidating the other claims on the same ground, and the examination conclusion will be unreasonable if the Board dose not introduce such cause, the Board may *ex officio* introduce such cause and perform examination on the other claims in that regard. For example, where the petitioner requests for invalidating a patent on the ground that claim 1 possesses no novelty and dependent claim 2 possesses no inventive step, if the Board finds that claim 1 possesses novelty, and claim 2 possesses no inventive step, it may examine the inventive step of claim 1 *ex officio*;

(5) where the petitioner requests for invalidating some of the claims which have reference relationship among them on the ground that they have some defect, and does not indicate that the other claims have defect of the same nature, the Board may introduce a corresponding cause to the defect into the invalidation and examine the other claims in that regard. For example, the petitioner requests for invalidating claim 1 on the ground that a technical feature has been added to it, therefore it is not in conformity with Article 33, while he does not indicate dependent claim 2 has the same defect, the Board may intro-

duce the cause for invalidation concerning Article 33 to examine dependant claim 2 *ex officio*;

(6) where the petitioner requests for invalidating a patent on the ground that it is not in conformity with Article 33 or Rule 43. 1 and makes a specific analysis and description of the fact that the amendment goes beyond the scope of the original disclosure, but fails to submit the original application document, the Board may introduce the original application document of the patent as the evidence; and

(7) the Patent Reexamination Board may determine *ex officio* whether a technical means belongs to common knowledge of the art, and may introduce such common knowledge evidence as those in a technical dictionary, technical manual, or textbook into the examination *ex officio*.

Rule 67

### 4.2 Addition of Causes for Invalidation

(1) Where the petitioner raises additional causes for invalidation within one month from the date of submitting the request, he shall explain the causes concretely within this period; otherwise the Patent Reexamination Board will not take them into account.

(2) Where the petitioner raises additional causes for invalidation after one month from the date of submitting the request, generally the Patent Reexamination Board will not take them into account, unless in any of the following circumstances:

(i) for claims amended by way of combination by the patentee, addition of causes for invalidation is made within the time limit specified by the Patent Reexamination Board, and the added causes are explained concretely within the time limit; or

(ii) the addition is to change the causes for invalidation which are obviously inappropriate to the evidence submitted.

### 4.3 The Time Limit for Presenting Evidence

#### 4.3.1 Presenting Evidence by the Petitioner

(1) Where the petitioner presents additional evidence within one month from the date of filing the request for invalidation, he shall explain concretely the relevant causes for invalidation with reference to the additional evidence within this period; otherwise the Patent Reexamination Board will not take it into account.

(2) Where the petitioner presents additional evidence after one

month from the date of filing the request for invalidation, generally the Patent Reexamination Board will not take it into account, unless in any of the following cases:

( i) concerning claims amended by way of combination or counter-evidence presented by the patentee, the petitioner presents additional evidence within the time limit specified by the Patent Reexamination Board, and explain the relevant causes concretely with reference to the additional evidence within this period;

( ii) by the closure of oral proceedings, the petitioner presents such evidence of common knowledge in the skilled art as those in a technical dictionary, technical manual, or textbook, or such complementary evidence for meeting the legal requirement for evidence as a notarial document or the original, and explain the relevant causes concretely with reference to the additional evidence within the period; or

(3) where the petitioner presents evidence in a foreign language, the time limit for submitting the Chinese translation thereof is the same as that for presenting the evidence.

### 4.3.2 Presenting Evidence by the Patentee

The patentee shall present evidence within the time limit for response as specified by the Patent Reexamination Board, but he may present, by the closure of oral proceedings, such evidence of common knowledge in the skilled art as those in a technical dictionary, technical manual, or textbook or such complementary evidence used for meeting the legal requirement for evidence as a notarial document or the original.

Where the patentee presents or adds evidence, he shall explain concretely the evidence within the above time limit.

Where the patentee presents evidence in a foreign language, the time limit for submitting the Chinese translation thereof is the same as that for presenting the evidence.

Where the patentee does not present or add evidence within the above time limit, or he fails to explain concretely the evidence within the above time limit, the Patent Reexamination Board will not take it into account.

### 4.3.3 Presenting Evidence in Extension Period

Where either of the parties has evidence to prove that his failure to present evidence within the time limit as specified in Section 4.3.1

or 4.3.2 of this Chapter was due to *force majeure*, he may, within the specified time limit, request in written form the extension of the time limit. If refusal of the request will result in obvious inequity, the Patent Reexamination Board shall allow the extension of the time limit.

### 4.4 Manners of Examination

#### 4.4.1 Transfer of Documents

Rule 68

The Patent Reexamination Board shall, if need be, transfer the relevant documents to the parties concerned. Where it is necessary to prescribe a time limit for submitting the response, the time limit shall be one month. If the party fails to make a response within the time limit, said party shall be deemed to have been aware of the facts, causes, and evidence contained in the transferred documents and does not raise any objection.

Any observations and the attachments submitted by the parties concerned shall be made in duplicate.

Rule 70

#### 4.4.2 Oral Proceedings

The Patent Reexamination Board may, at the request of the parties concerned or in accordance with the needs of the case, decide to take oral proceedings for a request for invalidation. For specific provisions concerning oral proceedings, see Chapter 4 of this Part.

#### 4.4.3 Notification of Examination on Request for Invalidation

In the invalidation procedure, the Patent Reexamination Board may issue *Notification of Examination on Request for Invalidation* to both parties concerned in any of the following circumstances:

(1) where the facts alleged or evidence presented by the parties concerned are unclear or doubtful;

(2) where the patentee has amended his claims on his own initiative, but the amendment is not in conformity with the relevant provisions of the Patent Law, its Implementing Regulations or these Guidelines;

(3) where the Patent Reexamination Board needs to introduce *ex officio* causes or evidence not mentioned by the party concerned; or

(4) any other circumstance under which the issuance of *Notification of Examination on Request for Invalidation* is necessary.

For the party to which the notification of examination is directed,

it shall respond within one month from the date of receiving the notification. If no response is made within the time limit, the party shall be deemed to have been aware of the facts, causes and evidence contained in the notification and does not raise any objection.

Rules 68 & 70

**4.4.4 Selection of Manners of Examination**

In the invalidation procedure, the examination shall be performed in any of the following manners depending on the circumstances.

(1) If the Patent Reexamination Board has transferred the documents of the request for invalidation to the patentee, then, at the expiration of the specified time limit for making a response, no matter whether the patentee has made a response or not, so long as no oral proceedings is requested by him, and the Patent Reexamination Board considers that the evidence submitted by the petitioner is sufficient, and the causes for invalidating the whole patent are tenable, it may directly make an examination decision of invalidating the whole patent; if the petitioner requests to invalidate the patent only in part, the Patent Reexamination Board may also directly make an examination decision of invalidating the patent in the same part. If the patentee has submitted a response, the response may be transferred to the petitioner along with the examination decision so directly made.

(2) If the Patent Reexamination Board has transferred the documents of the request for invalidation to the patentee, then, at the expiration of the specified time limit for making a response, no matter whether the patentee has made a response or not, so long as the Patent Reexamination Board finds, upon consideration, the scope as requested for invalidation by the petitioner is tenable in part, and possibly a decision of invalidating the patent in part is to be made, the Patent Reexamination Board shall issue *Notification of Oral Proceedings* and conclude the case through oral proceedings. If the patentee has submitted a response, the response shall be transferred to the petitioner along with *Notification of Oral Proceedings*.

(3) If the Patent Reexamination Board has transferred the documents of the request for invalidation to the patentee, and the patentee has made a response within the time limit, then, so long as the Patent Reexamination Board considers that the causes in the response are well founded, and a decision of upholding the patent is to be made, the Patent Reexamination Board shall, depending on the specific circumstance of the case, choose to issue either *Notification of Transfer of Doc-*

uments or *Notification of Examination on Request for Invalidation* to perform the examination in written form; or issue *Notification of Oral Proceedings* along with *Notification of Transfer of Documents* to conclude the case through oral proceedings.

(4) If the Patent Reexamination Board has transferred the documents of the request for invalidation to the patentee and the patentee failed to respond within the specified time limit, so long as the Patent Reexamination Board considers that the evidence submitted by the petitioner is insufficient and that the causes for invalidating the patent are not tenable, and a decision of upholding the patent is to be made, the Patent Reexamination Board shall, depending on the specific circumstance of the case, choose to either issue *Notification of Examination on Request for Invalidation* to perform the examination in written form, or issue *Notification of Oral Proceedings* to conclude the case through oral proceedings.

If, after the issuance of *Notification of Oral Proceedings*, the oral proceeding is not taken on schedule due to reasons on the part of the parties concerned, the Patent Reexamination Board may directly make an examination decision.

### 4.5 Combined Examination of Cases

In order to increase the efficiency of examination and lighten the burden of the parties concerned, the Patent Reexamination Board may hear cases in combination. The circumstances for combined examination include the following:

(1) where more than one case of request for invalidation is directed to the same patent, the Patent Reexamination Board shall as far as possible take the oral proceedings in combination; and

(2) for cases of request for invalidation directed to different patents, where part or all of the parties concerned are the same and the facts of the cases relate to each other, the Patent Reexamination Board may, at the request in written form of the party concerned or at its own initiative, take the oral proceedings in combination.

The evidence in different cases of invalidation heard in combination cannot be used in a combinative way.

Rule 69

## 4.6 Amendment to Patent Documents in the Invalidation Procedure

### 4.6.1 Principles of Amendment

Any amendment to the patent documents of a patent for invention or utility model shall be limited to the claims only, and shall follow the following principles:

(1) the title of the subject matter of a claim can not be changed;

(2) the extent of protection can not be extended as compared with that in the granted patent;

(3) the amendment shall not go beyond the scope of disclosure contained in the initial description and claims; and

(4) addition of technical features not included in the claims as granted is generally not allowed.

The patent document of a design patent cannot be amended.

### 4.6.2 Manners of Amendment

Subject to the above principles of amendments, the specific manners of amendment are generally limited to deletion of a claim, combination of claims, and deletion of a technical solution.

Deletion of a claim means one (or more) claim, such as an independent claim or a dependent claim, is removed from the claims.

Combination of claims means that two or more claims dependent on a same independent claim and having no relation of dependency are combined together. Under this circumstance, all the technical features of the combined dependent claims constitute a new claim. The new claim shall contain all the technical features of each of the dependent claims thus combined. The dependent claims subordinated to a same independent claim shall not be combined together unless the independent claim is amended.

Deletion of a technical solution means to remove one or more technical solutions from several parallel technical solutions defined in the same claim.

### 4.6.3 Restrictions to Manners of Amendment

Before the Patent Reexamination Board makes a decision on the request for invalidation, the patentee may either delete a claim or delete a technical solution contained in a claim.

The patentee may amend the claims by the way of combination within the time limit for response only in one of the following circumstances:

(1) in response to the request for invalidation;

(2) in response to causes for invalidation or evidence added by the petitioner;

(3) in response to causes for invalidation or evidence not mentioned by the petitioner but introduced by the Patent Reexamination Board.

Rule 88

**4.7 Suspension of the Invalidation Procedure**

In this regard, Chapter 7, Section 7 of Part V shall apply.

**5. Types of Examination Decisions on Request for Invalidation**

There are three types of examination decisions for a request for invalidation, which are:

(1) declaring a patent right invalid in whole;

(2) declaring a patent right invalid in part; and

(3) maintaining the validity of a patent right.

Declaring a patent right invalid includes the situations of declaring a patent right invalid in whole and declaring a patent right invalid in part. According to Article 47, any patent right which has been declared invalid shall be deemed to be non-existent from the date of filing.

In the invalidation procedure, where the causes for invalidation directed to some of the claims of an invention or utility model patent are tenable and the causes for invalidation directed to other claims (including the claims after amendment by way of combination) are untenable, the decision for the request for invalidation shall declare invalid those claims to which the causes for invalidation are tenable and maintain the validity of the other claims. For a design patent having designs of several products of independent use, where the causes for invalidation directed to some of the product designs are tenable and the causes directed to other product designs are untenable, the decision for the request for invalidation shall declare invalid those product designs to which the causes for invalidation are tenable and maintain the validity of the other product designs. For example, for a design patent which has two or more similar designs of the same product, if some causes for invalidation concerning some of the designs are tenable and the

causes concerning the other designs are untenable, the decision on request for invalidation shall declare invalid those designs to which the causes for invalidation are tenable and maintain the validity of the other designs. Both of the above decisions are examination decisions of the type declaring a patent right invalid in part.

Where a patent right is declared invalid in part, the part of the patent right so invalidated shall be deemed non-existent from the date of filing, and the part of the patent right that are maintained valid (including the amended claims) shall be deemed existent from the date of filing at the same time.

## 6. Delivery, Registration and Announcement of Examination Decision on Request for Invalidation

### 6.1 Delivery of Decision

According to Article 46.1, the Patent Reexamination Board shall deliver the examination decision on the request for invalidation to the both parties.

For a request for invalidation that involves an infringement dispute, where the relevant People's Court or local intellectual property administrative authority had been notified before the initiation of the examination on the request for invalidation, the Patent Reexamination Board shall, after making the decision, deliver the examination decision and *Notification of Termination of Examination on Request for Invalidation* to the People's Court or local intellectual property administrative authority.

### 6.2 Registration and Announcement of Decision

According to Article 46.1, after the Patent Reexamination Board has made an examination decision of declaring the patent right invalid (in whole or in part), if the party concerned does not institute legal proceedings before the people's court within three months from receipt of the decision, or the decision is upheld by an effective judgment of the People's Court, the examination decision shall be registered and announced by the Patent Office.

## 7. Termination of the Invalidation Procedure

Rule 72

Where the petitioner withdraws his request for invalidation before the Patent Reexamination Board makes an examination decision on it,

the invalidation procedure terminates, unless, based on the examination it has done, the Patent Reexamination Board finds that a decision invalidating the patent right in whole or in part can be made.

Rules 70.3 & 72.2

Where the petitioner fails to make a response to *Notification of Oral Proceedings* within the specified time limit and fails to appear in the oral proceedings so that the request for invalidation is deemed withdrawn, the invalidation procedure terminates, unless, based on the examination it has done, the Patent Reexamination Board finds that a decision invalidating the patent right in whole or in part can be made.

Where a request for invalidation, which has been accepted is found to be inconformity with the requirements for acceptance and is thus rejected, the invalidation procedure terminates.

After the Patent Reexamination Board has made a decision of examination, the party concerned does not institute legal proceedings before the people's court within three months from receipt of the decision, or the decision is upheld by an effective judgment of the People's Court, the invalidation procedure terminates.

After the Patent Reexamination Board has made an examination decision of declaring a patent right invalid in whole, the party concerned does not institute legal proceedings before the people's court within three months from receipt of the decision, or the decision is upheld by an effective judgment of the People's Court, the invalidation procedures in all other cases concerning the same patent right shall terminate.

# Chapter 4 Provisions Concerning Oral Proceedings in the Reexamination and Invalidation Procedures

## 1. Introduction

The procedure of oral proceedings is a formal administrative hearing procedure provided pursuant to Rules 63 and 70, the aim of which is to ascertain the facts through investigation and provide the parties concerned with opportunity to make observations before the panel.

Rule 70.1

## 2. Determination of Oral Proceedings

In the invalidation procedure, the party concerned may request for oral proceedings and explain the reasons therefor to the Patent Reexamination Board. The request shall be submitted in written from.

The parties concerned in the invalidation procedure may request for oral proceedings based on any of the following reasons:

(1) one of the parties requests for face-to-face cross-examination of evidence and debate with the opposite party;

(2) there is a need to explain the facts to the panel;

(3) there is a need to demonstrate a material object; or

(4) there is a need to call a witness giving evidential statement in testimony.

For cases of request for invalidation for which no oral proceedings has been taken, where the Patent Reexamination Board receives a request from the party concerned for oral proceedings in written form based on one of the reasons mentioned above, the panel shall decide to take oral proceedings.

In the reexamination procedure, the petitioner for reexamination may request for oral proceedings and explain the reasons therefor to the Patent Reexamination Board. The request shall be submitted in written form.

The petitioner for reexamination may request for oral proceedings based on any of the following reasons:

(1) there is a need to explain the facts or causes to the panel; or

(2) there is a need to demonstrate a material object.

Where the petitioner for reexamination requests for oral proceedings, the panel shall decide whether to take oral proceedings in accord-

ance with the needs of the case.

In the invalidation or reexamination procedure, the panel may decide on its own initiative whether to take oral proceedings in accordance with the needs of the case. For the same case where oral proceedings have been taken, if necessary, oral proceedings may be taken once again.

Subject to the approval of the Director or Deputy Director, the Patent Reexamination Board may take itinerant oral proceedings and handle cases on the spot. All necessary expenses shall be borne by the Board.

**3. Notification of Oral Proceedings**

Rules 70.2, 70.3 & 72.2

In the invalidation procedure, after the determination of taking oral proceedings, the panel shall issue *Notification of Oral Proceedings* to the parties concerned, informing them of the date, place and other matters of the oral proceedings to be taken. Normally the date and place of oral proceedings shall not be changed once they are fixed. Where it is necessary to change the date or place in a special situation, the change shall be subject to agreements by the both parties or the approval by the Director or Deputy Director of the Board. The parties shall submit the acknowledgment of receipt of the notification to the Board within seven days from the date of receipt. Where the petitioner for invalidation fails to submit the acknowledgment of receipt within the specified time limit and fails to appear in the oral proceedings, the request for invalidation shall be deemed withdrawn, and the invalidation procedure terminates. Unless, based on the examination it has done, the Patent Reexamination Board finds that a decision declaring the patent right invalid in whole or in part can be made. Where the patentee does not appear in the oral proceedings, the proceedings may be taken by default.

Rule 63.1

In the reexamination procedure, after the determination of taking oral proceedings, the panel shall issue *Notification of Oral Proceedings* to the petitioner for reexamination, informing him of the date and place of and matters to be investigated in the oral proceedings to be taken. Where the panel considers the patent application is not in conformity with the relevant provisions of the Patent Law and its Implementing Regulations, it shall notify the petitioner for reexamination of the specific facts, grounds and evidence thereof along with *Notification of Oral Proceedings*.

The panel shall notify the petitioner for reexamination that he may choose either to attend the oral proceedings to make oral observations or to make observations in written from within the specified time limit. The petitioner for reexamination shall submit the acknowledgment of receipt of the notification to the Board within seven days from the date of receipt, and indicate definitely whether he will attend the oral proceedings. Failure to submit the acknowledgment of receipt within the specified time limit is deemed not intending to attend the oral proceedings.

Where the specific facts, grounds and evidence for which the patent application is not in conformity with the relevant provisions of the Patent Law or its Implementing Regulations have been indicated in *Notification of Oral Proceedings*, if the petitioner for reexamination neither appears in the oral proceedings nor makes observations in written form within the specified time limit, the request for reexamination shall be deemed withdrawn.

The acknowledgement of receipt of *Notification of Oral Proceedings* in the invalidation or reexamination procedure shall be signed or sealed by the party concerned. Where the party concerned expresses its intention to appear in the oral proceedings, names of the persons to appear in the oral proceedings shall be clearly indicated. Where the party concerned intends to call a witness having given evidential statement in testimony before the panel, it shall so indicate in the acknowledgement of receipt of *Notification of Oral Proceedings*, and provide the name and affiliation (or occupation) of the witness and the facts to be testified.

For each party concerned, the number of persons including its agent appear in the oral proceedings shall not exceed four. Where in the acknowledgement of receipt the indicated number of persons to appear in the oral proceedings is less than four, others may be designated to appear in the oral proceedings before the proceedings start. Where a party has more than one person to appear in the oral proceedings, it shall designate one of them as the first speaker to address primarily.

Where a person concerned cannot appear in the oral proceedings on the fixed date, he may appoint his patent agent or any other person to appear on his behalf.

Where a party concerned has appointed a patent agency according to Article 19, the patent agency shall designate its patent agents to appear in the oral proceedings.

## 4. Preparation Before Oral Proceedings

Before oral proceedings start, the following work shall be done by the panel:

(1) transferring in the invalidation procedure the relevant documents submitted by a party to the opposite party;

(2) reading and studying the files, understanding the details of the case, and identifying the key points in dispute and the main issues to be investigated and debated;

(3) holding a panel meeting prior to the oral proceedings to decide on the distribution of duties of the panel members in the oral proceedings, the order and contents of the investigation, main issues to be ascertained, and various circumstances likely to occur during the oral proceedings and the corresponding handling;

(4) preparing necessary documents;

(5) announcing the relevant information of taking the oral proceedings two days before the oral proceedings (unless the oral proceedings are not taken in public); and

(6) preparations concerning other administrative matters for the oral proceedings.

## 5. Taking of Oral Proceedings

Oral proceedings shall be taken on the scheduled date.

Oral proceedings shall be taken in public, unless they need to be kept confidential in accordance with the provisions of the laws or regulations.

### 5.1 The First Stage of Oral Proceedings

Before oral proceedings start, the panel shall check the identities of the persons appear in the oral proceedings and make sure they are eligible to appear.

Oral proceedings shall be presided over by the chairman. The chairman opens the oral proceedings, and introduces the panel members; the party concerned introduces the persons appear in the oral proceedings on its part and, where two parties appear, the opposite party shall be consulted for any objection to the eligibility of the persons appearing on either part; the chairman announces the rights and obligations of the parties concerned, inquires whether the party concerned would file a motion to recuse the panel members, and whether the party

concerned requests to call a witness in testimony or to make a demonstration of material evidence.

In *inter parte* oral proceedings, the parties concerned shall be inquired as to whether they are willing to make compromise. If both parties have the willingness and intend to compromise before the panel, the oral proceedings shall halt. Where there is little difference in expectations of the two parties, the oral proceedings may be suspended; where there is great difference in their expectations and it is difficult for them to reach a compromise in a short period of time, or where any of the parties has no willingness to compromise, the oral proceedings shall continue.

### 5.2 The Second Stage of Oral Proceedings

Before starting the investigation in oral proceedings, if necessary, the facts of the case may be briefed by a panel member. The investigation starts thereafter.

In oral proceedings of the invalidation procedure, first the petitioner for invalidation states the scope to be requested for invalidation and the causes therefor, and briefly describes the relevant facts and evidence. Then, the patentee makes a response. After that, the panel checks the scope and the causes for invalidation and the evidence submitted by both parties, and determines the scope of oral proceedings. Where a party raises new causes or presents new evidence in oral proceedings, the panel shall determine whether the causes or evidence are to be considered in accordance with the relevant provisions. If they are decided to be considered, the opposite party shall have the options to make an oral response before the panel or in written form afterwards as it is the first time for him to become aware of the causes or evidence. Then, the petitioner for invalidation shall adduce evidence for the causes for invalidation. Next, the patentee may examine the evidence and, if need be, raise counterevidence followed by examination by the opposite party. Where in a case there are many causes for invalidation, facts or evidence to be affirmed, the panel may require the parties to adduce and examine evidence regarding the causes for invalidation and the alleged facts one by one.

In oral proceedings of the reexamination procedure, after the panel has told the petitioner the main issues to be investigated, the petitioner for reexamination may make submissions. Where the petitioner for reexamination makes amendments to the application document be-

fore the panel, the panel shall examine whether the amendments are in conformity with the relevant provisions of the Patent Law, its Implementing Regulations and these Guidelines.

In oral proceedings, in order to identify comprehensively and objectively the facts, the panel may question the parties or witnesses about the relevant facts and evidence, and may also require the parties or witnesses to make explanations. Questioning shall be impartial, objective, specific and clear.

### 5.3 The Third Stage of Oral Proceedings

In oral proceedings of the invalidation procedure, following investigation is the proceeding of debate. If both parties have no dispute about the evidence and facts of the case, then the proceeding of debate may be taken directly on the basis of the evidence and facts recognized by both parties. The parties may respectively make observations and debate on the matters in dispute and the application of laws and regulations to the facts as shown by the evidence. During the debate, the panel members may raise questions, but shall neither make any tendentious statement nor argue with any of the parties. If in the course of debate any party raises a fact or evidence previously submitted but not examined, the chairman may halt the proceeding of debate and restore the proceeding of investigation. The debate shall continue after the completion of investigation.

After the parties have completely submitted their observations, the chairman announces the end of the debate, and invites the parties to make their final statements. In making the final statements, the petitioner for invalidation may insist on his request for invalidation or withdraw the request. He may also renounce part of the causes for invalidation and the corresponding evidence, or narrow the scope to be requested for invalidation. The patentee may insist on his demand for rejecting the request for invalidation, or declare to narrow down the scope of patent protection or renounce part of the claims. Thereafter, the two parties may try to compromise again as they did at the start of the procedure.

In oral proceedings of the reexamination procedure, after investigation the panel may make tendentious observations on the relevant issue. If necessary, the panel may notify the petitioner for reexamination of the specific facts of and grounds and evidence for which the patent application is considered not in conformity with the relevant provisions

of the Patent Law, its Implementing Regulations and the Guidelines, and hear the submissions of the petitioner for reexamination.

### 5.4 The Forth Stage of Oral Proceedings

In oral proceedings, the panel may adjourn for deliberation as the case needs.

The chairman announces temporary adjournment and the panel deliberates. Then, the oral proceedings are resumed. The conclusion of oral proceedings shall be announced by the chairman. It may be either a conclusion of the examination decision, or any other conclusion, such as a conclusion that the facts of the case have been clearly identified and an examination decision is ready to be made. To this time, the oral proceedings come to an end.

## 6. Suspension of Oral Proceedings

In any of the following circumstances, the chairman may announce the suspension of oral proceedings and, if necessary, fix a date for the resume of the oral proceedings:

(1) where the party concerned files a motion to recuse some panel member;

(2) where the parties require negotiation for compromise;

(3) where there is a need for further demonstration of the invention-creation; or

(4) any other circumstance where the panel deems necessary.

## 7. Termination of Oral Proceedings

For cases where the facts are clearly identified, an examination decision is ready to be made, and the examination decision needs not to be approved by the Director or Deputy Director of the Board, the panel may announce the conclusion of the examination decision on the spot.

For cases which conclusion of examination decision is planned to be announced on the spot but shall be subject to the approval of the Director or Deputy Director of the Board, the conclusion of the examination decision shall be announced after the approval.

Where the panel does not intend to announce on the spot the conclusion of an examination decision, the chairman shall make a brief explanation.

In any of the above three circumstances, it shall be the chairman

who announces the termination of oral proceedings. Thereafter, the full text of the decision shall be delivered to the parties in written form within a certain period of time.

### 8. Absence of a Party Concerned

Where one of the parties fails to appear in the oral proceedings, the panel shall take the oral proceedings according to the prescribed procedures so long as the presence of the other party in the oral proceedings complies with the procedural requirements.

### 9. Quit From Oral Proceedings

During oral proceedings for a request for invalidation or reexamination, the parties shall not quit without permission of the panel. Where a party quits from oral proceedings without permission of the penal or is expelled by the panel due to disruption to the oral proceedings, the proceedings may be taken by default. However, in this case, record shall be made as to the observations already made by the party and to the fact that the party quitted or was expelled, and shall be signed and confirmed by the party or the panel members.

### 10. Witness in Testimony

A witness who has provided oral evidence and has been indicated in the receipt of *Notification of Oral Proceedings* may testify in oral proceedings. Where the party concerned requests to call a witness in testimony during oral proceedings, the panel may decide whether to accept the request according to the circumstance of the case.

The witness shall produce his identification before testifying before the panel. The panel shall inform him of the legal obligation of honest testifying and the legal consequence of providing false evidence. The witness to be called in testimony shall not be allowed to audit the oral proceedings. Where a witness is inquired, the other witnesses shall not attend, unless they are required to make cross-examination of the evidence.

The panel may inquire a witness. In *inter parte* oral proceedings, the both parties may alternatively inquire a witness. The witness shall answer the inquiries of the panel definitely, and may refuse to answer unrelated questions of either party.

## 11. Recordation

In oral proceedings, the secretary or a panel member designated by the chairman shall take the minutes of the proceedings. The person who takes the minutes shall note down the important items of the oral proceedings in the *Record of Oral Proceedings*. In addition to the minutes, the panel may use audio or video equipment to record.

After important items of oral proceedings being noted down or the termination of oral proceedings, the panel shall hand the minutes to the parties for reading. For errors or mistakes in the minutes, the party concerned may request the person who takes the minutes to make rectification. After being confirmed, the minutes shall be signed by the parties and kept in file. Where any party refuses to sign, the chairman shall note it in the *Record of Oral Proceedings*.

The above-mentioned important items of oral proceedings include:

(1) in oral proceedings of the invalidation procedure, the claims renounced by the party concerned, the scope to be invalidated, and the causes or evidence for the request for invalidation;

(2) in oral proceedings of the invalidation procedure, important facts acknowledged by the both parties;

(3) in oral proceedings of the reexamination procedure, the specific fact, ground and evidence for which the application is not in conformity with the relevant provisions of the Patent Law, its Implementing Regulations and the Guidelines and of which the panel has notified the petitioner for reexamination in oral proceedings, and the main contents of the submissions by the petitioner for reexamination; and

(4) other important items which need to be noted down.

## 12. Public Audiences

The public may be admitted to oral proceedings. Public audiences have no right to address the panel. Without prior approval, photographing, audio or video recording is not permitted. Public audiences shall not send any relevant message to the parties appear in the oral proceedings.

If necessary, the Board may require public audiences to go through the formalities for auditing.

## 13. Rights and Obligations of the Parties Concerned

The chairman shall, at the beginning of oral proceedings, notify the parties of their rights and obligations in the oral proceedings.

(1) Rights of a party concerned

A party concerned shall have the right to request for recusing a panel member; the right to make compromise with the opposite party in the invalidation procedure; the right to call a witness having provided oral evidence in testimony before the panel in oral proceedings and the right to request for demonstration of material evidence; and the right to debate. A petitioner for invalidation shall have the right to withdraw the request; the right to abandon some causes for invalidation and the corresponding evidence; and the right to narrow down the scope to be requested for invalidation. A patentee shall have the right to renounce part of the claims and the corresponding evidence submitted. A petitioner for reexamination shall have the right to withdraw his request for reexamination; and the right to submit amendments to the application.

(2) Obligations of a party concerned

A party concerned shall abide by the rules of oral proceedings and keep the order of oral proceedings; shall request the approval of the chairman before speaking, and shall not interrupt the speech of the other party; and shall provide rational reasoning in debate. Observations and debate shall be restricted to the scope, which is relevant to the examination of the case as defined by the panel. The party concerned shall bear the burden of proof for what he alleges, and shall explain reasons in opposing the allegations of the opposite party. During oral proceedings, any party shall not quit from oral proceedings midway without permission of the panel.

# Chapter 5 Examination of Design Patent in the Invalidation Procedure

## 1. Introduction

This Chapter mainly deals with the examination of design patent concerning Articles 23 and 9 in the invalidation procedure. With regard to the examination concerning other provisions related to the request for invalidation of design patent, Chapter 3 of Part I shall apply.

## 2. Prior Design

According to Article 23.4, the prior design refers to the design known to the public before the date of filing in China or abroad (or the priority date, where priority is claimed).

The prior design includes designs that are made known to the public by publishing, public use or other means in China or abroad before the date of filing. With regard to the time limit, means of disclosure, etc., of the prior design, Chapter 3 of Part II shall apply.

Usual design refers to the prior design, which is so familiar to a normal consumer that the mention of its name would remind him of that particular design. For example, when packing box is mentioned it would remind people of a design with the shape of cuboid or cube.

Art. 2.4

## 3. Objects of Judgment

In the examination of design patent, the objects to be compared are called objects of judgment. The design patent requested for invalidation is hereinafter referred to as the patent concerned and the object of judgment to be compared with the patent concerned is hereinafter referred to as the comparative design.

In determining the objects of judgment, for the patent concerned, in addition to the drawings or photographs of the design patent, the determination shall also be made in accordance with facts such as whether the brief explanation contains any request for protection of colour or whether it has such content as "the existence of boundless unit pattern of two-side continuation or four-side continuation in plane product" (boundless design).

There are six types of the patent concerned.

(1) Design of mere shape

A design of mere shape refers to a shape design of a product that has no definition by pattern and no request for protection of colour.

(2) Design of mere pattern

A design of mere pattern refers to a pattern design of a plane product that has no request for protection of colour and is boundless.

(3) Design of shape and pattern

A design of shape and pattern refers to a shape and pattern design of a product that has no request for protection of colour.

(4) Design of shape and colour

A design of shape and colour refers to a shape and colour design of a product that has request for protection of colour but has no definition by pattern.

(5) Design of pattern and colour

A design of pattern and colour refers to a pattern and colour design of a plane product that has request for protection of colour and is boundless.

(6) Design of shape, pattern and colour

A design of shape, pattern and colour refers to a shape, pattern and colour design of a product that has request for protection of colour.

**4. Subject of Judgment**

The examination of whether a design patent is in conformity with Article 23. 1 and 23. 2, shall be made according to the knowledge and cognitive capability of a normal consumer of the product incorporating the patent concerned.

Different categories of design patent products have different consumers. A normal consumer of a certain category of product incorporating a design shall have the following characteristics:

(1) common knowledge of the designs and commonly used design methods incorporated in the same or similar products as that incorporating the patent concerned before its filing date. For example, a normal consumer of cars shall know about the cars on the market and have general information of cars available from the frequently shown advertisement in the media.

The types of commonly used design methods include design transformation, mosaic, replacement, etc.

(2) certain capability of distinguishing the differences in shape,

pattern and colour between design patent products, but without notice to the minor differences in shape, pattern or colour of products.

## 5. Examination in Accordance with Article 23. 1

According to Article 23. 1, any design for which patent right may be granted shall not be a prior design, nor has any entity nor individual filed before the date of filing with the patent administration department under the State Council an application relating to the identical design and disclosed in patent documents announced after the date of filing.

The patent concerned shall not be a prior design means that there is no design identical or substantially identical with the patent concerned in the prior design. An identical design application which was filed by any entity or individual with the Patent Office and published on or after the filing date of the patent concerned( including the filing date), is called "conflicting application". Wherein, identical designs mean that the designs are identical or substantially identical.

Determining whether the comparative design constitutes a conflicting application for the patent concerned shall be made in accordance with all the content of the published comparative design. When comparing the comparative design with the design of the product claimed by the patent concerned, whether the comparative design includes a design identical or substantially identical with the patent concerned shall be decided. For example, the patent concerned requests for protection of colour, while the published comparative design contains colour, even though the comparative design has no request for protection of colour, the design contains colour in the comparative design could be used to compare with the patent concerned; also, the published comparative design includes reference view of the state in use, even though the reference view of the state in use contains design which has not been claimed, the non-claimed design could be used to compare with the patent concerned to decide whether they are identical or substantially identical.

### 5. 1 Criteria for Judgment

#### 5. 1. 1 Identity of Designs

Identity of designs means that the patent concerned and the comparative design are designs for the same category of products, and all the design elements of the patent concerned are identical with the cor-

responding design elements of the comparative design, wherein design elements refer to shape, pattern and colour of a design.

If the difference between the comparative design and the patent concerned is merely a result of commonly used materials substitution or the difference only lies in the function, internal structure, technical performance or dimension of the product, and the difference does not lead to any change in the design of the product, the comparative design and the patent concerned are still identical designs.

In determining the category of product, reference may be made to the title, international classification for designs and the shelves classification of the product when it is on sale, however, the determination of whether two products belong to the same category shall be based on whether the uses of the two products are identical. The products of the same category refer to the products that have completely the same use. For example, although the internal structure of a mechanical watch and an electronic watch are different, they have the same use, and therefore they are of the same category.

### 5.1.2 Substantially Identical Designs

The judgment of substantially identical designs is only limited to designs of the same or approximate category of products. Where the patent concerned and the comparative design are for products of neither the same nor approximate category, without making a comparison and judgment of the two, it can directly be determined that the patent concerned and the comparative design are not substantially identical, for example, designs of towel and carpet.

Products of approximate categories refer to products that have similar use. For example, a toy and a tiny ornament are products of approximate categories, because they have similar use. It should be noted that for products having multiple uses, if some of the uses are the same and some are not, they are regarded as products of approximate categories. For example, a watch equipped with an mp3 player and a mere watch both have the use of timing, and therefore they are products of approximate categories.

If a normal consumer can see from the overall observation of the patent concerned and the comparative design, that their difference simply falls into the following circumstances, then the patent concerned and the comparative design are substantially identical:

(1) the difference lies in only slight changes in some fine details

which cannot be noticed paying normal attention, for example the designs of venetian blind differ only in the number of slats;

(2) the difference exists in the parts which cannot be seen easily or cannot be seen at all when in use, however, the circumstance where there is evidence showing that the special design in the parts which cannot be seen easily has notable visual effect for a normal consumer makes an exception;

(3) the difference is a result of the substitution of one design element as a whole by said design element of the usual design commonly known for the category of product, for example, changing the shape of a cookie jar with pattern and colour from the cube to the cuboid;

(4) the difference exists in that the patent concerned is simply a repeated and continuous arrangement or an increase/decrease in the continuous number of the comparative design as a design unit following the normal arrangement of the category of product, for example, repeated and continuous arrangement of the rows of the seat in cinema or a increase/decrease in the number of the rows of seats; and

(5) the difference exists in that the patent concerned and the comparative design are a mirror image.

### 5.2 Method of Judgment

The comparison and judgment of designs shall be based on the perspective of a normal consumer defined in Section 4 of this chapter.

#### 5.2.1 One-to-One Comparison

Generally the patent concerned shall be compared with only one comparative design, rather than with two or more comparative designs in combination.

If the patent concerned contains several designs of products which can be used separately, such as designs of a set of products or two or more similar designs for the same product, each of the designs may be separately compared with a different comparative design.

If the patent concerned is for a product comprising at least two components which are to be used when they are assembled together, the patent concerned may be compared with, as a single comparative design, a combination of prior designs that have a clear interrelation of assembly and are of the number corresponding to that of the components.

### 5.2.2 Direct Observation

The comparison of designs shall be based on direct visual observation, rather than with the aid of magnifier, microscope, chemical analysis, or other instruments or means. The parts or elements that cannot be directly identified by eyes shall not form the basis of judgment. For example, if viewed visually, some textile products are identical or similar in the shape, pattern and colour. However, if viewed under a magnifier, there is much difference in their texture.

### 5.2.3 Targeting at Only the Appearance of a Product

In the comparison of designs, account shall be taken only of the appearance of a product, considering the visual effect produced by the elements of shape, pattern and colour of a product or their combination.

Where the extent of protection of the patent concerned is defined only by part of its elements, the other elements will not be considered when compared with a comparative design.

If the patent concerned applies to the component part of a product, the comparison of designs shall be made simply by comparing the corresponding part of the comparative design with the patent concerned, without taking the rest part into account.

For a product which uses transparent material to form its appearance, the shape, pattern and colour inside the transparent part which is visible through eyesight shall form part of the design for the product.

### 5.2.4 Whole Observation and Comprehensive Judgment

The comparison of designs shall be made through the approach of whole observation and comprehensive judgment. The approach of whole observation and comprehensive judgment means to determine on the observation of the patent concerned and the comparative design as a whole rather than on part or details of the designs.

#### 5.2.4.1 Determining the Information Disclosed by a Comparative Design

Where the drawings or photographs of the comparative design do not display all the views of the product, the determination of information disclosed by the comparative design shall be based on the cognitive capability of a normal consumer.

If, based on the cognitive capability of a normal consumer, the design on the other parts of the product or in other varied states can be inferred according to the content disclosed by the drawings or photographs of the comparative design, the design on the other parts of the product or in other varied states is deemed to be also disclosed. For example, where the product is symmetrical with an axis, plane or center, if the drawings or photographs disclosed only one symmetrical side of the design, the other symmetrical side of the design is deemed to be also disclosed.

#### 5.2.4.2 Identifying the Patent Concerned

The patent concerned shall be identified according to the drawings or photographs in the granted design document. The brief explanation can be used to interpret the design of the product as shown in the drawings or photographs.

#### 5.2.4.3 The Comparison between the Patent Concerned and the Comparative Design

The comparison between the patent concerned and the comparative design shall be made through the approach of whole observation and comprehensive judgment.

If the undisclosed part in the drawings or photographs of the comparative design is a part usually not drawing attention of a normal consumer in the state of use, and the change in this part does not notably influence the overall visual effect of the product, taking fans of an air-conditioner as an example, if the drawings or photographs of the comparative design do not disclose the bottom side and rear side of the fans, and the change which the patent concerned does in the bottom side or rear side is considered not sufficient to influence the overall visual effect of the product, then the whole observation and comprehensive judgment of the two designs will not be affected.

If the part of the patent concerned corresponding to the undisclosed part in the drawings or photographs of the comparative design is a usual design of the category of products and does not draw attention of a normal consumer, for example, if the undisclosed part in the drawings or photographs of the comparative design is a hind baffle plate for a truck, while the hind baffle plate of the patent concerned is merely a usual design of this category of products, then the whole observation and comprehensive judgment of the two designs will not be affected.

### 5.2.5 Judgment Concerning Combination Product and Product of Variable States

#### 5.2.5.1 Combination Product

The combination product refers to a single product assembled by multiple components.

For an assembled product with only one option of assembly, such as an electronic kettle assembly comprising a kettle and a heater, when purchasing and using this category of product, a normal consumer will have an impression of the overall design of the electronic kettle after its components being assembled. Another example is a blender ice machine comprising a blending cup, an ice cup and a base. When purchasing and using this category of product, a normal consumer will have an impression of the overall appearance of the blender assembled by the blending cup and the base, and the overall appearance of the ice machine assembled by the ice cup and the base. Therefore, the judgment shall target at the overall appearance of the product in the abovementioned assembled states, rather than at the appearance of each individual components.

For an assembled product with more than one option of assembly, such as a plug-in units toy, when purchasing and using this category of product, a normal consumer will have an impression of the design of each individual component. Therefore, the judgment shall target at the appearance of each individual component of the plug-in product, rather than the appearance of the whole product after being plugged in.

For a combination product without the need to assemble its components, such as poker cards and pieces of chess, when purchasing and using this category of product, a normal consumer will have an impression of the design of each individual component. Therefore, the judgment shall target at the appearance of each individual component.

#### 5.2.5.2 Product of Variable States

A product of variable states means a product, which can be in various states when on sale or in use.

As for a comparative design, such a product in all its variable states may be compared with the patent concerned. As for the patent concerned, such a product shall be taken only in its state of use to

compare with a comparative design, and the judgment shall be made considering comprehensively the design of the product in its various states of use.

#### 5.2.6 Judgment on Design Elements

##### 5.2.6.1 Judgment on Shape

In respect of the overall shape of a product design, a circle is considerably different from a triangle or a quadrilateral, generally they shall not be taken as substantially identical, unless the overall shape of a product falls into the category of usual design. For a product like packing box, the judgment shall be made based on its shape in use.

##### 5.2.6.2 Judgment on Pattern

Difference in pattern includes differences in such elements as subject, composition, expression and lines designed. Change in colour may also result in the difference in pattern. Where the subject is identical, but the composition, expression and lines designed are different, generally the pattern may not be deemed substantially identical.

Words and numbers on the exterior of a product, including the name of the product, are a category of pattern, and account shall be taken of its decorative function as part of the pattern, rather than of the meaning and pronunciation of them.

##### 5.2.6.3 Judgment on Colour

The judgment on colour shall be made in a comprehensive way, taking account of the three properties of colour, i. e. hue, saturation, and lightness, and also combination and collocation of two or more colours. Hues of colour refer to shades of all categories of colours, such as vermilion, bright blue, lemon yellow, pink green, etc. Saturation means the degree of brilliance of colours. Lightness refers to the degree of brightness of colours. The white colour is the brightest, while the black colour is the darkest.

For monochromatic designs, only change in colour still makes them substantially identical.

### 6. Examination in Accordance with Article 23.2

According to Article 23.2, any design for which patent right may be granted shall significantly differ from prior design or the combina-

tion of prior design features. The patent concerned significantly differs from prior design or the combination of prior design features in the following circumstances:

(1) the patent concerned is not significantly different from the prior design of the product of the same or approximate category;

(2) the patent concerned is transformed from the prior design, the design features of the two are identical or only have very slight difference, and there's an inspiration for the specific transformation in the prior design of the product of the same or approximate category; and

(3) the patent concerned is a combination of the prior design or prior design features, the prior design and the corresponding part of the patent concerned are identical or only have very slight difference, and there's an inspiration for the specific combination in the prior design of the product of the same or approximate category.

If the patent concerned is transformed and combined from the prior design, the judgment shall be made based on the comprehensive observation in accordance with (2) and (3).

It should be noted that when a unique visual effect results from the above-mentioned transformation and/or combination, there could be an exception.

Prior design features refer to part of design elements of the prior design or their combination, such as shape, pattern, colour of the prior design or their combination , or the design of a component of the prior design, such as the design of the component of an integral design product.

### 6.1 Comparison with the Prior Design of the Product of the Same or Approximate Category

If a normal consumer finds that the difference between the patent concerned and the prior design does not notably influence the overall visual effect of the product through a comprehensive observation on them, then the patent concerned is not significantly different from the prior design. Judgment on notable influence limits to designs of the product of the same or approximate category.

Generally, in determining whether there is significant difference between the patent concerned and the prior design of the product of the same or approximate category, the following factors shall be further considered comprehensively:

(1) in the whole observation of the patent concerned and the prior

design, the parts which can be seen easily in use shall be paid more attention to, generally the design changes in the parts which can be seen easily when they are used have more notable influence on the overall visual effect than the design changes in the parts which cannot be seen easily or cannot be seen at all. For example, the rear side and bottom side of a television do not draw attention of a normal consumer when the television is used, therefore, for television the design changes in the parts which can be seen easily when they are used have more notable influence on the overall visual effect than the design changes in the rear side that cannot be seen easily and the design changes in the bottom side that cannot be seen at all. However, the circumstance where there is evidence showing that the special design in the parts which cannot be seen easily has notable visual effect for a normal consumer is an exception;

(2) where designs in some parts of a product are proved to be usual designs commonly known for the category of product (for example, design of column form for a tin), the changes in other parts have more notable influence on the overall visual effect. For example, since the contour of the cross section of a section steel is usually rectangle, the change in other parts of the cross section has more notable effect;

(3) a special shape exclusively determined by the function of a product generally does not notably influence the overall visual effect. For example, the shape of the curved surface of a cam is dictated by its specific motion track, such a difference generally does not notably influence the overall visual effect; the circular shape of tyre is exclusively determined by its function, so the pattern on the tyre has more notable influence on the overall effect; and

(4) if the difference lies only in minor changes in some fine details, the difference is not sufficient to have notable influence on the overall visual effect, the two are not significantly different. For example, both the patent concerned and the comparative design are electronic rice cookers, and the difference lies only in the different shapes of the control buttons, since control buttons are only minor designs of a detail in an electronic rice cooker, and occupy a very small portion of the overall design, the change in them is not sufficient to have notable influence on the overall visual effect.

It should be noted that the design designated by the essential features of the design in the brief explanation does not necessarily have a notable influence on the overall visual effect, and it does not necessari-

ly result in the significant difference between the patent concerned and the prior design. For example, as to the auto design, the brief explanation points out that the essential features of the design lie in the bottom side of the auto, however the design of the bottom side does not have a notable influence on the overall visual effect of the auto.

As to the judgment on notable influence, section 5.2 of this chapter shall apply.

## 6.2 Transformation of the Prior Design, Combination of the Prior Design or its Design Features

### 6.2.1 Method of Judgment

With respect to the judgment on transformation of the prior design and combination of the prior design or its design features, it could be made as the following steps:

(1) to determine the content of the prior design, including shape, pattern, colour or their combination;

(2) to compare the prior design or its design features with the respective part of the patent concerned; and

(3) where the prior design or its design features are identical with the respective part of the patent concerned, or the two only have very minor difference, to determine whether there is an inspiration for the specific transformation and/or combination in the prior design for the product of the same or approximate category.

If there is an above-mentioned inspiration, the two are not significantly different. The exception is where the transformation and/or combination produce a unique visual effect.

### 6.2.2 Transformation of the Prior Design

Transformation means to apply the design of one product to another product. Simulation of natural object and natural scenery, as well as application of a simple shape, pattern, colour or their combination into design of a product also fall into the category of transformation.

The following types of transformation fall into the circumstances where there is an obvious inspiration for the transformation, and designs arising therefrom are not significantly different from the prior design:

(1) the design which simply adopts the basic geometric shape or only slightly changes it;

(2) the design which simply simulates the original form of natural object or natural scenery;

(3) the design which simply simulates the entire or partial shape, pattern, colour of well-known building or work; and

(4) the design for product like toy, decoration, food, which is transformed from the design of other category of product.

If the above-mentioned circumstances give rise to unique visual effect, there could be an exception.

### 6.2.3 Combination of the Prior Design or its Design Features

Combination, including mosaic and replacement, means to produce a design by merely aggregating two or more designs or design features, or replacing the design feature of one design with another design feature. A design which is produced by simply repeating the arrangement of a design or design feature as a unit, is considered as a combination design. The above mentioned combination also contains mosaic and replacement using simulation of natural object or natural scenery, and those using simple shape, pattern, colour or their combination.

The following types of combination fall into the circumstances where there is an obvious inspiration for the combination, and designs arising therefrom are not significantly different from the combination of the prior design or its design features:

(1) the design which is produced by merely aggregating multiple prior designs or their slightly changed forms for the product of the same or approximate category. For example, an integral design which is produced by merely aggregating multiple component parts;

(2) the design which is produced by replacing the design feature of a design with another design feature or its slightly changed form of the product of the same or approximate category; and

(3) the design of product which is produced by merely aggregating the prior design of shape for the product with the prior pattern, colour or their combination; or by replacing the pattern, colour or their combination in one prior design with those in another prior design.

If the above-mentioned circumstances give rise to unique visual effect, there could be an exception.

### 6.2.4 Unique Visual Effect

Unique visual effect means that the patent concerned produces

unexpected visual effect, comparing with the prior design. As to the combined design, where each prior design or design feature only stands alone, or merely aggregate with each other, without producing interaction in visual effect, generally the combination would not be considered to produce unique visual effect.

The design which produces unique visual effect is significantly different from the combination of the prior design or its design features.

## 7. Examination in Accordance with Article 23.3

A design patent which is found to be in conflict with any other person's legitimate right obtained before the patent's filing date (or the priority date, where priority is claimed) shall be declared invalid.

Any other person refers to the civil subject other than the patentee, including natural person, legal person or other entity.

Legitimate right refers to the right or interest which is recognized by laws of the People's Republic of China and is still valid prior to the filing date of the patent concerned. It includes trademark rights, copyright, right to enterprise's name (including right to trade name), right to image and right to the special packaging and decoration of well-known goods, etc.

Obtaining prior to the filing date means that the prior legitimate right is obtained before the filing date of the patent concerned.

To be in conflict means that the design patent constitutes an unauthorized use of the subject matter of prior legitimate right, therefore the exploitation of the patent would infringe the relevant legitimate right or interest of the prior right holder.

Rule 66.3

In the invalidation procedure, the petitioner shall bear the burden of producing evidence for his allegation, including proving himself the right holder or interested party of the prior right and the validity of the prior right.

### 7.1 Trademark Rights

The prior trademark right refers to the trademark right of any other person protected by laws of the People's Republic of China before the filing date of the patent concerned. Where the patent concerned makes use of a design which is identical or similar to the prior trademark, without the trademark holder's authorization, and the exploitation of the patent would mislead the relevant public or produce confu-

sion in the relevant public, and infringe the trademark holder's related legitimate right or interest, the patent concerned shall be held to be in conflict with the prior trademark right.

To determine whether the respective design in the patent concerned is identical or similar to the prior trademark, generally the standard to judge the identity or similarity of trademark shall apply.

As to the registered trademark, which is well known to the relevant public in China, in determining whether there's a conflict of rights, the category of product could be properly broadened.

### 7.2 Copyright

The prior copyright refers to the copyright, which is legally entitled to by any other person either by creating a work independently or by means of inheritance or transfer. The work refers to the subject matter protected by Copyright Law of the People's Republic of China and its Implementing Regulations.

Where there is a possibility of contact with any other person's copyrighted work, the patent concerned makes use of a design identical or substantially similar to the work, without the copyright holder's authorization, and the exploitation of the patent would infringe the prior copyright holder's related legitimate right or interest, the patent concerned shall be held to be in conflict with the prior copyright.

## 8. Examination in Accordance with Article 9

"Identical invention-creation" referred to in Article 9 means for designs, that the claimed designs for product shall be identical or substantially identical. The comparison shall be made based on the whole comparison of all design elements.

Where the patent concerned contains multiple designs, each design shall be compared with the comparative design respectively. If one design of the patent concerned is identical or substantially identical with another design of the other patent, they are considered as identical inventions-creations.

With respect to the judgment of identical or substantially identical designs, Section 5 of this chapter shall apply.

Art. 29. 1

## 9. Verification of Right of Priority

### 9. 1 Circumstances where Verification of Right of Priority is Needed

A design patent application can only claim the right of foreign priority. Therefore verification of right of priority means verification of right of foreign priority.

Priority shall be verified when any of the following circumstances is found to exist:

(1) the patent concerned is identical or substantially identical with the comparative design, the patent concerned is not significantly different from the comparative design or the combination of its design features, and the publication date of the comparative design is on or after the claimed priority date and before the application date of the patent concerned;

(2) the patent concerned is identical or substantially identical with a design application filed by any entity or individual with the Patent Office, and the application date of the latter is on or before that of the former and on or after the claimed priority date, and the granting announcement date of the latter is on or after the application date of the former; or

(3) the patent concerned is identical or substantially identical with a design application filed by any entity or individual with the Patent Office, and the priority date of the latter is on or before that of the former and on or after the claimed priority date, and the granting announcement date of the latter is on or after the application date of the former.

In the circumstance (3), the right of priority of the patent concerned shall be verified first; where the patent concerned can not enjoy the right of priority and its application date is before the application date of the design filed by any entity or individual, the right of priority of the design filed by any entity or individual as a comparative design shall be verified as well.

### 9. 2 Determination of Same Subject Matter for Designs

The determination of same subject matter for designs shall be based on the design application subsequently filed in China and the content indicated in the first foreign design application. Designs of

same subject matter shall meet both of the following two conditions:

(1) both of the designs are for same products ; and

(2) the claimed design in the subsequent application in China is clearly shown in the first foreign application.

Where the drawings or photographs of the claimed design in the subsequent application in China are not completely consistent with those of the first foreign application, or the subsequent application in China contains a brief explanation while the first foreign application does not have the related brief explanation, but based on the application documents of the two, the claimed design in the subsequent application in China has been clearly shown in the first foreign application, it may be determined that the claimed design in the subsequent application in China has the same subject matter as that of the design in the first foreign application, and thus may enjoy the priority of the latter. For example, a first foreign application furnished a front view, a back view, a left view and a space diagram of a product, and the subsequent application in China furnished a front view, a back view, a left view, a right view and a top view of the product, and indicated in the brief explanation that the upward view was omitted since the bottom of the product was rarely seen. Under such circumstance, if only the front view, back view and left view of the subsequent application in China are the same as those of the first foreign application, and the right view and top view of the former have been clearly shown in the space diagram of the latter, it may be determined that the subject matters of the two applications are the same, and the subsequent application in China may enjoy the right of priority of the first foreign application.

### 9.3 Conditions for Entitlement to Right of Priority

In this regard, Chapter 3, Section 4.1.1 of Part II shall apply *mutatis mutandis*. However, the filing date of the subsequent application in China shall be no later than 6 months from the filing date of the first foreign application.

### 9.4 Effect of Right of Priority

In this regard, Chapter 3, Section 4.1.3 of Part II shall apply *mutatis mutandis*.

### 9.5 Multiple Priorities

According to Rule 32.1, in a design patent application one or

more priorities may be claimed; where multiple priorities are claimed, the priority period for the application shall be calculated from the earliest priority date.

For a design patent containing several products of independent use value, if the designs of one or more products therein have respectively the same subject matter as the designs in one or more first foreign applications, the design patent may enjoy one priority or multiple priorities.

# Chapter 6 Some Provisions Concerning the Examination of Utility Models in the Invalidation Procedure

## 1. Introduction

This Chapter is made pursuant to Articles 2. 3, 22. 2 and 22. 3.

Art. 2. 3

## 2. Examination of Subject Matter as Patentable for Utility Model

For examination in the invalidation procedure of a subject matter that may be granted for a utility model patent, Chapter 2, Section 6 of Part I shall apply.

Art. 22. 2

## 3. Examination of Novelty for Utility Model

In the examination of novelty for a utility model, all the technical features in a technical solution, including both composition features and process features, shall be taken into account.

For relevant aspects of examination of novelty for a utility model, including the concept of novelty, examination principles for novelty, the examination criteria, examination of priority, and examination of grace period, Chapter 3 of Part II shall apply.

Art. 22. 3

## 4. Examination of Inventive Step for Utility Model

In the examination of inventive step for a utility model, all the technical features in a technical solution, including both composition features and process features, shall be taken into account.

For relevant aspects of examination of inventive step for a utility model, including the concept of inventive step, examination principles for inventive step, the examination criteria, and the assessment of inventive step for various types of inventions-creations, Chapter 4 of Part II shall apply.

However, according to Article 22. 3, inventive step of an invention means that, as compared with the prior art, the invention has prominent substantive features and represents a notable progress; inventive step of a utility model means that, as compared with the prior art, the utility model has substantive features and represents progress. Therefore, the requirement of inventive step for a utility model shall be lower than that for an invention.

The difference in requirement of inventive step for a utility model and for an invention is mainly indicated by whether there exists a technical teaching in the prior art. In determining whether there exists a technical teaching in the prior art, a utility model differs from an invention in the following two aspects.

(1) Field of prior art references

For an invention, the examiner shall consider not only the technical field to which the invention belongs, but also the proximate or relevant technical fields, and those other technical fields in which the problem to be solved by the invention would prompt a person skilled in the art to look for technical means.

For a utility model, the examiner will normally focus on the technical field to which the utility model belongs. Where there is a clear technical teaching, for example, where there is an explicit description in the prior art, to prompt a person skilled in the art to look for technical means in a proximate or relevant technical field, the proximate or relevant technical field may be considered.

(2) Number of prior art references

For an invention application, one, two or more prior art references may be cited to assess its inventive step.

For a utility model, normally one or two prior art references may be cited to assess its inventive step. Where the utility model is made just by juxtaposing some prior art means, the examiner may, according to the circumstance of the case, cite more than two prior art references to assess its inventive step.

# Chapter 7 Handling of Identical Inventions-Creations in the Invalidation Procedure

## 1. Introduction

In accordance with Rule 65, inconformity with Article 9 is a cause for invalidating a granted patent right.

"Identical invention-creation" referred to in Article 9 means, for inventions or utility models, that the claimed inventions or utility models are identical, for principles of determination of which Chapter 3, Section 6. 1 of Part II shall apply; and for designs, that the claimed designs of the product are identical or substantially identical, for the determination of which Chapter 5 of this Part shall apply.

Where any entity or individual requests for invalidation on the ground that an invention or utility model patent and another invention or utility model patent applied earlier constitute identical inventions-creations, failing to comply with Article 9, if the patent applied earlier has constituted the prior art or is a patent applied earlier and published later than the patent concerned that belongs to any entity or individual, the Patent Reexamination Board may examine in accordance with Article 22.

Where any entity or individual requests for invalidation on the ground that a design patent and another design patent applied earlier constitute identical inventions-creations, failing to comply with Article 9, if the patent applied earlier has constituted a prior design or is a patent applied earlier and published later than the patent concerned that belongs to any entity or individual, the Patent Reexamination Board may examine in accordance with Article 23.

## 2. By the Same Patentee

### 2.1 On Different Date of Announcement of Grant of Patent

Where any entity or individual makes a request for invalidation of the patent granted earlier before the Patent Reexamination Board on the ground that the two patents with the same filing date (or the priority date, where priority is claimed) that belong to the same patentee do not comply with Article 9. 1, in case there are no other causes for in-

validation or other causes are untenable, the Patent Reexamination Board shall maintain the validity of this patent.

Where any entity or individual makes a request for invalidation of the patent granted later before the Patent Reexamination Board on the ground that the two patents with the same filing date (or the priority date where priority is claimed) that belong to the same patentee do not comply with Article 9.1, the Reexamination Board shall declare the invalidation of this patent where it holds that the two constitute identical inventions-creations after the examination.

If the two patents mentioned above include a utility model patent and an invention patent applied by the same patentee on the same date (only the filing date), the patentee has made a statement in accordance with Rule 41.2 as filing the application and the utility model patent has not terminated when the invention patent is granted, in that case, the patentee may retain the invention patent requested to be declared invalid by abandoning the utility model patent granted earlier.

### 2.2 On the Same Date of Announcement of Grant of Patent

Any entity or individual, who considers the same patentee's two patents with the same filing date (or the priority date where priority is claimed) and the same date of announcement of grant do not comply with Article 9.1, may request the Patent Reexamination Board to declare one of the patent rights invalid.

Where only one of the patent rights is requested to be invalidated, the Patent Reexamination Board shall declare the invalidation of the patent requested for invalidation if it holds that the two constitute identical inventions-creations after the examination.

Where both of the patent rights are requested to be invalidated, the Patent Reexamination Board shall generally examine the requests jointly. Where the Patent Reexamination Board holds that the two constitute identical inventions-creations after the examination, it shall notify the patentee of its holding, and require the patentee to choose to retain one of the two patent rights. Where the patentee chooses to retain only one of the two patent rights, in case there are no other causes for invalidation or other causes are untenable, the Patent Reexamination Board shall maintain the validity of this patent and declare the invalidation of the other one. Where the patentee does not make any choice, the Patent Reexamination Board shall declare the invalidation of both patent rights.

**3. By Different Patentees**

Any entity or individual, who considers different patentees' two patent rights having the same filing date (or the priority date where priority is claimed) fail to comply with Article 9.1, may separately request the Patent Reexamination Board to declare both of the patent rights invalid.

Rule 41.1

Where both of the patent rights are requested to be invalidated, the Patent Reexamination Board shall in general examine the requests jointly. Where the Patent Reexamination Board holds that the two constitute identical inventions-creations after the examination, it shall notify the two patentees of its holding, and require the two patentees to choose to retain one of the two patent rights through consultation. Where the two patentees submit a joint written statement of retaining only one of the two patent rights through consultation, in case there are no other causes for invalidation or other causes are untenable, the Patent Reexamination Board shall maintain the validity of this patent right and declare the invalidation of the other one. Where the patentees cannot make any choice through consultation, the Patent Reexamination Board shall declare both of the patent rights invalid.

Where only one of the patent rights is requested to be invalidated, the Patent Reexamination Board shall notify both parties of its holding that the two constitute identical inventions-creations after the examination. The patentee of the patent requested for invalidation may request for invalidating the other patent right, and choose to retain one of the two patent rights through consultation with the patentee of the other patent right. Where the patentee requests for invalidating the other patent right, the Patent Reexamination Board shall handle it according to the provisions of the preceding paragraph. Where the patentee does not request for invalidating the other patent right, the Patent Reexamination Board shall declare the patent right requested to be invalidated invalid.

# Chapter 8 Provisions Concerning Issues of Evidence in the Invalidation Procedure

## 1. Introduction

This Chapter is formulated pursuant to the relevant provisions of the Patent Law and its Implementing Regulations, in combination with the practice in the examination of invalidation cases.

For various issues of evidence in the invalidation procedure, the provisions of these Guidelines shall apply; where there are no provisions applicable in these Guidelines, the relevant provisions applied by the People's Court in civil procedures may be referred to.

## 2. Producing Evidence by the Party Concerned

### 2.1 Allocation of the Burden of Proof

The party concerned shall bear the burden of producing evidence for what he alleges to be facts on which his request for invalidation is based or on which his rebuttal to the request for invalidation is based.

Where the allocation of the burden of producing evidence cannot be determined in accordance with the preceding paragraph, the Board may determine the allocation of the burden of producing evidence in accordance with the principle of fairness and the principle of good faith, in combination with the parties' ability to produce evidence as well as the probability of occurrence of the facts to be proven, etc.

The party that bears the burden of proof shall bear the unfavorable consequence where the evidence cannot be produced or the evidence produced is not sufficient to support his allegations.

### 2.2 Presenting Evidences

For presentation of evidence, in addition to the provisions of this Chapter, Chapter 3, Section 4.3 of this Part shall apply.

Rule 3

#### 2.2.1 Presenting Evidence in a Foreign Language

Where the party concerned submits a piece of evidence in a foreign language, he shall also submit the Chinese translation thereof. If

he fails to submit the Chinese translation for the evidence within the time limit, the foreign language evidence shall be deemed not to have been submitted.

The party concerned shall submit the Chinese translation in written form. If he fails to submit the Chinese translation in written form, said Chinese translation shall be deemed not to have been submitted.

The party concerned may submit the Chinese translation only for part of the foreign language evidence. Other parts of the foreign language evidence without Chinese translation being submitted shall not be taken as evidence, unless the Chinese translation for the other parts are subsequently submitted at the demand of the Patent Reexamination Board.

If the opposite party has objection to the contents of the Chinese translation, he shall submit the Chinese translation for the disputed parts within a specified time limit. Failure to submit the Chinese translation shall be deemed as having no objection to the translation.

Where there is a dispute over the Chinese translation, if the both parties have reached an agreement as to the translation, the agreed translation shall be used; if the both parties cannot reach an agreement as to the translation, the Patent Reexamination Board may entrust a translator to translate if necessary. Where the both parties have reached an agreement on the translator, the Patent Reexamination Board may entrust the translator as agreed on by the both parties to translate, for the full text, the part to be used, or the part in dispute. Where the both parties cannot reach an agreement on the translator, the Patent Reexamination Board may entrust *ex officio* a professional translation agency to translate. The both parties shall respectively bear 50% of the translation fee for the entrusted translation. The party refusing to pay the translation fee shall be deemed to acknowledge that the Chinese translation submitted by the other party is correct.

### 2.2.2 Verification Formalities for Evidence Formed Abroad or in Hong Kong, Macao, or Taiwan

Evidence formed abroad means the evidence formed beyond the territory of the People's Republic of China. The evidence shall be notarized by the notary organs in the country concerned and verified by the Chinese Embassy or Consulate to the country, or shall be subject to any verification formalities provided in a treaty between China and the country.

For evidence formed in Hong Kong, Macao or Taiwan, the relevant verification formalities shall also be gone through.

However, in any of the following circumstances, the party concerned may not go through the relevant verification formalities in the invalidation procedure for the two kinds of evidence mentioned above:

(1) the evidence can be obtained via domestic public channels (Hong Kong, Macao and Taiwan excluded), e. g., foreign patent documents obtained from the Patent Office, or foreign literature obtained from a public library;

(2) the authenticity of the evidence can be sufficiently supported by other evidence; or

(3) the authenticity of the evidence is acknowledged by the opposite party.

### 2.2.3 Presenting Physical Evidence

The party concerned shall submit physical evidence to the Board within the time limit for producing evidence specified in Chapter 3, Section 4.3 of this Part. Where the party concerned submits physical evidence, he shall at the same time submit photographs or written description sufficient to demonstrate the objective situation of the physical evidence, and explain specifically the facts to be proved based on the physical evidence.

Where either party fails to present physical evidence within the time limit for producing evidence with due reasons, he may within the time limit, request in written form the extension of the time limit, and shall still, within the time limit, submit photographs or written description sufficient to demonstrate the objective situation of the physical evidence and explain specifically the facts to be proved based on the physical evidence. The party concerned shall submit physical evidence no later than the closure of the oral proceedings.

For the physical evidence which has been sealed and notarized by the notary organ, the party may only submit the notarial document rather than submit said physical evidence within the time limit for producing evidence, but shall submit said physical evidence no later than the closure of the oral proceedings.

## 3. Investigation and Collection of Evidence by the Patent Reexamination Board

The Patent Reexamination Board normally does not take the initia-

tive to conduct investigation or collect evidence for the examination of a case. For evidence that cannot be collected by the party concerned or its representative in its own effort due to objective reasons, the Patent Reexamination Board may investigate and collect the evidence if the party concerned has made such a request within the time limit for producing evidence and the Patent Reexamination Board considers necessary.

The Patent Reexamination Board may investigate and collect the relevant evidence *in situ*, or entrust a local intellectual property administrative authority or other relevant authority to investigate and collect the relevant evidence.

Where the investigation and collection of evidence is conducted at the request of a party concerned, the cost shall be borne by either the party concerned or the Patent Reexamination Board. Where the Patent Reexamination Board decides to investigate and collect evidence *ex officio*, the cost shall be borne by the Patent Reexamination Board.

## 4. Cross-examination, Examination and Verification of Evidence

### 4.1 Cross-Examination of Evidence

Evidence shall be cross-examined by the parties concerned and those without cross-examination shall not be taken as the basis for deciding the facts of the case.

In the cross-examination of evidence, focusing on the relevance, legitimacy and authenticity of the evidence, the parties concerned shall conduct their inquiry, explanation and argument with respect to the probative force of evidence.

### 4.2 Examination of Evidence

The panel shall examine the evidence submitted by the parties one by one and examine all the evidence items comprehensively.

The panel shall clarify the probative relationship between the evidence and the facts of the case and rule out the evidence items without relevance.

The panel shall take into account the specific circumstance of the case and examine the legitimacy of the evidence from the following aspects:

(1) whether the evidence meets the formal requirements prescribed by law;

(2) whether the acquirement of the evidence is in conformity with the provisions of laws and regulations;

(3) whether there is any other illegal circumstance that will prejudice the effectiveness of the evidence.

The panel shall take into account the specific circumstance of the case and examine the authenticity of evidence from the following aspects:

(1) whether the evidence is an original; whether a photocopy or duplicate matches the original;

(2) whether the provider of the evidence has interests in the party concerned;

(3) objective environment where the evidence is collected;

(4) causes and means in formation of the evidence;

(5) contents of the evidence; and

(6) other factors which may affect the authenticity of the evidence.

**4.3 Determination of Evidence**

Where, as to the evidence submitted by one party, the other party has acknowledged it or his counterevidence is insufficient to rebut it, the Board shall determine the probative force of the evidence.

Where, for the evidence submitted by one party, the other party has objection and has submitted counterevidence, and the one party has acknowledged the counterevidence, the Board may determine the probative force of the counterevidence.

Where, both parties have submitted evidence to the contrary against the same fact but neither of them provides sufficient basis to deny the evidence of the other party, the panel shall take into account the specific circumstance of the case and make a judgment whether the probative force of the evidence submitted by one party is obviously greater than that of the one submitted by the other party, and affirm the evidence with greater probative force.

Where, due to the failure in judgment of the probative force of the evidence, it is difficult to determine the fact in dispute, the Board shall make a judgment in accordance with the rules concerning allocation of the burden of producing evidence.

**4.3.1 Testimony of Witness**

A witness shall state the specific facts that he has experienced in

person. Inference, conjecture, or observations made by the witness based on his experience shall not be taken as the basis for deciding the facts of the case.

In taking the testimony of a witness, the Patent Reexamination Board may make a judgment by analyzing comprehensively the witness' interest in the case, mental health, moral character, knowledge, experience, legal awareness, professional competence, etc. , of the witness.

Witness shall appear and be inquired in the oral proceedings. Written testimony made by a witness not appear in oral proceedings shall not be taken independently as the basis for deciding the case, unless the witness does have difficulties in appearing in the oral proceedings. Where a witness does have difficulties in appearing in oral proceedings, the Patent Reexamination Board shall take his written testimony according to the rules in the preceding paragraph.

**4.3.2 Acknowledgement and Admission**

In the invalidation procedure, evidence of a party clearly acknowledged by the opposite party shall be taken by the Patent Reexamination Board, unless the evidence are obviously inconsistent with facts, or detrimental to national interest or public interest, or taken back by the party concerned with sufficient counterevidence to overturn it.

In the invalidation procedure, the facts stated by a party and clearly admitted by the opposite party shall be taken by the Patent Reexamination Board, unless the evidence are obviously inconsistent with facts, or detrimental to national interest or public interest, or taken back by the party concerned with sufficient counterevidence to overturn it. Where the opposite party neither admits nor denies an alleged fact and, after the panel makes adequate explanation and inquires of it, still refuses to clearly express its admission or denial, it shall be deemed as admitting said fact.

Where a party concerned appoints an agent to appear in the invalidation procedure, admission by the agent shall be deemed as admission by the party itself, provided that admission by the agent without special authorization does not directly lead to the admission of the request for invalidation of the opposite party. If the party concerned is present and does not deny the admission by its agent, the admission shall be deemed as admission by the party itself.

Where the party concerned takes back its admission prior to the

closure of oral proceedings or, for cases without oral proceedings, prior to the decision of invalidation being made, subject to the approval by the opposite party, the Patent Reexamination Board will not recognize the legal effect of the admission. Where there is sufficient evidence to prove that the admission was made under coercion or due to serious misunderstanding and was inconsistent with facts, the Patent Reexamination Board will not recognize the legal effect of the admission.

In the invalidation procedure, acknowledgement of facts by a party concerned for reaching a mediation agreement or a compromise shall not be taken as adverse evidence against it in the subsequent proceedings of the invalidation procedure.

#### 4.3.3 Common Knowledge

The party concerned alleging that certain technical means is common knowledge in the art shall bear the burden of proof for its allegation. If the party concerned cannot produce evidence or cannot adequately explain that the technical means is common knowledge in the art, and the allegation is not acknowledged by the opposite party, the panel shall not support the allegation.

The party concerned may prove that certain technical means is common knowledge in the art with reference to the technical contents recorded in a reference book such as a textbook, a technical dictionary, or a technical manual.

#### 4.3.4 Notarial Document

Where a party concerned submits a notarial document as evidence, the facts attested in a valid notarial document shall be taken as the basis for deciding the facts of the case, unless there is counterevidence to overturn the attestation of the notarial document.

If the notarial document has serious defections in its form, e. g. , lack of seal of the notary, it shall not be taken as the basis for deciding the facts of the case.

If the conclusion of the notarial document obviously lacks grounds or there is self-contradiction in its contents, the corresponding contents shall not be taken as the basis for deciding the facts of the case. For example, where a notarial document concludes that the content of the statement of a witness is real merely on the basis of the witness's statement, the conclusion of the notarial document shall not be taken as the basis for deciding the facts of the case.

## 5. Others

### 5.1 Publication Time of Evidence on Internet

The earliest time when the public can find the information on the Internet is the publication time of the information, usually the issuance time of the information on the Internet is deemed as the publication time of the information.

### 5.2 Public Use or Oral Disclosure as Evidenced by Documentary Recordation after the Application Date

Documentary evidence recording contents of public use or oral disclosure formed on or after the application date or evidence of other forms can be used to prove public use or oral disclosure of the patent before the application date.

In determining the probative force of the evidence mentioned above, evidence formed before or on the patent publication date shall prevail over those formed after the patent publication date.

### 5.3 Consultation and Evaluation on Technical Contents or Issues

The Patent Reexamination Board may, if need be, invite the relevant organizations or experts to provide consultation opinions on the technical contents or issues involved in a case. If necessary, it may entrust a relevant organization to provide expert opinions, and the cost shall be borne by the Patent Reexamination Board or the party concerned depending on the specific circumstance of the case.

### 5.4 Handling of Articles such as Samples Submitted by the Party Concerned but not Used as Evidence

In the invalidation procedure, at the time of submitting articles such as samples not used as evidence, the party concerned is entitled to request in written form to take back the articles after the case is decided.

For request of the party concerned to take back articles, the panel shall, taking into account the needs of examination and the subsequent proceedings, decide when to allow the articles to be taken back. Where it is decided to allow the articles to be taken back, the Patent Reexamination Board shall notify the party concerned submitting the articles of the decision, and the party concerned shall take back the articles within

three months from the date of receipt of the notification. If the articles are not taken back within the time limit, or the party concerned does not request to take back at the time of submitting them, the Patent Re-examination Board shall have the right to dispose of these articles.

# Part V

# Processing of Patent Applications and Procedural Matters

# Chapter 1 Patent Application Documents and Formalities

## 1. Introduction

An applicant seeking patent protection for an invention-creation shall file an application for patent with the Patent Office in accordance with the provisions of the Patent Law and its Implementing Regulations. In the procedures of examination and approval of patent application, the applicant shall also go through a variety of matters relating to the patent application in accordance with the Patent Law and its Implementing Regulations or upon the requirements of the examiner. Patent application formalities refer to the filing of a patent application with the Patent Office and the going through of other patent-related matters by the applicant in the procedures of patent examination and approval.

The request, description, claims, drawings and abstract submitted to the Patent Office by the applicant upon filing a patent application in accordance with Article 26 or the request, drawings or photographs, and brief explanation submitted to the Patent Office by the applicant upon filing a patent application in accordance with Article 27 are referred to as patent application documents. Except for the application documents, all the other requests, statements, observations, rectification and certificates, evidence materials submitted by the applicant (or the patentee), or other parties concerned when going through the various formalities in connection with the application (or the patent) at the time of filing or thereafter are referred to as other documents.

When going through the formalities of a patent application, the corresponding documents shall be submitted, and the prescribed fees shall be paid within the prescribed time limits.

Rule 2

## 2. Form of Filing Patent Application

The formalities of a patent application shall be gone through in either written (on paper) or electronic form.

### 2.1 Written Form

Where an application is filed in written form and is accepted, the relevant documents shall be submitted in paper form in the procedures of patent examination and approval. Unless otherwise provided, the rel-

evant documents submitted in electronic form shall be deemed not to have been submitted.

The formalities gone through in manners other than in written form, such as in oral form, by phone call or in physical, or by such communication means as telegram, telex, facsimile, E-mail, etc. , shall be deemed not to have been performed, and shall have no legal effect.

### 2. 2 Electronic Form

Unless otherwise provided, where an application is filed in electronic form by an applicant and is accepted, the corresponding documents shall also be submitted in electronic form through the electronic patent application system in patent examination and approval procedures. Where the corresponding document is not in conformity with the provisions of submitting, it shall be deemed not to have been submitted.

## 3. Applicable Language

Rule 3

### 3. 1 Chinese

Except for certificates or evidence materials provided by foreign government departments or created in foreign countries, the patent application documents and other documents shall be in Chinese.

The examiner shall take the Chinese text of the patent application submitted by the applicant as the basis of examination. The foreign language text of the application submitted by the applicant at the time of filling the application shall serve as a reference for the examiner in the examination procedures and have no legal effect.

### 3. 2 Chinese Characters

The word "Chinese" mentioned in Section 3. 1 of this Chapter refers to the Chinese characters. The patent application documents and other documents shall be written in Chinese, and the words and sentences shall comply with the modern Chinese standard.

The Chinese characters in the simplified writing form published officially shall be used as the standard. The examiner may correct the variant, traditional, or non-standardized simplified forms of the characters in the application documents *ex officio*, or invite the applicant to make the correction.

### 3.3 Translation of Foreign Languages

Rule 3.1

Where application documents are written in foreign language, they shall be translated into Chinese, in which the scientific and technological terms in foreign language shall be translated into Chinese according to relevant provisions and shall be in standard terms. Where there is no unified translation in Chinese for a scientific and technological term in foreign language, the term may be translated following conventions with the original text shown in bracket following the translation. Measuring units in the description shall adopt the legal measuring units, including SI units and other selected units in China. Where necessary, other measuring units well recognized in the art may be indicated in the parentheses at the same time.

Rule 3.2

When the parties concerned submit the certifying documents and certifying materials (such as documents certifying the right of priority, documents certifying the assignment, etc.) in foreign language, the Chinese translation of the titles thereof shall also be submitted. When necessary, the examiner may invite the parties concerned to submit the Chinese translation of the full text or the abstract thereof within the specified time limit. Where the translation of the document fails to be submitted within the specified time limit, the said document shall be deemed not to have been submitted.

## 4. Standard Forms

Standard forms made by the Patent Office shall be used when going through the formalities of patent application (or patent). The standard forms shall be made, amended and published by the Patent Office according to specified format and style.

Where a document is submitted in non-standard form when going through the patent application (or patent) formalities, the examiner may issue a *Notification to Make Rectification* or a *Notification that Action Deemed Not to Have Been Made* concerning the formalities according to relevant provisions.

However, where the submitted rectification or observations are in non-standard form when the applicant replies to the *Notification to Make Rectification* or *Notification of Office Action*, the document may be deemed to have met the formal requirements provided that the application number is clearly written, indication of rectification of application documents is shown, and signatures or seals are consistent with re-

quirements.

### 4.1 Paper

The paper used for the various documents shall be pliable, sturdy, durable, smooth, lusterless and white, with quality equal to, or better than, that of the 80g offset paper.

### 4.2 Specification

The specification of the paper used for the description, drawings, claims, abstract, figure accompanying the abstract, drawings or photographs, brief explanation of application for design, and other forms shall be of 297mm × 210mm (A4).

### 4.3 Margin

For the application documents, there shall be a 25mm margin on the top(if there is a title, from the top of the title to the edge of the page) and on the left of the page respectively, and a 15mm margin on the right and at the bottom from the page number below to the edge of the page respectively.

Rule 121

## 5. Rules of Writing

### 5.1 Typewriting or Printing

The request, claims, description, abstract, the text matter of the drawings and the figure accompanying abstract, and brief explanation shall be typewritten or printed. Mathematical and chemical formula in the above-mentioned documents may be handwritten in a way as provided in map-making.

All other documents may be written in hand unless otherwise provided. However, the writing shall be neatly lettered and free from any alteration.

### 5.2 Typeface and Specification

The Song typeface, imitation Song typeface or regular script shall be used in the various documents. Running hand or other typefaces shall not be used.

The characters shall be 3.5mm to 4.5mm in height, and the line spacing shall be 2.5mm to 3.5mm.

### 5.3 Method of Writing

For all the documents, the paper shall be used on one side only and in portrait orientation unless otherwise provided. The documents shall be written from left to right, and not in multiple columns.

One document shall not contain two or more patent applications (or patents), and one page of paper shall not contain two or more kinds of documents (e.g., one page of paper shall not contain both description and claims).

### 5.4 Contents of Writing

Each item of the documents shall be filled in accurately and detailedly, and the same contents shall be filled in consistently across different items or documents. For example, the address item shall be filled in completely according to the division of the administrative region, and the postal code shall be consistent with the address; the signature or seal of the applicant shall be consistent with that filled in the applicant item.

### 5.5 Color of Typeface

The typeface shall be in black. The handwriting and printing shall be clear, solid, inerasable, and unfadable and meet the requirements of copying and scanning.

### 5.6 Numbering

Various documents shall be sequentially numbered with Arabic numerals respectively. The page number shall be in the upper center of the bottom margin of each page.

## 6. Certifying Documents

The certifying documents which are often used in the procedures of patent application approval include the non-service invention certificate, nationality certificate, habitual residence certificate, certificate of location of registration or habitual business office, certificate of qualification of applicant, certificate of the priority right (copy of the earlier application documents), certificate of assignment of the priority right, certificate of deposit of biological material sample, certificate of the alternation of the name of the applicant (or patentee) or certificate of the transfer of rights, certificate of date for mailing the document, etc.

The various certifying documents shall be provided by the competent authorities concerned or be signed by the parties concerned. For such documents, the original files shall be provided; where the copy of the certifying documents is provided, it shall be notarized or affirmed by the competent authorities with official seals affixed (except for those original files are affirmed and recorded by the Patent Office).

### 7. Number of Copies of Document

The patent application documents submitted by applicant shall be in duplicate, one original and one copy. For invention (or utility model) patent application, the request, description, drawings, claims, abstract, and figure accompanying the abstract shall be submitted in duplicate; and for a design patent application, the request, drawings or photographs, and brief explanation shall be submitted in duplicate, with the original text clearly indicated. Where there is no original indicated by the applicant, the Patent Office shall designate one as the original. Where there are different contents in the two copies, the original one shall prevail.

Unless otherwise provided in the Implementing Regulations of the Patent Law or in these Guidelines and except for the replacement sheet of the application documents, all the other documents submitted to the Patent Office(e. g. , the power of attorney, request for substantive examination, statement for change in bibliographic data, contract of assignment) shall be in one copy. Where it is necessary to transfer the documents to other parties concerned, the Patent Office may, as needed, specify the number of copies in the notification.

### 8. Signature or Seal

Rule 119. 1

The patent application documents or other documents submitted to the Patent Office shall be signed or sealed according to relevant provisions. Where an application has not been appointed to patent agency, the application shall be signed or sealed by the applicant, the patentee, other interested parties or their representatives. Where the formalities concern common rights, all the right owners shall sign or seal; where an application has been appointed to patent agency, the application shall be sealed by the patent agency. If necessary, the application shall also be signed or sealed by the applicant, the patentee, other interested parties or their representatives.

# Chapter 2 Patent-Related Fees

### 1. Time Limit for Payment of Fees

Rule 95

(1) The time limit for the payment of the filing fee is within two months from the filing date or fifteen days from the date of receipt of the notification of acceptance. The fees need to be paid in this period include the fee for claiming priority, additional fee for filing and the printing fee for the publication of a patent application for invention.

The fee for claiming priority refers to the required fee when the applicant claims the right of foreign or domestic priority. Such fee shall be calculated in accordance with the number of the earlier applications that serve as the basis of the priority.

The additional fee for filing an application refers to the required fee when the number of pages of the description (including drawings and sequence listing) of the application documents exceeds 30 or the number of claims exceeds 10. Such fee shall be calculated in accordance with the number of pages of the description or the number of claims.

The printing fee for publication refers to the required fee for the publication of the patent application for invention.

Where the filing fee (including the printing fee for publication and the additional fee for filing) is not paid or not paid in full within the prescribed time limit, the application shall be deemed to have been withdrawn. Where the fee for claiming priority is not paid or not paid in full within the prescribed time limit, the claim for right of priority shall be deemed not to have been made.

Art. 35.1
Rule 96

(2) The time limit for paying the substantive examination fee is three years from the date of filing (or from the earliest priority date where right of priority is claimed). This fee applies only to the patent applications for invention.

Rule 99.2

(3) The time limit for paying the fee to request an extension of a time limit shall be due before the date on which the corresponding time limit expires. Such fee shall be calculated according to the length of the extension requested (on a monthly basis).

Rules 6 & 99.1

(4) The time limit for paying the fee to request the restoration of right shall be due within two months from the date on which the party

concerned receives the notification confirming the loss of right issued by the Patent Office.

Art. 41. 1
Rule 96

(5) The time limit for paying the reexamination fee is three months from the date on which the applicant receives the rejection decision issued by the Patent Office.

Rules 54 & 97

(6) The time limit for paying the registration fee for granting patent right, the annual fee for the year in which the patent right is granted and the printing fee for the announcement of the grant is two months from the date on which the applicant receives the *Notification to Grant Patent Right* and the *Notification to Go through Formalities of Registration* issued by the Patent Office.

Rule 98

(7) For the time limit for paying the annual fee and the surcharge, please see Chapter 9, Section 2. 2. 1 of this Part.

Rule 99

(8) The time limit for paying the fee for a change in the bibliographic data, the fee for requesting patent evaluation report, and the fee for requesting invalidation is one month from the date on which the corresponding request is filed.

Rule 94. 1

**2. Methods of Payment and Settlement**

The fees may be paid directly to the Patent Office (including the local patent receiving agencies), or by postal or bank remittance, or in any other prescribed way. The kinds of fees collected by each local patent receiving agency shall be separately provided for.

Rule 94. 2

Where the fees are paid by postal or bank remittance, the correct application number or patent number, and the titles of the fees to be paid shall be indicated on the money order, and the password can not be set. Non-compliance with the aforesaid requirements shall be deemed that the formalities of payment have not been gone through.

The name of the person who remits the payment and the address thereof (including postal code) shall be indicated on the money order. Where there are two or more kinds of fees to be paid for the same application or patent, the title and amount of each fee shall be indicated respectively, and the sum of the amount of each fee shall be equal to the total amount of all the fees to be remitted.

Where the fees for different applications (patents) are remitted in one money order and the total amount of all the fees is less than the sum of the amount of each fee, treatment methods are as follows:

(1) where the remitter marks the sequence numbers on the application numbers (or patent numbers), the fees shall be divided in ac-

cordance with the order of labeling; or

(2) where the sequence number is not marked on the application numbers (or patent numbers) by the remitter, the fees shall be divided on the basis of the order from left to right, top to bottom.

Where part of the fees are not paid or not paid in full, the payment shall be deemed not to have been made.

Where the fees are paid by a party concerned that has no habitual business office or residence in mainland China, the payment shall be made in the designated foreign currency and through a patent agency except as otherwise provided for.

Rule 94.3

Where the fees are paid by postal remittance and the application number (or patent number) and the titles of the fees to be paid are clearly indicated on the money order, the date of remittance on the withdrawal notification issued by the post office shall be the date of payment. Where the date of remittance on the withdrawal notification issued by the post office is different from the date of remittance indicated by the postmark on the receipt of China Post, the date of remittance on the original receipt of China Post or the notarized duplicate copy submitted by the party concerned shall be the date of payment. Where the patent examiner doubts about the evidence submitted by the party concerned, he may require the party concerned to submit the certifying materials issued by the remitting post office with its official seal affixed.

Rule 94.3

Where the fees are paid by bank transfer and the application number (or patent number) and the titles of the fees to be paid are clearly indicated, the date on which the transfer of such fee is conducted shall be the date of payment. Where the party concerned disagrees with the date of payment, and submits the certifying materials issued by bank with its official seal affixed, the date of payment shall be redefined in accordance with the transfer date that affirmed in the certifying materials.

Where the fees are paid by post remittance or bank transfer, and the application number (or patent number) of the fees to be paid is not indicated on the money order, the fees shall be refunded and the payment shall be deemed not to have been made.

Where the fees cannot be refunded or no person gets the refund due to the incomplete or inaccurate information of the person who remits the payment, the fees shall be temporarily deposited in the account of Patent Office and the payment shall be deemed not to have

been made.

All of the fees shall be settled in RMB(Yuan). The fees that shall be paid in foreign currency according to relevant provisions shall be settled after the foreign currency is converted to RMB in accordance with the exchange rate as is provided for by the State on the date when the remittance is made.

### 3. Reduction and Postponement of Payment

Rule 100

Where any applicant (or patentee) has difficulties in paying the patent-related fees, he may submit a request for reduction or postponement of the payment to the Patent Office under rules of reduction and postponement of the patent-related fees.

#### 3.1 Types of Fees That Can Be Reduced or Postponed

The following fees can be reduced or postponed in payment:

(1) the filing fee (not including the printing fee for publication, the additional fee for filing an application);

(2) the substantive examination fee for the patent application for invention;

(3) the reexamination fee; and

(4) the annual fee (the annual fee for the three years starting from the year in which the patent right is granted).

#### 3.2 Formalities of Reducing and Postponing Payment

When a patent application is filed or during the procedure of examination, the applicant (or patentee) may submit a request for reduction or postponement of the required payment whose time limit does not expire.

Where the reduction or postponement of the payment is requested, a request for reduction or postponement of the payment shall be submitted, and if necessary, the certifying documents shall be additionally submitted. The request for reduction or postponement of the payment shall be signed or sealed by all the applicants (or patentees). Where a patent agency is appointed by the applicants (or the patentees) to go through the formalities of reducing and postponing payment and submit the declaration, the request for reduction or postponement of the payment may be sealed by the agency. The declaration of appointing a patent agency to go through the formalities of reducing and postponing payment, may be indicated in the power of attorney, or

may be submitted separately.

Where the request for reduction or postponement of the payment complies with the provisions, the examiner shall approve it and send a *Notification of Decision on Reduction of Fees* indicating the percentage and type of the fees to be reduced or postponed. Where the request for reduction or postponement of the payment does not comply with the provisions, the examiner shall send a *Notification of Decision on Reduction of Fees* indicating the reasons why the request is refused.

The rules of reduction and postponement of the patent-related fees should be separately issued.

## 4. Temporary Deposit and Refund of Fees

### 4.1 Temporary Deposit

Where neither a receipt can be written out nor the remittance can be refunded because of illegible handwriting or for lack of the necessary information on the money order, the money remitted shall be deposited temporarily in the bank account of the Patent Office. Where the content of the payment is clarified after the inquiry by the remitter with certifying documents, a receipt shall be written out in time or the fees shall be refunded. Where the receipt is written, the date on which the temporary deposit ends is deemed to be the date of payment. However, where evidence is submitted within two months from the receipt of the *Notification of Loss of Right* sent by the Patent Office, if it is proved by evidence that it is the fault of the bank or the post office that leads to the temporary deposit of the fees, the date of initial remittance shall be the date of payment. If the contents of the payment cannot be clarified after the three-year-long temporary deposit is made, the account shall be settled and the fees shall be handed over to the higher authority.

### 4.2 Refund

#### 4.2.1 Principles of Refund

Rule 94.4

Where any patent-related fee is paid in excess, in duplicate or in error, the party concerned may request a refund within three years from the date of payment, and the Patent Office shall refund the payment if the request complies with the relevant provisions.

#### 4.2.1.1 Circumstances of Request for Refund

(1) The fee is paid in excess: for example, where the annual fee that the party concerned shall pay is 600 Yuan, and the actual fee the party concerned has paid in specified time limit is 650 Yuan, he may request a refund of the excessive 50 Yuan.

(2) The fee is paid in duplicate: for example, each time changes in the bibliographic data are requested, the handling fee for changes in the bibliographic data, 200 Yuan, shall be paid. If the party concerned pays another 200 Yuan after he paid 200 Yuan, he may request a refund of the repeatedly paid 200 Yuan.

(3) The fee is paid in error: for example, when the party concerned wrongly specifies the fee type, or the application number (or the patent number) during payment, or the fee is not paid in full or not within the prescribed time limit which leads to loss of right, or the patent fee is paid after the loss of right, the party concerned can makes a request for refund.

#### 4.2.1.2 Circumstances of Refund on the Patent Office's Own Initiative

When the payment of fees in the following circumstances can be verified, the Patent Office shall refund the payment on its own initiative:

(1) the substantive examination fee for the patent application for invention which has been paid after the patent application is deemed to have been withdrawn or the declaration of withdrawing the patent application has been ratified, and before the Patent Office issues the *Notification of Entering the Substantive Examination Procedure of the Application;*

(2) the annual fee paid after the patent right is terminated or the decision on declaring the patent right entirely invalid is announced; or

(3) the fee for requesting the restoration of right and relevant fee paid by the party concerned where the Patent Office decides to refuse the request for restoration of right.

#### 4.2.1.3 Circumstances of Refund Not to Be Made

(1) Where the party concerned requests the refund of a fee paid in excess, in duplicate or in error after more than three years from the date on which the payment was made;

(2) where the party concerned fails to provide evidence for the payment in error; or

(3) where a fee has already been paid according to relevant provisions before the request for reduction or postponement of the payment is approved, and the party concerned requests refund of the fee.

### 4.2.2 Formalities of Refund

#### 4.2.2.1 Filing of Request for Refund

The person who requests a refund shall be the remitter of the payment. Where the applicant (or patent), the patent agency as a non-paying party requests a refund, it shall be stated that it or he commissioned by the remitter for refund.

Any request for refund shall be made in written form, and the grounds thereof and the corresponding certifying documents shall be attached, e.g., the copy of the payment receipt provided by the Patent Office, or the warrant provided by the post office or the bank, etc. The certifying documents provided by the post office or the bank shall be in the original. Where the original copy cannot be provided, the duplicate copy either notarized or affirmed by relevant authorities providing the documents with official seal affixed shall be provided.

Any request for refund shall indicate the application number (or patent number), the payment information concerning the fee to be refunded (e.g., the money order number, the amount of the fee, etc.), and information of the payee. Where the party concerned requests a refund through the post office, information of the payee shall include the name, address and postal code. Where the party concerned requests a refund through bank, information of the payee shall include the name or title, the bank's name and the account number of the bank.

#### 4.2.2.2 Handling of Refund

Where the refund is approved after check, the Patent Office shall refund according to the information of the payee indicated in the request for refund.

Where no information of the payee is indicated in the request for refund, and the person who requests a refund is the applicant (or the patentee) or the appointed patent agency, the Patent Office shall refund according to the corresponding address and title or name recorded in documents.

The examiner shall send the *Notification of Decision on Refund* when refund is completed. Where the refund shall not be approved after check, the examiner shall indicate the reasons why the refund is not approved in the *Notification of Decision on Refund*.

#### 4.2.3 Effect of Refund

The payment refunded shall be deemed not to have been made from the beginning.

#### 4.2.4 Handling under Special Circumstances

##### 4.2.4.1 Circumstances of Refund Due to Incomplete Information for Payment Caused by the Bank or Post Office

Where the refund of payment is due to lack of necessary information (e.g., application number or the type of fee) because of fault of the bank or the post office, if the party concerned has objection to the refund, he shall submit observations in written form and attach certifying documents provided by the bank or the post office with official seal affixed. The certifying documents shall include at least: the name or title of the remitter, the amount of the fee, the date of remittance, the application number (or patent number) provided when remitting, the title of the fee, and so on. In the meantime, the party concerned shall anew pay the fee that has been refunded.

Where the above requirements are satisfied, the date of original payment shall be taken as the date of the new payment. For any decision that needs to be accordingly changed, the examiner shall send a *Notification of Amendment to Decision*. Where the above requirements are not satisfied, the examiner shall send a notification to the party concerned that the fee is deemed not to have been paid.

##### 4.2.4.2 Circumstance That the Money Order Cannot Be Honored Due to the Remitter's Withdrawal of the Payment

Where the Patent Office receives the notice of withdrawal by the post office and provides the receipt and the money order cannot be honored because the remitter has withdrawn the payment, the Patent Office shall request the post office to note on the notice that the payment has been withdrawn by the remitter, with its official seal affixed.

After the post office has provided the document certifying that the payment has been withdrawn, the Patent Office shall handle it in time,

and the said fee shall be deemed not to have been paid.

### 5. Inquiry about Payment

Where a party concerned requires to inquire about the payment of a fee, if no receipt of the Patent Office has been received, a duplicate copy of the bank money order or a duplicate copy of the voucher of the postal remittance, or, if the receipt of the Patent Office has been received, a duplicate copy of the receipt from the Patent Office, shall be provided. The time limit for inquiry is one year from the date on which the fee is remitted.

### 6. Change of Fee Type

In paying the fees for the same patent application (or patent), if the type of a fee has been filled in wrongly, the party concerned making the payment may request to change the type of the fee with corresponding certifying documents attached, within the relevant time limit. The fee type may be changed after confirmation by the Patent Office. However, the fees for one application (or patent) cannot be converted to another.

Where the type of fee paid by the party concerned is obviously wrong, the examiner may change the fee type *ex officio*. Where the fee type is changed by the examiner *ex officio*, the party concerned shall be notified accordingly.

For any change in the fee type, the date of payment shall remain unchanged.

### 7. Supplemental Information for Payment

Where the fees are paid by postal or bank remittance without the required information of payment, the party concerned can provide the complete information by fax or email on the day of remittance, and the date of remittance shall be the date of payment. Where the supplement is incomplete on the day of remittance, the party concerned can provide the complete information once more, and the day on which the complete information is provided shall be the date of payment.

Where the information for payment is supplemental, the party concerned shall provide the copy of money order of the bank or a voucher of the postal remittance, the application number (or patent number), the title and the amount of each fee. In addition, the following information of the person that receives the receipts shall be provid-

ed: the title or name, address, and postal code etc. If the party concerned cannot provide the duplicate copy of the bank money order or the voucher of the postal remittance, it or he shall provide the date of remittance, the title or name of remitter, the amount of the fee and money order number, etc.

# Chapter 3 Acceptance

## 1. Location of Acceptance

The receiving department of Patent Office includes the Receiving Division of the Patent Office and the local patent receiving agencies. The Receiving Division of the Patent Office is responsible for receiving patent applications and other relevant documents. The local patent receiving agencies are responsible for receiving some certain patent applications and other relevant documents according to relevant provisions. The Patent Reexamination Board may receive documents related to the reexamination or the invalidation declarations.

The Receiving Division of the Patent Office and the local patent receiving agencies shall set service windows for receiving applications and documents. Documents that are not registered through receiving procedure shall not enter into the procedures for examination and approval.

The Patent Office shall publish the addresses of the Receiving Division of the Patent Office and the local patent receiving agencies through announcement. If the application documents or other relevant documents are sent by post or submitted directly to any individual or any department other than the Receiving Division of the Patent Office, the date of sending or submission shall have no effect of determining filing date or submission date.

## 2. Acceptance or Nonacceptance of Patent Application

### 2.1 Requirements for Acceptance

Rule 39

The Patent Office shall accept patent applications meeting the following requirements:

(1) the request shall be included in the application documents, in which the type of patent application is clear, and the name or title and address of the applicant are indicated;

(2) the description and the claims shall be included in the documents of the patent application for invention; the description, drawings of the description, and the claims shall be included in the documents of the patent application for utility model; and drawings or photographs

or brief description shall be included in the documents of the patent application for design;

(3) the application documents are typewritten or printed in Chinese. The writing and lines of the application documents shall be legible, free from alterations and neat enough for the contents of the documents to be identified. The drawings of the description of a patent application for invention or utility model and the pictures of a patent application for design shall be drafted with non-erasable ink, and free from alterations;

(4) where the applicant is a foreigner, foreign enterprise or other foreign organization, the application shall be in conformity with the provisions of Article 19. 1, and the country to which the applicant belongs shall be in conformity with the provisions of Article 18;

(5) where the applicant is an individual or enterprise or other organization of Hong Kong, Macao or Taiwan, the application shall comply with the provisions of Chapter 1, Section 6. 1. 1 of Part I.

Rule 39

### 2. 2 Circumstances of Nonacceptance

In any of the following circumstances, the Patent Office shall refuse to accept the application:

(1) where the patent application for invention does not contain a request, a description or claims; the patent application for utility model does not contain a request, a description, drawings, or claims; the patent application for design does not contain a request, drawings or photographs, or a brief description;

(2) where the application documents are not written in Chinese;

(3) where the application documents are not in conformity with the requirements of acceptance specified in Section 2. 1 (3) of this chapter.

(4) where the title or name of the applicant, or address is not indicated in the request .

Art. 18

(5) where a foreign applicant is obviously not entitled to file an application for patent due to his nationality or its residence;

Art. 19. 1

(6) where, as the first named applicant, a foreigner, foreign enterprise or other foreign organization without habitual residence or business office in Mainland China does not appoint a patent agency ;

(7) where, as the first named applicant, an individual, an enterprise or other organization from Hong Kong, Macao or Taiwan without habitual residence or business office in Mainland China does not ap-

point a patent agency ;

(8) where the application is mailed directly from a foreign country to the Patent Office;

(9) where the application is mailed directly from Hong Kong, Macao, or Taiwan to the Patent Office;

(10) where the kind of protection (patent for invention, utility model or design) of the application for a patent is not clear and definite or cannot be ascertained; or

Rule 42. 3

(11) where the divisional application changes the application type.

**2. 3 Procedures of Acceptance and Nonacceptance**

After receiving a patent application, Receiving Division of the Patent Office or the local patent receiving agencies shall review and check all of the documents, and issue *Notification of Acceptance or Notification of Nonacceptance*.

Rule 38

**2. 3. 1 Procedure of Acceptance**

Where a patent application meets the requirements of acceptance, procedure of acceptance is as follows:

(1) determining the date of receipt. According to the date on which the documents are received, the date of receipt shall be recorded in the documents to indicate the date on which the Receiving Department receives the documents;

(2) checking the number of documents. Check the total number of the documents, verify the titles and number of the application documents and other documents indicated in the request, and record the results of the check. As for patent application for invention relating to nucleotide or amino acid sequence, it shall be verified the sequence listing in a computer-readable form, such as CD-ROM or floppy disk, etc. , is submitted;

Art. 28
Rule 4. 1

(3) determining the date of filing. Where the patent application is directly submitted to the Receiving Division of the Patent Office or a local patent receiving agency, the date of receipt shall be the date of filing. Where the patent application is sent to the Receiving Division of the Patent Office or a local patent receiving agency by post, the date of mailing indicated by the postmark on the envelope shall be the date of filing; Where the postmark is illegible, the date on which the Receiving Division of the Patent Office or the local patent receiving agency

receives the application documents shall be the date of filing, and the envelope shall be kept in the file. Where the patent application is sent to the Receiving Division of the Patent Office or a local patent receiving agency by express delivery, the date of receiving shall be the date of filing. Where the patent application is sent by post or submitted directly to any department other than the Receiving Division or any individual of the Patent Office the date of sending or submission shall have no effect of determining filing date, and if the said application is transferred to the Receiving Division of the Patent Office or a local patent receiving agency, the actual receiving date on which the Receiving Division or the local patent receiving agency receives the application shall be the filing date. As for a divisional application, the filing date of the original application shall be its filing date and the date of submission of the divisional application shall be indicated in the request;

(4) assignment of the application number. A corresponding application number shall be assigned to patent applications according to the application type and the order of filing. The application number shall be stuck on the request and the folder;

(5) recording the number of the registered letter. Where the patent application is sent by the registered letter, the number of the registered letter shall be recorded on the request;

(6) examining the request for a reduction or postponement of the payment. The request for a reduction or postponement of the payment submitted with the application simultaneously shall be examined according to the rules of reduction and postponement of the patent-related fees, *Notification of Decision on Reduction of Fees* shall be made and the corresponding mark shall be indicated on the request;

(7) collecting and verifying the data. According to the request of an application, collect and verify the data, print the data verification sheet and correct the incorrect data;

(8) issuing the notification. The *Notification of Acceptance of Patent Application, Notification to Pay Filing Fees or Notification of Decision on Reduction of Fees* shall be sent to the applicant. In the *Notification of Acceptance of Patent Application,* at least the application number, date of filing, name or title of the applicant and the verification information of the documents shall be indicated. The seal of the Receiving Division of the Patent Office or the local patent receiving agency shall be affixed, and the seal of the examiner and the date of issuance of the document shall be affixed, too.

In the *Notification to Pay Filing Fees*, the filing fee, additional filing fees, other fees that the applicant is required to pay when the application is filed and the time limits for paying the fees shall be indicated, and the requirements for the payment of the fees shall also be indicated clearly. In the *Notification of Decision on Reduction of Fees*, the percentage of the reduction or postponement of the payment, the amount to be paid, the time limit and the relevant requirements for the payment shall be indicated; and

(9) Scanning the documents. The documents of a patent application that meet the requirements for acceptance shall be scanned and recorded in databases. The contents to be scanned include the application documents and other documents submitted at the time of filing. Besides, the electronic data of notifications issued by the Patent Office (e. g., *Notification of Acceptance of the Patent Application, Notification to Pay Fees* or *Notification of Decision on Reduction of Fees*) shall also be recorded in databases.

### 2.3.2 Procedure for Acceptance of Divisional Application

#### 2.3.2.1 Procedure for Acceptance of National Divisional Application

For a national divisional application, except for conducting the examination for acceptance according to the requirements for acceptance of a regular patent application, the Patent Office shall examine whether the original application number and the original date of filing are indicated in the request of the divisional application. Where the original application number is filled correctly in the request of the divisional application, but the original date of filing is not indicated, the filing date corresponding to the original application number shall be deemed to be the filing date. If the original application number is not indicated or is indicated wrongly in the request of the divisional application, the application shall be accepted as a regular patent application.

For a divisional application that meets the requirements for acceptance, the Patent Office shall accept it, assign an application number to it, and acknowledge the original filing date as its filing date. The submission date of the divisional application shall be recorded.

#### 2.3.2.2 Procedure of Acceptance for International Divisional Application Entering the National Phase

For an international application, if a divisional application is filed after it entering the national phase, in addition to conducting the examination for acceptance according to the requirements for acceptance of a regular patent application, the examiner shall verify whether the original date of filing and the original application number are indicated in the request of the divisional application. The said original date of filing shall be the filing date of the international application, and the original application number is the application number assigned by the Patent Office when it enters into the national phase, and the international application number of the original application shall be indicated in the following brackets as well.

### 2.3.3 Procedure of Nonacceptance

Where a patent application fails to meet the requirements for acceptance, procedure of nonacceptance is as follows:

(1) determining the receiving date. According to the date on which the documents are received, the receiving date shall be recorded in the documents to indicate the date on which the Receiving Department receives the application documents;

(2) collecting data and issuing *Notification of Nonacceptance*. Collect the data and make the *Notification of Nonacceptance of the Documents* and send to the party concerned. In the notification, at least the name or title of the party concerned, detailed address, reasons for nonacceptance, and the number of nonacceptance file shall be indicated and the seal of the Receiving Division of the Patent Office or the local receiving agencies shall be affixed with the signature of the examiner and the date of issuance of the notification; and

(3) the application documents that do not comply with acceptance requirements shall be kept in archives for inquiry, and shall not be returned to the party concerned in principle.

Where patent applications that are directly submitted to the Receiving Division of the Patent Office or to the local patent receiving agencies fail to meet the requirements for acceptance, the reasons of nonacceptance shall be explained directly to the party concerned, and the applications shall be refused.

## 3. Acceptance or Nonacceptance of Other Documents

### 3.1 Requirements for Acceptance of Other Documents

Any other documents, submitted by the parties concerned after filing date, which meet the following requirements, the said documents shall be accepted by the Patent Office:

(1) the application number (or the patent number) of the patent application is indicated in the document and relate to only one patent application (or patent); and

(2) the various documents are written in clear and neat Chinese and are non-erasable. For certifying materials in foreign language, a list of the materials in Chinese shall be attached.

When other documents associated with the patent application submitted by the applicant (or the patentee), or any other parties concerned are received by the Receiving Division of the Patent Office, the local patent receiving agencies or the Patent Reexamination Board, the said Division, agencies or Board shall check and verify all the documents.

### 3.2 Procedure for Acceptance of Other Documents

Where the other documents meet the requirements for acceptance, the procedures of acceptance is as follows:

(1) determining the receiving date. According to the date on which the documents are received, the receiving date shall be recorded in the documents to indicate the date on which the Receiving Department receives the said documents;

(2) checking the number of documents. Check the number of all the documents; verify the titles and number of the documents indicated by the party concerned on the list; and record the result of the verification on the list. Where no list is provided by the party concerned, the annex indicated in the principal document shall be verified and the result of verification shall be recorded in the principal document. Where the application number of the document submitted is incorrect, if the correct application number can be figured out on the basis of other information, the Receiving Division may, *ex officio,* make a correction. Otherwise, the documents shall not be accepted;

(3) determining the submission date. For determining the submission date of other documents, see Section 2.3.1(3) of this chapter. The

submission date of the documents shall be recorded in the principal document;

(4) giving the receipt for receiving documents. Where the parties concerned submit the documents at the Reception Windows with two copies of the list of the documents attached, the duplicate copy of the list shall be recorded with the receiving date and indicated with the result of the verification of documents and send to the parties concerned as a receipt, and the original copy of the list shall be kept in the folder with the seal of the examiner affixed and the date of issuance of the document indicated. Where the parties concerned submit the documents without any list of documents attached or with only one copy of the list attached, no receipt for the documents shall be provided. Where the parties concerned submit the documents by post, the Patent Office shall not provide the receipt for the documents.

Where the patent agency submits documents in batch and provides the list of documents, after verified and sealed by the Receiving Department, one copy of the list shall be sent to the patent agency as a receipt, and the other copy shall be kept in archives for reference; and

(5) collecting the data and scanning the documents. All relevant information, e. g. , type, number of copies, number of pages, and code of documents, shall be collected, and the documents shall be scanned and recorded in databases.

### 3. 3 Procedure for Nonacceptance of Other Documents

Where the other documents fail to meet the requirements for acceptance, these documents shall be handled in accordance with the procedure as set forth in section 2. 3. 3 of this Chapter and issue the *Notification of Nonacceptance of Documents*.

## 4. Correction of Date of Filing

Where the applicant, after receiving the *Notification of Acceptance of Patent Application*, believes that the date of filing recorded in the notification is not the same as the date of mailing the application documents, it or he may request the Patent Office to correct the date of filing.

After receiving the request to correct the date of filing from the applicant, the Receiving Division of the Patent Office shall check whether such request meets the following requirements:

(1) whether it is submitted within two months from the date of

submitting the patent application documents or within one month from the date on which the applicant receives the *Notification of Acceptance of the Patent Application*; and

(2) whether it is attached with the valid certificates of the mailing date provided by the post office that receives and delivers the patent application documents, and the number of the registered mail indicated in the certificates is identical with the registered number recorded in the request.

Where the above-mentioned requirements are met, the date of filing shall be corrected; otherwise, the date of filing shall not be changed.

Where it is decided to correct the date of filing, the *Notification of Re-determination of Filling Date* shall be made, the notification shall be sent to the applicant, and the relevant data shall be amended; where it is decided not to change the date of filing, the *Notification that Request Deemed Not to Have Been Made* shall be issued to the applicant requesting for correction of the date of filing, the reasons therefore shall be stated.

Where the party concerned has objection to the submission date of other documents determined by the Patent Office, he or it shall provide the return receipt issued by the Patent Office, the certificate provided by the post office in charge of mail receiving and delivering, or other valid certifying materials. Where the materials meet the requirements, the Patent Office shall re-determine the submission date of the other documents and amend the relevant data.

### 5. Correction of Mistakes in Procedure of Acceptance

Once any mistakes related to acceptance are found, the Receiving Division of the Patent Office or the local receiving agencies shall correct them promptly, the *Notification of Rectifications and Corrections* shall be issued, and the relevant data shall be amended. The documents that are sent to other examination departments of the Patent Office by mistake shall be returned to the Receiving Division in time and the reason therefore shall be stated.

### 6. Inquiry

A register of receiving documents is established in the Receiving Division of the Patent Office. Unless the party concerned can provide the receipt for the receiving of the document or the *Notification of*

*Acceptance* issued by the Patent Office or the local patent receiving agencies, the contents contained in the register shall prevail.

The time limit for inquiry is within one year from the date on which the document is submitted.

# Chapter 4 Patent Application Files

## 1. Patent Application Files and its Composition Thereof

The files of a patent application are a collection of the documents of a patent application accumulated and kept as the original record for verification purpose in the procedures of examination and approval and in the valid term of the patent right. There are two kinds of patent application files, that is, paper files (dossier) and electronic files. Patent application files are the basis for examination of the patent application and decision-making of Patent Office.

## 2. Dossier

Dossier includes a folder and various documents therein.

### 2.1 Folder

A folder is used to keep the documents and record the important contents of the file. Therefore, it is an important part of the file as a whole.

When the folder has to be changed due to natural or intentional damage, the complete record on the folder shall be moved to the new folder, and the old folder shall be kept with the file and shall not be destroyed.

### 2.2 Documents

The documents in the patent application file are mainly from the following sources:

(1) the patent application documents and other documents submitted by the applicant when filing the application;

(2) the various documents submitted by the applicant according to the requirement of the examiner in the course of examination of the patent application;

(3) the documents and certifying materials submitted by the applicant in going through formalities on his own initiative after filing the patent application;

(4) the various documents concerning the patent application (or patent) submitted by any parties and the documents produced by the

People's Courts etc. after examining these documents in the course of examination of the patent application or in the valid term of the patent right; and

(5) other relevant documents.

The above-mentioned documents, after being properly handled, established and filed, constitute important components of the file.

### 2.3 Establishment of Files

During establishment of files, the following principles shall be complied with:

(1) principle of authenticity. The collection shall be the original documents submitted by the applicant (or patentee), other parties concerned, etc., during the procedures of filing, examination and approval and various legal proceedings after grant of patent right. These documents shall not be replaced, removed, supplemented or altered;

(2) principle of one file for one application. One patent application shall have one independent file with the application number as the number of the file, which shall be used for the entire existence of the file.

Where the same applicant (or patentee) intends to go through the identical formalities in respect of several patent applications (or patents), he shall submit a request for each of the patent applications (or patents) respectively and the related documents shall be placed in their respective files. The applicant (or patentee) shall not leave out any document by using "see..." for cross-reference. Where patent applications are changed in the name or title of the applicant (or patentee) or the transfer of right in batch, the duplicate copy of the certifying document affirmed by the Patent Office shall has the same effect as the original one; and

(3) Principle of chronological order. Where a party concerned goes through the formalities before the Patent Office in accordance with the law, the Patent Office shall handle and place the various submitted documents in file in time.

The documents in a patent application file shall be placed in chronological order according to the time when they are handled.

## 3. Electronic Files

The establishment of electronic files shall comply with the principles in Section 2.3 of this chapter, and the following contents shall be

included:

(1) the graphic files and coded files made by the Patent Office on the basis of paper documents submitted by the party concerned;

(2) the sequence listing of the nucleotide or amino acid submitted by the party concerned in accordance with the prescribed form;

(3) the notifications, decisions (such as, *Notification of Rectification*, *Decision of Rejection*, etc.) and other documents (such as pamphlet of application for patent for invention, pamphlet of patent for invention, pamphlet of patent for utility model or pamphlet of patent for design, etc.) made by the Patent Office or the Patent Reexamination Board in the course of the patent examination and approval, reexamination or invalidation;

(4) data of patent-related fees;

(5) the historic record of the legal status and changes thereof related to the filing, examination and approval of patent application;

(6) the historic record of all the bibliographic data and changes thereof in the course of the patent examination and approval;

(7) electronic documents submitted by the party concerned through electronic application;

(8) the evaluation report of patent; and

(9) the symbol of classification, related examination departments, various marks (such as mark of priority, mark of request for substantive examination or mark of confidentiality, etc.);

## 4. Legal Effect

The patent application file is a true record of the legal procedures of the examination and approval, reexamination and invalidation declaration of the patent, as well as the relevant procedures resulting from disputes over ownership of right.

## 5. Consultation and Photocopying

### 5.1 Principles of Consultation and Photocopying

Art. 21.3

(1) Until the publication of a patent application for invention and the announcement of the grant of patent right for utility model or design, the Patent Office is liable to keep them in confidential. In this period, the requester for consultation or photocopying is limited only to the applicant and agent thereof;

(2) any person may file a request with the Patent Office to consult

or photocopy the file of a published patent application for invention and the file of the patent application for granted utility model or design;

Rule 118.1

(3) in principle, the files of reexamination or invalidation cases that have been concluded may be consulted or copied;

(4) the Patent Office and the Patent Reexamination Board shall bear the responsibility to keep the files of reexamination or invalidation cases that have not been closed in confidential. For the documents in the procedure of reexamination or invalidation, the requester for consultation or photocopying is limited only to the party concerned of the said case;

(5) where the conclusion of the reexamination or invalidation case is that the request is deemed not to have been filed, not accepted, actively withdrawn, or deemed to have been withdrawn, for the documents in the procedure of reexamination or invalidation, the requester for consultation or photocopying is limited only to the party concerned of the said case;

(6) in principle, various documents provided by the party concerned upon the request of the Patent Office or the Patent Reexamination Board in need of examination may be consulted or copied. However, the above provisions do not apply if consultation or photocopying may cause damage to the legitimate interest of the party concerned, or involve privacy or trade secrets, etc; and

(7) relevant documents concerning the interests of the State or being kept in files for the internal operation or management needs of the Patent Office or the Patent Reexamination Board shall not be consulted or copied.

### 5.2 Contents Allowed for Consultation and Photocopying

(1) For a patent application for invention before publication and a patent application for utility model or design before the announcement of the grant of patent right, the applicant or agent thereof may consult or photocopy the relevant contents in the said patent application files, including the application documents, the formality documents directly relating to the application, notifications and decisions sent to the applicant in the preliminary examination procedure, and the text of the observations submitted by the applicant in response to the notifications;

(2) for the file of a patent application for invention which has been published and whose grant of patent right has not been an-

nounced, the contents in the file which may be consulted and copied relate to those before the date of the publication, including the application documents, formality documents directly relating to the application, publication documents, notifications and decisions sent to the applicant in the preliminary examination procedure and the text of the observations submitted by the applicant in response to the notifications;

Rule 118.1

(3) for the file of a patent application for which grant of patent right has been announced, the contents in the file which may be consulted and copied include the application documents, the formality documents directly relating to the application, pamphlet of patent application for invention, pamphlet of patent for invention, pamphlet of patent for utility model or pamphlet of patent for design, Patent Register, and evaluation report of patent, and the various notifications and decisions issued by the Patent Office or the Patent Reexamination Board to the applicant or parties concerned, and the text of the observations submitted by the applicant or the parties concerned in response to the notifications in the examination proceedings which have been closed (including procedures of preliminary examination, substantive examination, reexamination and invalidation, etc.);

(4) for the file of patent applications which are still in reexamination or invalidation procedure and have not been closed, where consultation and photocopying of the file is necessary due to special needs, the contents in the file before starting the current procedure may be consulted and copied upon the approval of the competent authorities in accordance with the relevant provisions of above-mentioned items (1) and (2); and

(5) except for the above-mentioned contents mentioned above, consultation or photocopying of other documents shall not be allowed.

### 5.3 Procedures for Consultation and Photocopying

The following procedures shall be followed for consultation and photocopying of the documents in the file of a patent application:

(1) the requester shall file a request in written form and pay the prescribed fees;

(2) after having verified and checked the relevant certificates or identification provided by the requester, a staff member of the Patent Office shall retrieve the file from the department where the file is kept and sort out the file in accordance with the provisions of Section 5.2

of this Chapter and take out the documents that are not allowed to be consulted and copied;

(3) the staff member of the Patent Office makes an appointment with the requester and issues a *Notification of Approval for Consultation;*

(4) the requester for consultation may, after producing the *Notification of Approval for Consultation*, consult the documents at the designated place and photocopy the documents as needed; and

(5) the staff member of the Patent Office shall rearrange the patent application file that has been consulted, put in the file the original copy of the certificates for consultation and the duplicate copy of the identification of the consulter, and return the file to the department concerned.

## 6. Preservation Period and Destruction of File

Rule 118.2 & .3

### 6.1 Preservation Period

The files of the closed cases are divided into two categories: files of patent applications that are closed without being granted a patent right (having been deemed to have been withdrawn, having been withdrawn or having been rejected) and files of patent applications that are closed after being granted a patent right (having been deemed to have abandoned the entitlement to patent, patent right having been abandoned on the patentee's own initiative, termination of the patent right due to nonpayment of the annual fee, expiration of the patent right, patent right to be announced completely invalidated, etc.).

The preservation period for the ungranted closed files of patent applications is no less than two years, usually three years, and for the granted closed files of patent applications is no less than three years, usually five years, from the closing date of the relevant examination procedure.

The preservation period for the files of the original application withdivisional applications shall start from the last closing date of the divisional applications.

The preservation period for the files of patent applications upon which a *Notification of Nonacceptance* has been issued is one year, calculated from the date on which the *Notification of Nonacceptance* is issued.

### 6.2 Destruction

Before destruction, a list of destructed files shall be created on the computer. The list shall include the file number, the basic bibliographic data and the date of destruction of each file to be destroyed. After the Commissioner in charge approves the destruction, the department in charge of keeping the files shall execute the work of destruction.

# Chapter 5 Confidentiality Examination of Patent Application to Be Kept Secret and Patent Application to Be Filed Abroad

## 1. Scope of Contents to Be Kept Secret

The scope of patent applications to be kept secret as provided for in Article 4 covers both inventions-creations relating to the security or other vital interests of the State.

According to Rule 7. 1, where any patent application received by the Patent Office relates to the interests concerning national defense and is required to be kept secret, the application shall be promptly transferred to the patent department of national defense to carry out the examination.

According to Rule 7. 2, Where the Patent Office finds that a patent application for invention or for utility model filed with it relates to the security or other vital interests of the State other than interests concerning national defense and is required to be kept secret, it shall promptly make a decision to handle it as a patent application to be kept secret, and notify the applicant accordingly.

## 2. Criteria for Keeping Patent Application Secret

For the criteria to be observed for an application to be kept secret, the relevant provisions provided by the competent departments of the State shall apply.

## 3. Determination of Secrecy of Patent Application

### 3.1 Determination of Secrecy Request Filed by Applicant

#### 3.1.1 Filing of Secrecy Request

Where the applicant believes that its or his patent application for invention or for utility model relates to the security or other vital interests of the State and is required to be kept secret, it or he shall indicate in the request to keep the application secret when filing the patent application, and shall submit the application document in the form of pa-

per. The applicant may also request to keep the application secret before the patent application for invention entering into the phase of preparation for publication, or before the patent application for utility model entering into the phase of preparation for announcement.

Where the applicant, before submitting the secrecy request, determines that its or his application relates to the security or other vital interests of the State and is required to be kept secret, it or he shall submit relevant documents provided by the competent departments of the State in which the level of secrecy is determined.

### 3.1.2 Determination of Keeping Patent Application Secret

The examiner shall examine the patent application in accordance with the criteria for keeping patent application secret, and determine whether or not it is necessary to keep the application secret depending on the different circumstances.

Rule 7.1

(1) Where the contents of the patent application relate to the interests of national defense, the National Defense Patent Office shall determine the secrecy. Where the application is required to be kept secret, it shall be promptly transferred to the National Defense Patent Office to carry out the examination, and the examiner shall issue *the Notification of Transfer of Patent Application to National Defense Patent Office*. Where the application is not required to be kept secret, the examiner shall issue *the Notification of Decision on Secrecy* to notify the applicant that the patent application is not to be kept secret and will be handled as a regular patent application.

Rule 7.2

(2) Where the contents of the patent application for invention or for utility model relate to the security or other vital interests of the State other than interests of national defense, the Patent Office shall determine the secrecy, and if necessary, technical experts in related fields may be invited to assist in the determination. The examiner issues *the Notification of Decision on Secrecy* in accordance with the determined results of secrecy. Where the application is required to be kept secret, the applicant shall be notified that the patent application is to be kept secret and shall be handled as a patent application to be kept secret. Where the application is not required to be kept secret, the applicant shall be notified that the patent application is not to be kept secret, and will be handled as a regular patent application.

### 3.2 Secrecy Determined by Patent Office *Ex Officio*

When classifying, the classification examiner shall screen out the patent application for invention or for utility model that may relates to the security or other vital interests of the State but no secrecy request is made by the applicant. The examiner shall determine the secrecy of said patent application in accordance with the provisions in Section 3.1.2 of this Chapter.

Where an electronic application is determined as a patent application to be kept secret, and if it relates to the security or other vital interests of the State and is required to be kept secret, the examiner shall transform the application into the form of paper and continue the examination, and notify the applicant accordingly. The applicant shall submit all sorts of documents in form of paper to the Patent Office or the National Defense Patent Office hereafter, and shall not submit any document through the electronic patent application system.

Rule 7

## 4. Procedures of Examination for Patent Application to Be Kept Secret

Rule 55

(1) Where any patent application relates to the interests concerning national defense and is required to be kept secret, the application shall be examined by the National Defense Patent Office. Where no grounds for rejection have been found after the examination, the Patent Office shall make a decision of grant of national defense patent right on the basis of the examination observations made by the National Defense Patent Office, entrust the National Defense Patent Office to issue the national defense patent certificate, and announce the patent number, the filing date and the date of granting the patent right in the Patent Gazette.

Where the Patent Reexamination Board of National Defense makes a decision of declaring the invalidity of the national defense patent right, the Patent Office shall announce the patent number, the date of granting the patent right, the number and the date of the decision on invalidity in the Patent Gazette.

(2) Where any patent application for invention or for utility model relates to the security or other vital interests of the State other than the interests concerning national defense and is required to be kept secret, it shall be examined and administered by the Patent Office according to the following procedures.

The examiner shall label the file of the patent application determined to be kept secret as secrecy, and keep it under secrecy management until the decision on declassification is made.

Both the preliminary examination and the substantive examination on the patent application to be kept secret shall be conducted by the examiners designated by the Patent Office.

Concerning a patent application for invention, the preliminary examination and the substantive examination shall be conducted in accordance with the criteria identical with those for regular patent applications for invention. After passing through the preliminary examination, the patent application to be kept secret shall not be published, and shall directly enter into the substantive examination stage if the request for substantive examination is in conformity with the provisions. Where no grounds for rejection have been found after the substantive examination, a decision to grant the patent right for invention to be kept secret shall be made, and *the Notification to Grant Patent Right for Invention* and *the Notification to Go through Formalities of Registration* shall be issued.

Concerning a patent application for utility model, the preliminary examination shall be conducted in accordance with the criteria identical with those for regular patent applications for utility model. Where no grounds for rejection have been found after the preliminary examination, a decision to grant the patent right for utility model to be kept secret shall be made, and *the Notification to Grant Patent Right for Utility Model* and *the Notification to Go through Formalities of Registration* shall be issued.

The announcement of grant of patent right to patent applications to be kept secret shall include only the patent number, the filing date, and the date of the announcement.

## 5. Declassification Procedures of Patent Applications (or Patents)

### 5.1 Request for Declassification by Applicant (or Patentee)

The applicant of a patent application to be kept secret or the patentee of a patent to be kept secret may request for declassification in written form. If the applicant (or patentee), when requesting secrecy, submits relevant documents from the competent departments of the State determining the level of secrecy, he shall provide a certifying document of approval of declassification from the original competent

departments that determine the level of secrecy when requesting for declassification.

The Patent Office shall make decision on declassification of patent application (or patent) to be kept secret requested for declassification, and shall notify the applicants of the results.

### 5.2 Regular Declassification by Patent Office

The Patent Office shall conduct a review on the patent applications (or patents) to be kept secret every two years and shall notify the applicants of declassification as to the applications (or patents) which are no longer necessary to be kept secret.

### 5.3 Processing after Declassification

The examiner shall make a label of declassification for the patent application (or patent) that has been declassified. A patent application for invention, after declassification, shall be examined and administered as a regular patent application for invention if the patent right has not yet been granted; where it meets the conditions for publication, the application shall be published, and the pamphlet of the patent application for invention shall also be published. A patent application for utility model, after declassification, shall be examined and administered as a regular patent application for utility model if the patent right has not yet been granted.

Where a patent for invention or for utility model is declassified, the decision of declassification shall be announced, and the pamphlet of the patent for invention or for utility model shall be published, and the patent shall be administered as a regular patent.

## 6. Confidentiality Examination of Patent Application to Be Filed Abroad

Article 20.1 stipulates that where any entity or individual intends to file an application for patent abroad with any invention or utility model developed in China, it or he shall file it in advance with the Patent Office for confidentiality examination.

Article 20.4 stipulates that for an invention or utility model, if a patent application has been filed in a foreign country in violation of the provisions of the first paragraph of this Article, it shall not be granted patent right while filing application for patent in China.

In accordance with Rule 8, where any entity or individual intends

to file an application for patent abroad with any invention or utility model developed in China, it or he shall request, by one of the following manners, the Patent Office to conduct confidentiality examination:

(1) where anyone intends to file an application for patent directly in a foreign country or an international patent application with a relevant foreign organization, it or he shall file the request for confidentiality examination in advance with the Patent Office and describe in detail the related technical solution;

(2) where after having filed an application for patent with the Patent Office, anyone intends to file an application for patent in a foreign country or an international patent application with a relevant foreign organization, it or he shall file a request for confidentiality examination with the Patent Office before filing the application for patent in a foreign country or the international patent application with the relevant foreign organization;

Where anyone files an international patent application with the Patent Office, it or he shall be deemed to have simultaneously filed a request for the confidentiality examination.

Said filing an application for patent abroad, mentioned in the above provisions, refers to filing a patent application with the patent administration department established by a foreign country or an intergovernmental patent cooperation organization. Filing an international patent application with a relevant foreign organization refers to filing of an international patent application with the patent administration department established by a foreign country or an intergovernmental patent cooperation organization, or the International Bureau of the World Intellectual Property Organization designated as the PCT Receiving Office.

### 6.1 Confidentiality Examination for Patent Application Intended to Be Filed Abroad Directly

#### 6.1.1 Filing of Request for Confidentiality Examination

Rule 8.2

The documents for the request for the confidentiality examination of the patent application to be filed abroad shall include *the Request for Confidentiality Examination of Patent Application to Be Filed Abroad* and the description of the technical solution. The Request and the description of the technical solution shall be in Chinese. The person making the request may submit the corresponding documents in foreign

languages for the examiner's reference. The description of the technical solution shall be identical with the contents of the patent application to be filed abroad. The description of the technical solution may be drafted according to the provisions of Rule 17, and shall be in conformity with other provisions in Chapter 1 of this Part.

### 6.1.2 Confidentiality Examination

The examiner conducts the preliminary confidentiality examination to the documents for the request for the confidentiality examination of the patent application to be filed abroad. Where the form of the documents for the request does not comply with the provisions, the examiner shall notify the person making the request that the request for confidentiality examination is deemed not to have been made, and the person making the request may submit a request for the confidentiality examination of the patent application to be filed abroad again as required. Where the technical solution is obviously not necessary to be kept secret, the examiner shall promptly notify the person making the request that it or he may file a patent application abroad. Where the technical solution may be required to be kept secret, the examiner shall notify the person making the request that further confidentiality examination shall be conducted and the patent application to be filed abroad shall be suspended. The examiner shall issue *the Notification of Confidentiality Examination of Patent Application to Be Filed Abroad,* and inform the person making the request of said examination results.

Rule 9.1

If the person making the request fails to receive *the Notification of Confidentiality Examination of Patent Application to Be Filed Abroad* within 4 months from the filing date of its or his request, it or he may file a patent application in respect of the technical solution abroad.

Rule 9.2

Where the person making the request is notified to suspend the patent application to be filed abroad, the examiner shall conduct further confidentiality examination, and if necessary, may invite technical experts in related fields to assist in the examination. The examiner shall issue *the Decision on Confidentiality Examination of Patent Application to Be Filed Abroad* based on the conclusions of the confidentiality examination, and notify the person making the request of the examination results on whether a patent application in respect of the technical solution to be filed abroad is permitted.

If the person making the request fails to receive *the Decision on Confidentiality Examination of Patent Application to Be Filed Abroad*

within 6 months from the filing date of its or his request, it or he may file a patent application in respect of the technical solution abroad.

"The applicant fails to receive the notification or decision within 4 or 6 months from the filing date of its or his request" said in Rule 9 refers to that the date on which the notification or decision issued by the Patent Office is presumably received is not within the prescribed time period.

### 6.2 Confidentiality Examination of Patent Application to Be Filed Abroad after Filing a Patent Application

#### 6.2.1 Filing of Request for Confidentiality Examination

Rule 8.2

Where the applicant intends to file a patent application abroad after filing a patent application with the Patent Office, it or he shall, at or after the filing date of the application, file the request for the confidentiality examination of the patent application to be filed abroad. Where the applicant fails to make a request as required in the above provisions, the request shall be deemed not to have been made. The contents of the patent application filed abroad shall be identical with those in said patent application.

#### 6.2.2 Confidentiality Examination

Concerning the patent application where a request for the confidentiality examination of the patent application to be filed abroad is filed, the examiner shall conduct the confidentiality examination with reference to the provisions of Section 6.1.2 of this Chapter.

### 6.3 Confidentiality Examination of International Application

Rule 8.2

#### 6.3.1 Filing of Request for Confidentiality Examination

Where the applicant files an international application with the Patent Office, it or he shall be deemed to have filed simultaneously a request for the confidentiality examination of the patent application to be filed abroad.

#### 6.3.2 Confidentiality Examination

Where the international application is not necessary to be kept secret, the examiner shall handle the international application in accordance with the regular procedure of the international phase. Where the

international application is necessary to be kept secret, the examiner shall issue *the Notification of Not Forwarding Record Copy and Search Copy for National Security Reasons* within 3 months from the filing date, and notify the applicant and the International Bureau that the international application will not be handled as international application, and terminate the procedure of the international phase. Where the applicant receives said notification, it or he shall not file a patent application abroad in respect of the contents of said application.

# Chapter 6 Notification and Decision

## 1. Production of Notification and Decision

### 1.1 Notification and Decision

During the procedures of the examination and approval, the reexamination and invalidation of a patent application, and other procedures prescribed in the Patent Law and its Implementing Regulations, various notifications and decisions shall be made by the examiner under different circumstances. These notifications and decisions principally include *Notification of Acceptance, Notification of an Office Action, Notification to Make Rectification, Notification of Passing Examination on Formalities, Notification that Application Deemed to be Withdrawn, Notification of Decision on Request for Restoration of Right, Notification before Expiration of Time Limit of Request for Substantive Examination of the Application for Invention, Notification to Pay the Fees, Notification of Decision on Reduction of Fees, Notification of Passing Preliminary Examination of the Application for Invention, Notification of Publication of the Application for Invention, Notification of Entering the Substantive Examination Procedure of the Application for Invention, Notification to Grant Patent Right for Invention, Notification to Grant Patent Right for Utility Model , Notification to Grant Patent Right for Design, Notification to Go through Formalities of Registration, Notification that Entitlement to Patent Deemed Abandoned, Notification of Termination of Patent Right, Decision of Rejection, Reexamination Decision, and Examination Decision on Request For Invalidation, etc.*

### 1.2 Drafting of Notifications and Decisions

The drafting of notifications or decisions shall comply with the relevant provisions of the Patent Law, its Implementing Regulations, and these Guidelines.

Unless specifically provided for in other Sections or Chapters of these Guidelines, a notification or decision shall generally include the information of addressee, bibliographic data, contents of the notification or decision, signature and/or seal, and date of issuance of the document, wherein,

(1) the information of addressee includes the address, postal code, and name of the addressee;

(2) the bibliographic data includes application number (or patent number), title of the invention-creation, the names of all the applicants (or patentees), and titles or names of all the petitioners if the notifications are in the invalidation procedure or suspension procedure;

(3) contents of the notification or decision includes the title and text of the notification or decision. Where the examiner makes the notification or decision against the party concerned, the reasons shall be stated, and the follow-up legal procedure shall be indicated if necessary; and

(4) signature and/or seal. The notification or decision shall be signed or sealed by the examiner. When it is necessary to be checked, it shall also be signed or sealed by the checking person. The notification or decision issued shall be affixed with the examination seal of the State Intellectual Property Office or the Patent Reexamination Board.

## 2. Delivery of Notification and Decision

Rule 4

### 2.1 Manners of Delivery

#### 2.1.1 Delivery by Post

Delivery by post refers to sending the notification or decision to the party concerned through the post office. Unless otherwise provided, documents shall be sent by registered mail, and the registration number, the address and name of the addressee, the type of document, the application number of the patent application concerned, the date of issuance of the document and the department issuing the document shall be recorded in the computer system. When a mail is returned, the date of return shall be recorded.

#### 2.1.2 Delivery in Person

Upon the approval of the Patent Office, the patent agency may receive the notification or decision at a place and time as designated by the Patent Office. In special circumstances, upon the approval of the Patent Office, the party concerned may also receive the notification or decision by himself at a place and time as designated by the Patent Office.

Except for delivery in person of a *Notification of Acceptance* or the receipt for documents at the Receiving Office, delivery in person of all other documents shall go through the formalities of registration and signature. In special circumstances, the party concerned shall be invited to sign or seal on the file of the application, and the type, number, and issuing authority of the identity certificate of the party concerned shall be recorded.

#### 2.1.3 Delivery by Electronic Means

For an application filed in electronic form, where various notifications, decisions and other documents issued by the Patent Office to the applicant are in electronic form, the applicant shall receive them according to the approaches prescribed by the user registration agreement on use of the electronic patent application system.

#### 2.1.4 Delivery by Public Notice

The examiner shall check the records when the notifications or decisions issued by the Patent Office are returned. If it is affirmed that the documents can not be sent by post again for the reason of ambiguity of the postal address or for other reasons, the party concerned shall be notified by public notice in the Patent Gazette. At the expiration of one month from the date of the public notice, the document shall be deemed to have been delivered.

### 2.2 Addressee

#### 2.2.1 Where No Patent Agency Being Appointed by the Party Concerned

Where no patent agency is appointed by the party concerned, the addressee of the notification or decision shall be the contact person filled in the request. Where no contact person is filled in the request, the addressee shall be the party concerned. Where there are two or more parties concerned, if a party concerned who is not signed first in the request is declared to be a representative, the addressee shall be the representative; otherwise, the addressee shall be the party concerned signed first in the request.

### 2.2.2 Where the Party Concerned Having Appointed a Patent Agency

Where a patent agency is appointed by the party concerned, the addressee of notifications or decisions shall be the patent agent designated by the said patent agency. Where two patent agents are designated, the addressees shall be the two patent agents.

### 2.2.3 Other Circumstances

Where the party concerned is of civil disability, on condition that the Patent Office is so notified, the addressee of the notification and decision shall be the legal guardian or legal agent.

Rule 4

## 2.3 Date of Delivery

### 2.3.1 Delivery by Post, Delivery in Person and Delivery by Electronic Means

Where a notification or decision is delivered by post, in person or by electronic means, the 16th day from the date of mailing shall be the date on which the party concerned presumably receives the notification or decision. For the notification or decision delivered by post, where the party concerned submits evidence proving that the actual date of receipt is later than the presumed date of receipt, the actual date of receipt shall be the date of delivery.

### 2.3.2 Delivery by Public Notice

Where a notification or decision is delivered to the party concerned by public notice in the Patent Gazette, the date of expiration of one month from the date of publication of the notice shall be taken as the date on which the notification or decision is received. The party concerned may provide a detailed address and request for a second delivery by post after noting the notice, but the date on which the notification or decision is received shall remain to be the date of expiration of one month from the date of publication of the notice.

## 3. Handling of Returned Documents and Inquiry of Documents

### 3.1 Handling of Returned Documents

The notifications or decisions that are delivered by post and returned shall be recorded in computer by the department in charge of issuance of documents and then be transferred to the relevant department to be handled.

In handling the returned documents, the examiner shall first analyze and identify the reason of the mail being returned on the basis of the various documents submitted by the applicant and his patent agency in the application file. Where the correct address and addressee can be redetermined, the documents shall be sent again to the address and addressee corrected.

If, after the handling, the documents that are returned can not be sent by post again or are returned again, where necessary, the documents shall be delivered by public notice depending on the nature of the notification and decision.

The documents that are returned (together with the envelope) shall be put into the file.

### 3.2 Inquiry of Documents

Where the party concerned states that he has not received certain notification or decision from the Patent Office, the department which handle the returned documents shall make an inquiry of it. Such inquiry shall begin with the department in charge of the issuance of documents in the Patent Office, and the party concerned shall be notified of the result of the inquiry (including date of issuance, registered number and addressee of the notification or decision) by the department which handles the returned documents.

Where the party concerned requires to further inquire the delivery of the document, he shall go through the formalities of post road inquiry. The department in charge of the issuance of documents shall, via the local post office, consult the post office located in the place where the addressee lives. Where the result of the inquiry reveals that the responsibility of nondelivery of the document rests on the Patent Office or the post office, the notification or decision shall be sent again with a new date of issuance of the document. Where the result of the inquiry reveals that the responsibility of nondelivery of the document rests on

the mail service department of the entity to which the addressee belongs or on the addressee himself or on a person connected to him, the Patent Office may redeliver the duplicate copy of the relevant notification or decision upon the request of the party concerned, while the date of issuance of the document shall remain unchanged.

The time limit for post road inquiry is within ten months calculated from the date of issuance of the document.

# Chapter 7 Time Limit, Restoration of Right and Suspension of Procedure

## 1. Types of Time limit

### 1.1 Prescribed Time Limit

The prescribed time limit refers to any of the various time limits as prescribed in the Patent Law and its Implementing Regulations, such as the time limit for request for substantive examination of a patent application for invention (as provided in Article 35.1), and the time limit for an applicant to go through the formalities of registration (as provided in Rule 54.1).

### 1.2 Specified Time Limit

The specified time limit refers to the time limit specified by the examiner in the various notifications under the Patent Law and its Implementing Regulations for an applicant (or patentee), or any other person concerned to make a response or perform a certain act. For example, according to Article 37, when the Patent Office finds, after the substantive examination of a patent application for invention, that the application is not in conformity with the provisions of the Patent Law, the applicant shall be notified to make observations or amend the application within a specified time limit. Such time limit is specified by the examiner. For another example, according to Rule 3.2, if a certificate or certifying document submitted by the party concerned under the Patent Law and its Implementing Regulations is in a foreign language, the Patent Office, when considering it necessary, may request the party concerned to submit the Chinese translation of the certificate or the certifying document within a specified time limit. Such time limit is also specified by the examiner.

A specified time limit shall be in general two months. In the procedures of substantive examination of a patent application for invention, the time limit for the applicant to response to the first Office Action shall be four months. A one-month or shorter time limit may be specified for a less complicated act. The time limit mentioned above shall be calculated from the date on which the party concerned

presumably receives the notification.

## 2. Calculation of Time Limit

### 2.1 Dies a Quo of Time Limit

(1) Calculated from such fixed date as the date of filing, date of priority and date of announcement of the grant of patent right, etc.

Most prescribed time limits are calculated from a fixed date such as the date of filing, date of priority and date of announcement of grant of patent right. For example, it is provided in Article 42 that the term of a patent right shall be calculated from the date of filing. It is provided in Article 29.1 that a patent application for invention or for utility model claiming the priority based on a foreign application shall be filed within twelve months from the date on which the application serving as the basis is first filed in a foreign country (priority date).

(2) Calculated from the date on which a notification or decision is presumably received.

All of the specified time limits and part of the prescribed time limits are calculated from the date on which a notification or a decision is presumably received. For example, the time limit for the applicant to make observations or amend the application specified by the examiner in accordance with Article 37 (specified time limit) is calculated from the date on which the Office Action is presumably received by the applicant. The time limit for the applicant to go through the formalities of registration as provided for in Rule 54.1 (prescribed time limit) is calculated from the date on which the *Notification to Grant Patent Right* is presumably received by the applicant.

Rule 4.3

The date on which a document is presumably received refers to the 16th day from the date of the issuance of the said document by the Patent Office (the date is indicated in the notification or the decision). For example, where a notification is issued on 4 July, 2001 by the Patent Office, the date on which the notification is presumably received shall be 19 July, 2001.

### 2.2 Expiration of Time Limit

The date of expiration of a time limit shall be the last day of the prescribed or specified time limit calculated from the Dies a Quo of the time limit. The relevant acts shall be accomplished before, or at the latest on, the date of expiration.

Rule 5

### 2.3 Calculation of Time Limit

The first day (Dies a Quo) of any time limit is not to be calculated in. Where a time limit is calculated by year or by month, it shall expire on the corresponding day (the date corresponding Dies a Quo) of the last month; if there is no corresponding day in that month, the time limit shall expire on the last day of that month. For example, if the filing date of a patent application for invention is 1 June, 1998, the expiration date of the time limit for requesting the substantive examination shall be 1 June, 2001. For another example, if an Office Action is sent by the Patent Office on 6 June, 2008, the date on which it is presumably received is 21 June, 2008 (the date can not be postponed in case of statutory holidays); if the specified time limit for this notification is two months, the expiration date shall be 21 August, 2008. For another example, if a notification is sent by the Patent Office on 16 December, 1999, the date on which it is presumably received is 31 December, 1999. If the specified time limit for this notification is two months, the expiration date shall be 29 February, 2000.

If a time limit expires on an official holiday or an adjusted weekly holiday, the time limit shall be extended to expire on the first working day after that official holiday or the adjusted weekly holiday; if the first working day is a weekly holiday, the expiration date shall be postponed to next Monday. Statutory holidays include the holidays enjoyed by all citizens as provided for in Article 2 of the "*Measures on Having a Holiday for National Annual Leaves and Memorial Days*" promulgated by the State Council and the weekly holidays as provided for in Article 7.1 of the "*Provisions of the State Council on Working Hours of Workers and Staff*".

## 3. Monitoring of Time Limit

### 3.1 Determination of Time Limit

A time limit is always determined from the dies a quo of that time limit. For example, after a patent application is filed by an applicant, and the date of filing is affirmed, the various time limits which are calculated from the date of filing shall be determined while the file of the said patent application is established. The examiner, when making the various notifications or decisions in connection with the time limits, shall determine the time limits for making a response that are calculat-

ed from the date on which the notification or decision is presumably received.

### 3.2 Monitoring Time Limit

The various time limits are generally monitored by computer systems. After an applicant has gone through the formalities relating to a time limit, the date of going through such formalities shall be recorded in computer systems and be compared with the expiration date of the corresponding time limit, so that the legitimacy of the said formalities in respect of the time limit can be ascertained.

The time limit shall be monitored on a day-to-day basis and shall be handled in time. If a time limit has not been eliminated one month after its expiration, it shall be handled and a decision shall be made accordingly. For example, a *Notification to Make Rectification* was sent by the Patent Office on September 4, 2001 to notify the applicant to submit the Chinese translation of a certifying document of transfer of priority within one month; the date on which the notification was received presumably by the applicant shall be September 19, 2001, and the expiration date of the time limit is October 19, 2001. If the Patent Office failed to receive the Chinese translation submitted by the applicant, the time limit shall be handled after November 19, 2001, and *a Notification that Claim to Priority Deemed Not to Have Been Made* shall be sent.

### 3.3 Notification before Expiration of Time Limit

(1) At the time of three months before the expiration of the time limit for requesting the substantive examination for a patent application for invention, if no such request has been made or the corresponding fee has not been paid, a *Notification before Expiration of Time Limit of Request for Substantive Examination of the Patent Application for Invention* shall be issued to notify the applicant to go through the relevant formalities.

(2) At the time of one month after the expiration of the time limit for the payment of the annual fee, a *Notification to Pay Annual Fee* shall be issued, regarding the patent for which the relevant annual fees have not been paid, to notify the applicant to pay the relevant annual fees and the surcharge within the time limit for late payment as provided for in Rule 98.

(3) No notification as a reminder will be issued before the expira-

tion of other kinds of time limit.

## 4. Extension of Time Limit

Rules 6.4 &71

### 4.1 Request for Extension of Time Limit

A party concerned may request to extend a time limit if he cannot perform or complete a certain act or procedure within the time limit with justified reasons. The request for the extension of time limits shall be limited only to the specified time limits. However, in the procedure of invalidation, the time limit specified by the Patent Reexamination Board shall not be extended.

Rules 6.4 &99.2

Where the extension of time limit is requested, the request for extension of time limit, with the reasons explained, shall be submitted and the fee for requesting the extension shall be paid before the expiration of the time limit. The fee for such request shall be calculated by month.

### 4.2 Approval of Request for Extension of Time Limit

The request for extension of time limit shall be examined and approved by the department that has made the corresponding notification or decision or the flow management department.

Where the extension of time limit is less than one month, it shall be calculated as one month. The extension of time limit shall not exceed two months. In general, a time limit, which is specified in the same notification or decision, may be extended only once.

Where the request does not meet the requirements, a *Notification of Decision on Extension of Time Limit* shall be issued and the reason for non-approval of the request for extension of the time limit shall be stated. Where the request meets the requirements, a *Notification of Decision on Extension of Time Limit* shall be issued and a change shall be made to the expiration date of the time limit in the computer system, which means the time limit shall be reestablished for being monitored.

## 5. Handling for Failure to Meet Time Limit

### 5.1 Check before Making Decision of Disposition

The outcome of the applicant's (or the patentee's) failure to meet a time limit is that the applicant (or patentee) loses the corresponding right, which essentially includes the right to apply for a patent (or the

patent right) and the priority right, etc.

Before making a decision of disposition, the examiner shall re-check whether it needs to make such a decision. The decision shall be made only when it is ascertained that the applicant (or patentee) has not completed an act that should have been completed within the prescribed or specified time limit.

### 5.2 Decision of Disposition

The decisions of disposition for failure to meet time limit mainly include: application deemed to have been withdrawn, entitlement to patent deemed to have been abandoned, termination of patent right, application being not accepted, request deemed not to have been made, and right of priority deemed not to have been claimed.

The drafting of the decision of disposition shall be in conformity with Chapter 6, Section 1.2 of this Part and shall be made one month after the date on which the time limit expires.

### 5.3 Handling after Making a Decision of Disposition

Where the right to apply for a patent (or patent right) is not influenced by the decision of disposition, the original procedure continues.

Where the right to apply for a patent (or patent right) is lost after the decision of disposition is made, there shall be a two-month time limit (from the date on which the decision is presumably received) for requesting restoration of right under regulations. Where no request for restoration of right is made at the expiration of the time limit, or where the request for restoration of right does not meet the requirements, the patent application or patent shall be respectively handled as follows after four months from the date of issuance of the decision (six months for reexamination or invalidation procedure):

(1) where the decision of disposition concerns an unpublished patent application, the decision of disposition shall be checked again, and if it is confirmed inerrant, the patent application shall be handled to be invalid.

(2) where the decision of disposition concerns a published patent application for invention or an announced patent, the decision of disposition shall be checked again, and if it is confirmed inerrant, the decision of disposition shall be announced in the Patent Gazette. The patent application (or the patent) shall be handled to be invalid.

Where, after the decision of loss of right to apply for a patent or

loss of patent right is made, a relevant document indicating that actually the corresponding formalities have been completed within the prescribed time limit is received, the flow management department shall revoke the corresponding decision timely and issue a *Notification of Amendment and Corrections*. The correction shall be further published if the decision has been published.

Rule 6

## 6. Restoration of Right

### 6.1 Scope of Application

Rule 6.1 and Rule 6.2 provide for the requirements to be met for requesting restoration of right which is lost due to failure to meet a time limit. However, Rule 6.5 provides that any right lost due to failure to meet the following four kinds of time limit, namely, the grace period for non-prejudicial disclosures, the priority period, the patent term, and the prescription for instituting legal proceedings of infringement, can not be restored.

### 6.2 Formalities

To request for restoration of right under Rule 6.2, the party concerned shall submit a request for restoration of right, state the reason, and pay the fee for restoration of right within two months from the date of receipt of the decision of disposition made by the Patent Office or the Patent Reexamination Board. To request for restoration of right under Rule 6.1, the party concerned shall submit a request for restoration of right and state the reason within two months from the date on which the impediment is removed, at the latest within two years immediately following the expiration of that time limit, and attach, if necessary, the relevant supporting documents.

At the time of requesting for restoration of right, the party concerned shall go through the corresponding formalities that shall have been completed before the loss of right, and eliminate the cause that leads to the loss of right. For example, where a patent application is deemed to have been withdrawn due to failure to pay the application fee, at the time of requesting for restoration of the right to apply for a patent, the applicant shall pay the prescribed application fee.

### 6.3 Examination and Approval

The examiner shall examine the request for restoration of right in

accordance with Sections 6.1 and 6.2 of this Chapter.

(1) Where the request for restoration of right meets the requirements, the restoration of right shall be approved and a *Notification of Decision on Request for Restoration of Right* shall be issued. Where the applicant submits a letter to express the willingness to request the restoration of right, the letter may be deemed as an eligible request as long as it indicates the application number (or patent number) and is signed or sealed in accordance with requirements.

(2) Although, within the specified time limit, the request in writing has been submitted or the fee for requesting restoration of right has been fully paid, the request is still not in conformity with requirements. Under such circumstance, the examiner shall issue a *Notification to Rectify Formalities of Restoration* to ask the party concerned to make rectification or go through relevant formalities within specified time limit. If the rectification made or the formality gone through is in conformity with requirements, the right shall be permitted to restore and a *Notification of Decision on Request for Restoration of Right* shall be issued. If no rectification is made within the time limit or the rectification made does not meet the requirements, the right shall not be restored and a *Notification of Decision on Request for Restoration of Right* shall be issued with reasons thereof explained.

The procedures of examination and approval of patent application shall proceed if the right to apply for a patent (or patent right) is restored with the approval of the Patent Office. In addition, where the decision of disposition has been announced, the decision of restoration of right shall also be announced in the Patent Gazette.

Rules 86.1 & 87

## 7. Suspension of Procedures

Suspension of procedures refers to an action of the Patent Office to suspend the relevant procedures upon the request of a party concerned in a dispute over the ownership of right or under the request of the People's Court when a dispute over the right to apply for a patent (or ownership of patent right) is accepted by the local intellectual property administrative authority or the People's Court, or when the People's Court has ordered the adoption of measures of property preservation for the right to apply for a patent (or the patent right).

### 7.1 Requirements for Request of Suspension

The following requirements shall be met for requesting the Patent

Office to suspend the relevant procedures:

Rule 86.1

(1) where a party concerned files the request of suspension, the dispute over the ownership of right to apply for patent (or of patent right) shall have been accepted by the local intellectual property administrative authority or by the People's Court. Where assistance to enforce the adoption of measures of property preservation for the right to apply for a patent (or a patent right) is asked for by the People's Court, the civil order for property preservation shall have been made; or

Rule 87

(2) the requester for suspension shall be either the party concerned in a dispute over the ownership of right or the People's Court that has adopted the measures of property preservation for the right to apply for a patent (or a patent right).

## 7.2 Scope of Suspension

Rule 88

The scope of suspension includes the following:

(1) suspend the procedures of preliminary examination, substantive examination, reexamination, the grant of patent right, and invalidation;

(2) suspend the procedures of an application deemed to be withdrawn, entitlement to patent deemed to have been abandoned, and termination of patent right due to failure to pay annual fee, etc; and

(3) suspend the formalities to withdraw a patent application, to abandon patent right, to make a change of the name of the applicant (or patentee), to transfer the right to apply for a patent (or the patent right), and to register the pledge of patent right, etc.

Where, the procedure of preparation for publication or announcement has started before the request for suspension is approved, the said procedure shall not be affected by the request for suspension.

## 7.3 Formalities and Examination and Approval of Request for Suspension

### 7.3.1 Suspension Requested by the Party Concerned in a Dispute over Right Ownership

#### 7.3.1.1 Formalities of Requesting Suspension by the Party Concerned in a Dispute over Right Ownership

Rule 86.2

Where the party concerned in a dispute over the ownership of right to apply for a patent (or a patent right) requests the Patent Office

to suspend the relevant procedures, he shall:

(1) submit a request for suspension;

(2) attach certifying documents, i. e. , the original or duplicate copy of the document for acceptance with patent application number (or patent number) issued by the local intellectual property administrative authority or the People's Court .

#### 7.3.1.2 Examination and Approval of Suspension Requested by the Party Concerned in a Dispute over Right Ownership

After the Patent Office receives the request for suspension of procedures and the relevant certifying documents provided by the party concerned, the flow management department thereof shall examine whether the following requirements are met:

(1) the patent application (or patent) being requested for suspension has not lost its rights, except for the invalidation procedure;

(2) no suspension of procedure has been enforced;

(3) the request is submitted by the party concerned in the dispute over the ownership of right as indicated in the relevant certifying document;

(4) the authority receiving the dispute has jurisdiction over the dispute of ownership of right to apply for a patent (or of a patent right);

(5) the application number (or patent number), title of the invention-creation and the owner of the right indicated in the certifying document are identical with those recorded in the patent application (or patent);

(6) other aspects of the request for suspension and the certifying document meet the formal requirements as prescribed.

Where the requirements of paragraph (1), (2), (3), (4), or (5) is not met, the examiner shall issue a *Notification that Request Deemed Not to Have Been Made* to the requestor for suspension. Where the requirement of paragraph (6) is not met, for example, the request for suspension does not meet the formal requirements or the submitted certifying document is neither the original nor the copy thereof, the examiner shall issue a *Notification to Rectify Formalities* to notify requestor for suspension to make rectification within one month. The relevant procedures are suspended temporarily within the time limit of the rectification. If no rectification is made within the time limit, or the fault is not eliminated after rectification, the *Notification that Request Deemed Not*

*to Have Been Made* shall be issued to the requestor for suspension, and the relevant procedures shall be resumed.

Where the above requirements are met when the request is filed or after the rectification is made, the suspension shall be enforced, and the examiner shall issue a *Notification of Decision on Request for Suspension* to both parties in a dispute over the ownership of right to apply for a patent (or of the patent right), and notify the commencement date and the cessation date of the suspension period (from the date on which the request for suspension is filed). For a patent in the procedure of invalidation, the flow management department of the Patent Office shall also notify the Patent Reexamination Board of the decision of enforcing the suspension, and the Patent Reexamination Board shall notify the parties concerned in the invalidation procedure.

### 7.3.2 Suspension Due to Execution Assistance of Property Preservation Asked by the People's Court

Rule 87

#### 7.3.2.1 Formalities of Suspension Due to Execution Assistance of Property Preservation

Where the relevant procedures are suspended due to the execution assistance of property preservation asked by the People's Court, the following requirements shall be met:

(1) the People's Court shall serve the specified receiving department of the Patent Office with the civil order of property preservation of the right to apply for a patent (or patent right) and the *Notification on Assistance in Execution*, and provide the address, postal code and name of the addressee of the People's Court;

(2) the civil order and the *Notification on Assistance in Execution* shall indicate the information of the patent application or patent upon which the Patent Office is asked to assist the execution, such as the application number (or patent number), the title of the invention-creation, and the name or title of the applicant (or the patentee), as well as the property preservation period; and

(3) the patent application (or the patent) upon which execution assistance of property preservation is asked for shall be valid.

#### 7.3.2.2 Check and Handling of Suspension Due to Execution Assistance of Property Preservation

The Patent Office shall check the civil order and the *Notification*

*on Assistance in Execution* from the People' s Court in accordance with the provisions of Section 7. 3. 2. 1 of this chapter after receiving them, and handle them according to the following provisions:

(1) for those dissatisfying the requirements, issue a *Notification of Non-Enforcement of Property Preservation* to the People' s Court, explain the reasons for not to execute the suspension, and continue the original procedure;

(2) for those satisfying the requirements, execute the suspension, issue a *Notification of Commencement of Preservation* Procedure to the People' s Court and the applicant (or patentee), indicate the commencement date and the cessation date of the time period of assisting the execution of property preservation (from the date of receiving the civil order), and announce the property preservation of patent application (or the patent right); and

(3) for any patent application (or patent) that has been executed property preservation, preservation shall not be executed once again. If another People's Court also asks for execution assistance of the property preservation after a suspension being executed, the preservation request may be put in waiting list in turn. The Patent Office shall make the waiting list in turn. The preservation request on the top of the waiting list shall be executed from the date on which the previous preservation comes to an end.

For patent in the invalidation procedure, the flow management department of the Patent Office shall also notify the Patent Reexamination Board of the decision of enforcing the suspension, and the Patent Reexamination Board shall notify the parties concerned in the invalidation procedure.

## 7.4 Time Limit of Suspension

Rule 86. 3

### 7.4.1 Time Limit of Suspension Requested by the Party Concerned in a Dispute over Right Ownership

For the request for suspension made by a party concerned in a dispute over the ownership of the right to apply for a patent (or of patent right), the duration of the suspension shall generally not exceed one year. That is, the suspension shall end one year after the date of filing the request for suspension.

If no decision is made on the dispute over the ownership of right to apply for a patent (or patent right) within one year of the suspension

and it is necessary to continue the suspension, the requester may request to extend the suspension before the expiration date of the suspension after submitting certifying document of reasons for not concluding the case issued by the authority receiving the dispute over the ownership of right. The suspension may be extended once, and the extension period shall not exceed six months. If the request for extension of suspension does not comply with the provisions mentioned above, the examiner shall issue a *Notification of Decision on Extension of Time Limit* and explain the reason for non-approval of extension. If the request for extension complies with the provisions mentioned above, the examiner shall issue a *Notification of Decision on Extension of Time Limit* to notify both parties in the dispute over the ownership of the right.

Rule 87

### 7.4.2 Time Limit of Suspension Due to Execution Assistance of Property Preservation

For the suspension due to execution assistance of property preservation asked by the People's Court, the suspension period is generally six months. The suspension shall cease six months after the date of receiving the civil order.

Where the People's Court orders to continue adopting measures of property preservation, it shall serve the Patent Office with a *Notification on Assistance in Execution* for keeping on the preservation before the expiration of the time limit for suspension. The suspension may be extended six months if the *Notification on Assistance in Execution* complies with the regulations set forth in Section 7.3.2.1 of this chapter after being checked. The time limit for suspension shall not exceed 12 months for a preservation verdict made during the execution procedure by the same court for the same case. If the preservation verdict is made during the trial procedure, the time limit for preservation can be extended accordingly.

### 7.4.3 Time Limit of Suspension Concerning Invalidation Procedure

With respect to patents in the invalidation procedure, the duration for suspension as requested by the party concerned in a dispute over the ownership of right or asked by the People's Court to assist in execution of property preservation shall not exceed one year. The Patent Office will resume the relevant procedures on its own initiative once the time limit of suspension expires.

## 7.5 Cessation of Suspension Procedure

### 7.5.1 Cessation of Suspension Requested by the Party Concerned in a Dispute over Right Ownership

Rule 86.3

After the time limit for suspension expires, the Patent Office shall resume the relevant procedures on its own initiative, and the examiner shall issue a *Notification of Cessation of Suspension* to both parties concerned in a dispute over right ownership.

For the patent application (or patent) which is still in the suspension period, after the decision made by the local intellectual property administrative authority or the judgment made by the People's Court takes effect (after the change of bibliographic data when the decision or judgment concerns the change of the owner of the right), the Patent Office shall cease the suspension.

After receiving the document of mediation, civil order or written judgment submitted by the party concerned, stakeholder, the local intellectual property administrative authority, or the People's Court, the Patent Office shall examine the following contents:

(1) whether the said document is valid, i. e., whether or not it is the official copy (original copy or duplicate copy) and whether or not it is made by the authority that has jurisdiction over the case;

(2) whether the application number (or patent number), the title of the invention-creation and the owner of the right recorded in the said document are identical with the record in the patent application (or patent) under request for cessation of suspension; and

(3) whether the said document has taken effect, for example, whether or not the time limit for appeal in the decision document has expired (there is no time limit of appeal for documents of mediation). Where it can not be determined whether or not the said document has taken effect, the examiner shall send a *Notification of Receiving the Judgement of People's Court* to the adversary party to affirm whether or not there will be an appeal. Where no response is made within the specified time limit or where it is clearly expressed that there will be no appeal, the said document shall be deemed to have taken effect. Where an appeal is made, the appellant shall submit the certifying document issued by the higher People's Court, and the original decision of the inferior People's Court shall not take effect.

Where the said document does not meet the requirements, the

examiner shall issue a *Notification that Request Deemed Not to Have Been Made* to the party requesting for cessation and the suspension procedure continues. Where the said document meets the requirements and there is no change over the owner of right, the examiner shall issue the Notification of Cessation of Suspension to notify both parties concerned, and resume the relevant procedures.

Where the said document meets the requirements and the change of owner of right is involved, the examiner shall issue the Notification to Rectify Formalities to notify the party that is to obtain the right to go through the formalities of changing the bibliographic data within three months from the date of receipt of the notification and to go through other formalities that are required to complete during the suspension but have not been completed. Where the party that is to obtain the right has gone through the formalities, the examiner shall issue the *Notification of Cessation of Suspension* to notify both parties concerned, and resume relevant procedures. Where the relevant formalities are not gone through within the time limit, the right to apply for a patent application (or patent right) shall be deemed to have been abandoned. The examiner shall issue a *Notification that Application Deemed to be withdrawn* or a *Notification that Entitlement to Patent Deemed Abandoned* to the party that is to obtain the right. Where the restoration formalities are not gone through within the time limit, the suspension shall be ceased. The examiner shall issue a *Notification of Cessation of Suspension* to notify both parties concerned, and resume relevant procedures.

Rule 87

**7.5.2 Cessation of Suspension Procedures Due to Execution Assistance of Property Preservation Asked by the People's Court**

After the time limit for suspension expires, where there is no request of the people's court to continue the preservation, the examiner shall issue a *Notification of Cessation of Suspension* to notify the People's Court and the applicant (or patentee), resume the relevant procedure, and announce the discharging of preservation of the patent right. Where there is a waiting list in turn of the preservation request, the preservation request on the top of the waiting list shall be executed from the date on which the previous preservation comes to an end. The duration of the preservation is 6 months. The examiner shall issue the *Notification of cessation of Suspension* to the previous People's Court and the applicant (or patentee), issue the *Notification of Commencement*

*of Preservation Procedure* to the People's Court on the top of the waiting list and the applicant (or patentee), indicate the commencement date and the cessation date of execution assistance of property preservation, and announce the property preservation of patent right.

Where the notification of discharging preservation from the People's Court which asks for execution assistance of property preservation is received, if it is in conformity with relevant provisions after being checked, the examiner shall issue the *Notification of Cessation of Suspension* to notify the People's Court and the applicant (or patentee), resume relevant procedures, and announce the discharging of preservation for the patent right.

# Chapter 8 Compilation of Patent Gazette and Pamphlet

Rule 90

## 1. Patent Gazette

### 1.1 Types of Patent Gazette

The patent gazettes compiled and published by the Patent Office include Invention Patent Gazette, Utility Model Patent Gazette and Design Patent Gazette. The patent gazettes are distributed in the form of journal, while electronic gazette form is published on the website of State Intellectual Property Office at the same time, or other forms are published by the Patent Office. The patent gazettes are published according to annual plan. Each of the three kinds of Patent Gazette shall be published once a week.

### 1.2 Contents of Patent Gazette

#### 1.2.1 Invention Patent Gazette

Invention Patent Gazette shall include the publication of the applications for patent for invention, publication of international applications for patent, grant of patent right for invention, secret patent for invention, matters relating to patent for invention, and index (index of publication of applications, index of announcement of grant of patent right).

##### 1.2.1.1 Publication of Patent Application for Invention

Where a patent application for invention is found to have met the requirements after the preliminary examination, the preparation for the publication of the application shall begin at the expiration of fifteen months from the date of filing (the priority date where priority is claimed), and the application shall be published at the expiration of eighteen months from the date mentioned above. Where an applicant requests his application to be published on an earlier date, before it is found to pass the preliminary examination, such preparation shall start from the date on which the application is found in conformity with the requirements after the preliminary examination, or where an applicant requests his application to be published on an earlier date after it is

found to pass the preliminary examination, such preparation shall start from the date on which the statement is found in conformity with the requirements, and the application shall be published in time. At the expiration of fifteen months from the date of filing (date of priority if with right of priority), if it is found that, for various reasons, a patent application for invention is not in conformity with the requirements of the preliminary examination, the publication of the application shall be put off. For any patent application for invention which is rejected, or deemed to have been withdrawn, or withdrawn by the applicant on his own initiative before preparation of publication, or treated as a secret application in the procedures of preliminary examination, no publication shall be made to it.

The contents of publication for a patent application for invention shall include the bibliographic data, the abstract and the drawing accompanying the abstract. Where there is no drawing in the description, there can be no drawing accompanying the abstract. The bibliographic data shall mainly include the symbol of International Patent Classification, application number, publication number (publishing number), date of publication, date of filing, matters concerning the right of priority, matters concerning the applicant, matters concerning the inventor, matters concerning the patent agency and the title of the invention, etc.

### 1.2.1.2 Grant of Patent Right for Invention

Where, according to the *Notification to Grant Patent Right* and the *Notification to Go through Formalities of Registration* made by the Patent Office, the patent applicant for invention has paid in time the patent registration fee, the annual fee of the year when the patent right is granted and other relevant fees, the patent application shall enter into the phase of preparation for the announcement of grant of patent right and the grant shall be announced.

The contents of announcement of grant of patent for invention shall contain the bibliographic data, the abstract and the drawing accompanying the abstract. Where there is no drawing in the description, there can be no drawing accompanying the abstract. The bibliographic data shall mainly include: the symbol of International Patent Classification, patent number, number of announcement of grant of patent (publishing number), date of filing, date of announcement of grant of patent, matters relating to right of priority, matters relating to the patentee, matters relating to the inventor, matters relating to the patent a-

gency, and the title of invention, etc.

#### 1.2.1.3 Secret Patent for Invention and National Defense Patent for Invention

For a secret patent for invention, only the matters relating to the grant of secret patent and the declassification of secret patent shall be announced. The bibliographic data in the announcement of secret patent includes: patent number, date of filing, and date of announcement of grant of patent right, etc.

After the declassification of a secret patent for invention, the declassification shall be announced in the item for declassification in the Patent Gazette, and a pamphlet shall be published.

The above provisions shall apply when the grant of national defense patent right for invention and the declassification of national defense patent are announced.

#### 1.2.1.4 Matters Relating to Patent for Invention

Matters relating to a patent for invention shall publish the decisions and notifications made by the Patent Office relating to a patent application for invention and a patent for invention, including taking effect of a request for the substantive examination, decision of the Patent Office to conduct the substantive examination with regard to a patent application for invention on its own initiative, rejection of the patent application for invention after its publication, withdrawal of the patent application for invention after its publication, deemed to be withdrawn of the patent application for invention after its publication, deemed to have been abandoned of the entitlement to patent, invalidation of the whole patent right (or part of the patent right), cessation of patent right, abandonment of patent right on the patentee's own initiative, restoration of the right to apply for a patent (or of patent right), transfer of the right to apply for a patent or patent right, compulsory license for exploitation of patent, submission for record of patent license contract for exploitation, pledge and preservation of the patent right and their discharge, change of the name or address of the patentee or other bibliographic data, delivery of documents by public notice, corrections of the Patent Office and other related matters.

#### 1.2.1.5 Index

The indexes of invention are divided into two categories: the in-

dex of application publication and index of announcement of grant of patent right. Each type of index is further divided into index of symbol of international patent classification, index of application number (or index of patent number), index of applicant (or index of patentee) and index of concordance list of publication number/application number (number of announcement of grant of patent right/patent number).

### 1.2.2 Utility Model Patent Gazette

The Utility Model Patent Gazette shall include the grant of patent right for utility model, the secret patent for utility model, matters relating to patent for utility model and the index of announcement of grant of patent right.

#### 1.2.2.1 Grant of Patent Right for Utility Model

Where, according to the *Notification to Grant Patent Right* and the *Notification to Go through Formalities of Registration* made by the Patent Office, the applicant for patent for utility model has paid in time the patent registration fee, the annual fee of the year when the patent right is granted, and other relevant fees, the patent application shall enter into the phase of preparation for the announcement of grant of patent right and the grant shall be announced.

The contents of announcement of grant of patent for utility model shall include the bibliographic data, the abstract and the drawing accompanying the abstract. The bibliographic data shall mainly include: the symbol of International Patent Classification, patent number, number of announcement of grant of patent right (publishing number), date of filing, date of announcement of grant of patent right, matters relating to right of priority, matters relating to the patentee, matters relating to the inventor, matters relating to patent agency, and the title of utility model, etc.

Where an applicant has filed an application for patent for invention regarding identical invention-creations on the same day when he files an application for patent for utility model and has stated his application, such statement shall be announced.

#### 1.2.2.2 Secret Patent for Utility Model and National Defense Patent for Utility Model

For a secret patent for utility model, only the matters relating to the grant of secret patent and the declassification of secret patent shall

be announced. The bibliographic data in the announcement of secret patent shall include: patent number, date of filing, and date of announcement of grant of patent right, etc.

After the declassification of a secret patent for utility model, the declassification shall be announced in the item for declassification in the Patent Gazette, and a pamphlet shall be published.

The above provisions shall apply when the grant of national defense patent right for utility model and the declassification of national defense patent are announced.

#### 1.2.2.3 Matters Relating to Patent for Utility Model

Matters relating to a patent for utility model shall publish the decisions and notifications made by the Patent Office concerning an application for a patent for utility model and a patent for utility model, including invalidation of the whole patent right (or part of the patent right), cessation of patent right, abandonment of patent right on the patentee's own initiative, abandonment of patent right for utility model to avoid double patenting, restoration of patent right, transfer of patent right, compulsory license for exploitation of patent, submission for record of patent license contract for exploitation, pledge and preservation of the patent right and their discharge, change of the name or address of the patentee or other bibliographic data, delivery of documents by public notice, correction of the Patent Office, and other related matters.

#### 1.2.2.4 Index of Announcement of Grant of Patent Right

The indexes of announcement of grant of patent right for utility model shall include index of symbol of International Patent Classification, index of patent number, index of patentee, and the index of concordance list of number of announcement of grant of patent right/ patent number.

### 1.2.3 Design Patent Gazette

The Design Patent Gazette shall contain the grant of patent rights for design, matters relating to patent for design and the index of announcement of grant of patent rights.

#### 1.2.3.1 Grant of Patent Right for Design

Where, according to the *Notification to Grant Patent Right* and the

*Notification to Go through Formalities of Registration* made by the Patent Office, the applicant for patent for design has paid in time the patent registration fee, the annual fee of the year when the patent right is granted, and other relevant fees, the patent application shall enter into the phase of preparation for the announcement of grant of patent right and the grant shall be announced.

The contents of announcement of grant of patent right for design shall include the bibliographic data, and one of the drawings or photographs of the design patent. The bibliographic data shall mainly include: the symbol of classification, patent number, number of the announcement of grant of patent right (publishing number), date of filing, date of announcement of grant of patent right, matters relating to the right of priority, matters relating to the patentee, matters relating to the designer, matters relating to the patent agency, and the title of the product incorporating the design, etc.

#### 1.2.3.2 Matters Relating to Patent for Design

In the part of matters relating to patent for design, the decisions and notifications made by the Patent Office concerning patent applications for design and patents for design shall be published. The items therein include announcement of invalidation of patent right in whole (or in part), cessation of patent right, abandonment of patent right on the patentee's own initiative, restoration of patent right, transfer of patent right, submission for record of patent license contract for exploitation, pledge or preservation of patent right and its discharge, change of the name or address of the patentee or other bibliographic data, delivery of documents by public notice, correction of the Patent Office, and other related matters.

#### 1.2.3.3 Index of Announcement of Grant of Patent Right

The index of announcement of grant of patent right for design shall include index of the symbol of design classification, index of patent number, index of patentee, and index of concordance list of number of announcement of grant of patent right/ patent number.

### 1.3 Compilation of Patent Gazette

#### 1.3.1 Compilation of Application Documents

The documents of a patent application for invention for publica-

tion and the documents of a patent application for invention, the documents of a patent application for utility model or the documents of a patent application for design for announcement of grant of patent right shall meet the requirements for the photoengraving, and the bibliographic data shall be consistent with the information contained in the patent application file of the time of preparation for publication or the time of preparation for announcement of grant of patent right.

The publication of an application for a patent for invention or the grant of patent right for invention and utility model shall be arranged in the order of the International Patent Classification symbol. Those having identical main classification symbols shall be arranged in the order of application numbers.

The grant of patent right for design shall be arranged in the order of the symbols of design classification. Those having identical classification symbols shall be arranged in the order of application numbers.

Each printed page of Patent Gazette shall be divided into two columns, the left column and the right column, and shall be compiled from top to bottom and from left to right in a continuous way.

### 1.3.2 Compilation of Matters

The compilation of matters in the various Patent Gazettes shall follow the following principles:

(1) the decision made by the Patent Office on the loss of right to a patent application for utility model or for design before the announcement of grant of patent right shall not be published. The decision made by the Patent Office on the loss of right to a patent application for invention before the publication of that application shall not be published;

(2) the various decisions made by the Patent Office which have taken effect and should be announced under regulations shall be published; and

(3) where more than two identical matters are to be published in the same issue of Patent Gazette, they shall be arranged in the order of main classification numbers; where the main classification numbers are identical, they shall be arranged in the order of the application numbers.

#### 1.3.2.1 Taking Effect of Request for Substantive Examination, Decision of the Patent Office to Conduct Substantive Examination on Its Own Initiative

This part is for patent applications for invention only. The items to be published shall include the main classification symbol, patent application number and date of filing.

#### 1.3.2.2 Rejection, Withdrawal and Deemed Withdrawal of Patent Application for Invention after Publication

This part is for patent applications for invention already published only. The items to be published shall include the main classification symbol, patent application number, and date of publication.

#### 1.3.2.3 Patent Application for Invention for Which Entitlement to Patent Right Deemed to Have Been Abandoned

The items to be published in this part shall include the main classification symbol, and the patent application number.

#### 1.3.2.4 Compulsory License for Patent Exploitation

The items to be published in this part shall include the main classification symbol, patent number, and date of announcement of grant of patent right.

#### 1.3.2.5 Cessation of Patent Right

The items to be published in this part shall include the main classification symbol, patent number, date of filing and date of announcement of grant of patent right.

#### 1.3.2.6 Taking Effect, Change and Cancellation of Submission for Record of License Contract for Patent Exploitation

The items to be published for taking effect of submission for record of license contract for patent exploitation shall include the main classification symbol, patent number, symbol of submission for record, assignor, assignee, title of invention, date of filing, date of publication of invention, date of announcement of grant of patent right, type of license (sole, exclusive or non-exclusive), and date of submission for record.

The items to be published for change of submission for record of license contract for patent exploitation shall include the main classifi-

cation symbol, patent number, symbol of submission for record, date of changing, item to be changed (type of license, assignor, assignee), and contents before and after the change.

The items to be published for cancellation of submission for record of license contract for patent exploitation shall include the main classification symbol, patent number, symbol of submission for record, assignor, assignee, and date of discharge of submission for record of license contract.

#### 1.3.2.7 Taking Effect, Change and Cancellation of Registration of Pledge Contract of Patent Right

The items to be published for taking effect of registration of pledge contract of patent right shall include the main classification symbol, patent number, symbol of registration, date of taking effect of the registration of pledge contract, pledger, pledgee, title of invention, date of filing, and date of announcement of grant of patent right.

The items to be published for change of registration of pledge contract of patent right shall include the main classification symbol, patent number, symbol of registration, date of changing, item to be changed(pledger, pledgee), and contents before and after the change.

The items to be published for cancellation of registration of pledge contract of patent right shall include the main classification symbol, patent number, symbol of registration, pledger, pledgee, date of filing, date of announcement of grant of patent right, and date of discharge of registration of pledge contract.

#### 1.3.2.8 Preservation of Patent Right and its Discharge

The items to be published for preservation shall include the main classification symbol, patent number, date of filing, date of announcement of grant of patent right, and date of taking effect of the registration of preservation.

The items to be published for discharge of preservation shall include the main classification symbol, patent number, date of filing, date of announcement of grant of patent right, and date of discharge of preservation.

#### 1.3.2.9 Transfer of Patent Application or Patent Right

The items to be published in this part shall include the main classification symbol, patent application number (patent number), item to

be changed, right owner before the change, right owner after the change, and date of taking effect of the registration.

#### 1.3.2.10 Announcement of Invalidation of the Whole Patent Right (or Part of the Patent Right)

The items to be published for announcement of invalidation of the whole patent right shall include the main classification symbol, patent number, date of announcement of grant of patent right, number of decision of invalidation, and date of decision of invalidation of patent.

The items to be published for announcement of invalidation of part of the patent right shall include the main classification symbol, patent number, date of announcement of grant of patent right, number of decision of invalidation, date of decision of invalidation of patent, and the claims maintaining the validity.

#### 1.3.2.11 Abandonment of Patent Right on the Patentee's Own Initiative

The items to be published in this part shall include the main classification symbol, patent number, date of filing, date of announcement of grant of patent right, and date on which the abandonment takes effect.

#### 1.3.2.12 Abandonment of Patent Right for Utility Model to Avoid Double Patenting

The items to be published in this part shall include the main classification symbol, patent number, date of filing, date of announcement of grant of patent right, and date on which the abandonment takes effect.

#### 1.3.2.13 Restoration of Right

The items to be published in this part shall include the main classification symbol, patent application number (patent number), title of the decision concerning loss of right, and date of announcement of the same decision.

#### 1.3.2.14 Delivery of Documents by Public Notice

Where the post address for a notification is not clear and the Patent Office is unable to notify the party concerned to respond or to go through formalities within the prescribed or specified time limit, the notification shall be published in this part. The items to be published shall include the main classification symbol, application number, ad-

dressee, and title of the notification.

#### 1.3.2.15 Other Relevant Matters

The contents which need to be announced other than those stated in the above parts shall be published in this part.

#### 1.3.2.16 Correction

Once any printing error or any other mistake is found in the Patent Gazette, the Patent Office shall make a correction to correct them in time, by announcement in this part. The correction of different types of errors or mistakes shall be published respectively. The items to be published shall include the main classification symbol, application number (or patent number), volume number of the original announcement, item to be corrected, and contents before and after the correction.

### 1.3.3 Compilation of Index

#### 1.3.3.1 Index of Classification Symbol

For invention and utility model, the index shall be compiled in accordance with the International Patent Classification symbols. For design, the index shall be compiled in accordance with the design classification symbols.

The index of the classification symbol shall be arranged in the order of the classification symbols. Those having identical classification symbols shall be arranged in the order of the publication number or the number of announcement of grant of patent right.

The items in the index of the classification symbols shall include the classification symbol, publication number or number of announcement of grant of patent right.

#### 1.3.3.2 Index of Application Number or Patent Number

The index of application number or patent number shall be arranged in the order of the application numbers or patent numbers.

The items in the index of application numbers or patent numbers shall include the application number or patent number, publication number or the number of announcement of grant of patent right.

#### 1.3.3.3 Index of Applicant or Patentee

The index of applicant or patentee shall be arranged in the order

of Pinyin of the characters of the name of the applicant or patentee. Those having identical first Chinese character for their names shall be arranged in the order of Pinyin of the second Chinese character, and so on. Names in foreign languages shall precede the others and follow the alphabetic order. Where the applicants or patentees are the same, they shall be arranged in the order of the publication number or number of announcement of grant of patent right.

The items in the index of the applicant or patentee shall include the applicant or patentee, publication number or the number of announcement of grant of patent right.

#### 1.3.3.4 Index of Publication Number/Application Number (Number of Announcement of Grant of Patent Right/Patent Number)

The index of concordance list of publication number/application number (number of announcement of grant of patent right/patent number) shall be arranged in the order of the publication number (number of announcement of grant of patent right).

The items in the index of concordance list of publication number/application number (number of announcement of grant of patent right/patent number) shall include publication number (number of announcement of grant of patent right) and application number (patent number).

Rule 91

## 2. Pamphlet of the Application for Patent and the Pamphlet of Patent

The Patent Office shall compile and publish the pamphlets. The pamphlets of patent application and the pamphlets of patent shall be published once a week, and on the same day when the corresponding Patent Gazette is published.

### 2.1 Types of Pamphlet

The types of pamphlet include pamphlet of application for patent for invention, pamphlet of patent for invention, pamphlet of patent for utility model and pamphlet of patent for design.

### 2.2 Contents of Pamphlet

#### 2.2.1 Pamphlet of Application for Patent for Invention

The document type code for published pamphlet of application for

patent for invention is "A". It shall include the head page, the claims, and the description (where there are drawings in the description, including the drawings).

The head page consists of the bibliographic data, the abstract, and the drawing accompanying the abstract. Where there is no drawing in the description, there can be no drawing accompanying the abstract. The contents of the head page shall be consistent with those of the corresponding patent application published in the Patent Gazette on the same day.

The claims, the description and the drawings shall be based on the text designated by the examiner in the *Notification of Passing Preliminary Examination of the Application for Patent Right for Invention*.

### 2.2.2 Invention Patent Pamphlet

The document type code for pamphlet of patent for invention is "B". The pamphlet shall include the head page, the claims, and the description (where there are drawings in the description, including the drawings).

The head page consists of the bibliographic data, the abstract, and the drawing accompanying the abstract. If there is no drawing in the description, there can be no drawing accompanying the abstract. As compared with the contents of the corresponding patent for invention published in the Patent Gazette on the same day, the contents of the head page further include the item for examiner and the item for reference documents.

The claims, the description and the drawings shall be based on the text designated by the examiner in the *Notification to Grant Patent Right*.

Where, in the invalidation procedure after a patent for invention is granted, the patent right is maintained subject to amendment to the claims, the claims after amendment shall be republished, with a document type code successively selected from "C1-C7". The date of the announcement of the amended claims shall be indicated therein.

### 2.2.3 Pamphlet of Patent for Utility model

The document type code for pamphlet of patent for utility model is "U". The pamphlet shall include the head page, the claims, the description and the drawings.

The head page consists of the bibliographic data, the abstract and

the drawing accompanying the abstract. The contents of the head page shall be consistent with those of the corresponding patent for utility model published in the Utility Model Patent Gazette on the same day.

The claims, the description and the drawings shall be based on the text designated by the examiner in the *Notification to Grant Patent Right*.

Where, in the invalidation procedure after a patent for utility model is granted, the patent right is maintained subject to amendment to the claims, the claims after amendment shall be republished, with a document type code successively selected from "Y1-Y7". The date of announcement of the amended claims shall be indicated therein.

### 2.2.4 Pamphlet of Patent for Design

The document type code for pamphlet of patent for design is "S". The pamphlet shall include the head page, the colored drawings or photographs of the design, and the brief explanation.

The head page consists of the bibliographic data and one of drawings (or photographs) of the design. The contents of the head page shall be consistent with those of the corresponding patent for design published in the Design Patent Gazette on the same day.

The colored drawings or photographs and the brief explanation shall be based on those designated by the examiner in the *Notification to Grant Patent Right*.

Where, in the invalidation procedure after a patent for design is granted, the patent right is maintained subject to amendment to the drawings or photographs, the drawings or photographs after amendment shall be republished with a document type code successively selected from "S1-S7". The date of announcement of the amended drawings or photographs shall be indicated therein.

### 2.3 Correction

Rules 58 & 90.1(15)

Once an error is found in the pamphlet of application for patent for invention, the pamphlet of patent for invention, the pamphlet of patent for utility model and pamphlet of patent for design, the Patent Office shall make a correction in time. The corrected pamphlet of application for patent or pamphlet of patent shall be republished, with the head page being marked.

# Chapter 9 Grant and Termination of Patent Right

## 1. Grant of Patent Right

### 1.1 Procedure of Grant of Patent Right

#### 1.1.1 Notification to Grant Patent Right

Art. 39 & 40

Where it is found after the substantive examination of a patent application for invention or after the preliminary examination of a patent application for utility model or design that there is no grounds for rejection of the application, the Patent Office shall make a decision to grant the patent right, issue the patent certificate, and conduct registration in the Patent Register, and announce it in the Patent Gazette. The patent right shall take effect from the date of announcement.

Before the grant of patent right, the Patent Office shall issue the *Notification to Grant Patent Right*.

Rule 54.1

#### 1.1.2 Notification to Go through Formalities of Registration

At the same time when the Patent Office issues the *Notification to Grant Patent Right*, it shall also issue the *Notification to Go through Formalities of Registration*. The applicant shall go through the formalities of registration within two months from the date of receipt of the notification.

Rule 97

#### 1.1.3 Formalities of Registration

When the applicant goes through the formalities of registration, he shall pay registration fee for the grant of the patent right, the annual fee of the year in which the patent right is granted (the year indicated in the *Notification to Go through Formalities of Registration*), the printing fee for the announcement of grant of patent right, and the stamp tax for patent certificate according to the fee indicated in the *Notification to Go through Formalities of Registration*.

Art. 39 & 40
Rule 54.1

#### 1.1.4 Issuance of Patent Certificate, Registration and Announcement of Grant of Patent Right

Where the applicant goes through the formalities of registration

within the prescribed time limit, the Patent Office shall issue the patent certificate, register and announce it at the same time. The patent right shall take effect from the date of the announcement.

After the applicant has gone through the formalities of registration, the Patent Office shall prepare the patent certificate, and make preparations for the registration of the grant of the patent right and the announcement of the decision to grant the patent right. After the patent certificate is made, it may be sent to the patentee in accordance with the provisions of Chapter 6, Section 2. 1. 1 of this Part. In special circumstances, it may also be delivered directly to the patentee in accordance with the provisions of Chapter 6, Section 2. 1. 2 of this Part.

Rule 54. 2

#### 1. 1. 5 Entitlement to Patent Deemed to Have Been Abandoned

Where the applicant fails to go through the formalities of registration within the prescribed time limit under the provisions set forth in Section 1. 1. 3 of this Chapter after the Patent Office issues the *Notification to Grant Patent Right and the Notification to Go through Formalities of Registration*, the Patent Office shall issue the *Notification that Entitlement to Patent Deemed Abandoned*. Such notification shall be made one month after the date of expiration of the time limit of going through formalities of registration, and the legal procedures for restoration of the right shall be indicated. Where, four months after the date of issuance of the notification, the formalities of restoration have not been gone through, or the Patent Office has made a decision of rejection to restore the right, the patent application shall be handled to be invalid. For a patent application for invention, the entitlement to patent right deemed to have been abandoned shall be announced in the Patent Gazette.

### 1. 2 Patent Certificate

#### 1. 2. 1 Composition of Patent Certificate

The patent certificate consists of the front page and the patent pamphlet.

The patent certificate shall contain the important bibliographic data concerning the patent right, the hallmark of the State Intellectual Property Office, signature of the Commissioner, and date of announcement of grant of patent right, etc.

The said bibliographic data shall include the patent certificate

number (serial number), the title of the invention-creation, the patent number (i. e. the application number), the filing date, the name of the inventor or designer, and the name of the patentee. Where the bibliographic data of a patent is too long to be contained in one page, additional page(s) may be attached. If total pages of the patent pamphlet in the certificate are over 110, pages from page 101 shall be in the form of an additional copy.

### 1.2.2 Duplicate Copy of Patent Certificate

Where for one patent there are two or more patentees, the Patent Office may issue duplicate copies of the patent certificate at the request of the joint patentees. However, the number of the duplicate copies of the patent certificate for one patent shall not exceed the number of the joint patentees. The Patent Office shall not issue duplicate copy of patent certificate once the patent right terminates.

If, after the issuance of the patent certificate, there is a change in the patentee due to transfer of the patent right, the Patent Office will not issue any duplicate copy of the patent certificate to the new or newly-added patentee.

The duplicate copy of a patent certificate has the word "copy" indicated on it. The format and contents of the duplicate copy of a patent certificate shall be identical with the format and contents of the original. The fee for duplicate copy and the stamp tax shall be charged for issuance of a duplicate copy of a patent certificate.

### 1.2.3 Replacement of Patent Certificate

Where, according to the settlement of the local intellectual property administrative authority or the judgment of the People's Court on a dispute over the ownership of the patent right, the patent right is returned to the person who filed the case, he may, after the said settlement or judgment takes effect, request the Patent Office for the replacement of the patent certificate after the formalities of changing patentee has been passed through. If the patent certificate is damaged, the patentee may request for the replacement of the patent certificate. If the patent right terminates, the Patent Office shall no longer replace the patent certificate. If the patentee changes due to transfer of patent right or name change of the patentee, the patent certificate shall not be replaced.

When requesting for replacement of the patent certificate, the pa-

tentee shall return the original certificate and pay the handling fee. The Patent Office shall verify the patent application record after receiving the request for replacing the patent certificate. If the request meets the requirements, the Patent Office may prepare a new patent certificate and issue it to the party concerned. The format and contents of the replacing certificate shall be identical with those of the original patent certificate. The original patent certificate shall be put into the file of the patent application with the word "replaced" indicated thereon.

#### 1.2.4 Correction of Typing Errors in the Patent Certificate

Where there is any typing error in the patent certificate, the patentee may return the certificate and request the Patent Office to correct it. The Patent Office shall correct the typing error after verification, and shall send the replaced certificate to the patentee. The original certificate shall be put into the file of the patent application with the word "replaced" indicated thereon.

No patent certificate shall be reissued if the original patent certificate is lost, unless the loss is due to the Patent Office.

### 1.3 Patent Register

#### 1.3.1 Format of the Patent Register

Rule 89

The Patent Office shall establish the Patent Register when the patent right is granted. The contents to be recorded in the Patent Register include the grant of the patent right, transfer of the patent application or of the patent right, declassification of the secret patent, invalidation of the patent right, termination of the patent right, restoration of the patent right, pledge and preservation of the patent right and their discharge, the license contract for patent exploitation submitted for the record, compulsory license for the patent exploitation, and change in the name, nationality and address of the patentee.

Once made, the above said items are recorded in the Patent Register. The items recorded in the Patent Register shall be stored in the form of data in database. When the duplicate copy of the Patent Register is made, it shall be printed according to the prescribed format, and shall take effect when it is affixed with the special seal of certification.

#### 1.3.2 Effect of the Patent Register

At the time when the patent right is granted, the contents of the

Patent Register are consistent with those recorded in the patent certificate, they have the same legal effect. After the grant of the patent right, the change in the legal status of the patent is recorded only in the Patent Register. For this reason, where the contents contained in the Patent Register are not consistent with those recorded in the patent certificate, the legal status contained in the Patent Register shall prevail.

### 1.3.3 Duplicate Copy of the Patent Register

Rule 118.1

Duplicate copy of the Patent Register is made according to the original. After the announcement of grant of patent right, any person may request the Patent Office to issue a duplicate copy of the Patent Register. When any person requests the Patent Office to issue a duplicate copy of the Patent Register, he shall submit a request for the duplicate copy, and pay the corresponding fee.

Upon receipt of the said request and payment of the fee, the Patent Office shall make a duplicate copy of the Patent Register. After being verified with the file of the patent application and confirmed inerrant, the duplicate copy shall be affixed with the special seal for certification and sent to the person who made the request.

## 2. Termination of Patent Right

### 2.1 Termination Due to Expiration of Term of Patent Right

Art. 42

The duration of patent right for inventions shall be twenty years, and the duration of patent right for utility model and patent right for design shall be ten years, counted from the filing date. For example, if the filing date of a patent application for utility model is September 6, 1999, the term of the patent right is from September 6, 1999 to September 5, 2009, and the date of termination of the patent right is September 6, 2009 (the date can not be postponed in case of statutory holidays).

When the term of a patent right expires, it shall be registered in the Patent Register and announced in the Patent Gazette respectively in time, and it shall be handled to be invalid.

## 2.2 Termination of Patent Right Due to Patentee's Failure to Pay Annual Fee

Rule 98

### 2.2.1 Annual Fee

The annual fee of the year in which the patent right is granted shall be paid at the time of going through the formalities of registration, and the subsequent annual fees shall be paid before the expiration of the preceding year. The date on which the time limit for payment expires is the corresponding date of the current year to the filing date.

#### 2.2.1.1 Annual Period

An annual period for a patent is counted from the date of filing. It is irrelevant to the date of priority or that of grant of the patent right. It is not necessarily relevant to a calendar year either. For example, the date of filing of an application for a patent is June 1, 1999, the first year of that patent application is counted from June 1, 1999 to May 31, 2000, and the second year of the patent application is counted from June 1, 2000 to May 31, 2001, and the rest can be deduced by analogy.

#### 2.2.1.2 Amount of Annual Fee Payable

The annual fee for every year shall be paid in the amount as prescribed in the fee schedule. For example, the date of filing of an application for a patent is June 3, 1997, and the application is granted a patent right on August 1, 2001 (date of announcement of grant of patent right). If the applicant paid the annual fee for the fifth year when he went through the formalities of registration, the patentee shall pay the annual fee for the sixth year no later than June 3, 2002 in the amount as prescribed for the sixth year.

#### 2.2.1.3 Surcharge

Where the patentee fails to pay the annual fee in time (not including the annual fee of the year in which the patent was granted), or where the fee has not been paid in full, the patentee may pay the fee or make up the insufficiency within six months from the expiration of the time limit within which the annual fee is due. If the late payment is made less than one month after the date of the expiration of the time limit within which the annual fee is due, no surcharge shall be paid.

Where the late payment is made more than one month after the date of expiration of the time limit, the surcharge in an amount calculated according to the following rules shall be paid:

(1) where the late payment is made more than one month but no more than two months after the date of expiration of the prescribed time limit, a surcharge of 5% of the annual fee shall be paid;

(2) where the late payment is made more than two months but no more than three months after the date of expiration of the prescribed time limit, a surcharge of 10% of the annual fee shall be paid;

(3) where the late payment is made more than three months but no more than four months after the date of expiration of the prescribed time limit, a surcharge of 15% of the annual fee shall be paid;

(4) where the late payment is made more than four months but no more than five months after the date of expiration of the prescribed time limit, a surcharge of 20% of the annual fee shall be paid; and

(5) where the late payment is made more than five months but no more than six months after the date of expiration of the prescribed time limit, a surcharge of 25% of the annual fee shall be paid.

Where, within six months after the expiration of the prescribed time limit, the shortage of annual fee or surcharge is paid but not paid in full, and another payment is necessary to make up the insufficiency, the annual fee and surcharge shall be complemented according to the surcharge standard for the period when the complementary payment is made. For example, the payment period for the surcharge of 5% of the annual fee is from May 10 to June 10, and the surcharge is 45 Yuan, but the payer paid 25 Yuan only. If the payer intends to make a complementary payment of the surcharge on June 15, the surcharge shall be 10% of the annual fee according to the surcharge standard for the period corresponding to the date of complementary payment. The amount of surcharge for this period is 90 Yuan, and therefore, the patentee shall further pay 65 Yuan.

Where failure to pay or pay in full the annual fee and/or surcharge within the prescribed time limit leads to termination of the patent right, in the procedure for restoration of right, the patentee shall further pay or complement a surcharge of 25% of the annual fee in addition to payment of the annual fee.

### 2.2.2 Termination

Where, at the expiration of surcharge period of annual fee, the pa-

tentee still fails to pay or pay in full the annual fee or the surcharge, a *Notification of Termination of Patent Right* shall be made by examiner two months after the expiration of surcharge period of annual fee. Where the patentee does not request for restoration of right or where the request for restoration of right is not approved, the patent right shall be handled to be invalid, and the termination of patent right shall be announced in the Patent Gazette by the Patent Office after four months from the issuance of the *Notification of Termination of Patent Right*.

The patent right shall terminate from the date on which the time limit for payment of the annual fee expires.

Art. 44. 1(2)

### 2.3 Patentee Abandons Patent Right

After the grant of patent right, the patentee may request to abandon his patent right on his own initiative at any time. Where a patentee request to abandon his patent right, he shall submit a declaration of abandonment of patent right with certifying materials of agreement of the abandonment of the patent right signed or sealed by all the patentees attached, or only submit a declaration of abandonment of patent right signed or sealed by all the patentees. Where a patent agency is designated, the formalities of abandonment of patent right shall be gone through by the patent agency, with declaration of agreement of abandonment of patent right signed or sealed by all the patentees attached. Declarations of abandonment of patent right on the patentee's own initiative shall not have any additional conditions. The abandonment of patent right refers to the abandonment of the entire patent right. The declaration of partial abandonment of patent right shall be deemed not to have been made.

Where the declaration of abandonment of patent right does not meet the requirements after examination, the examiner shall issue a *Notification that Declaration Deemed Not to Have Been Made*. Where it meets the requirements, the examiner shall send a *Notification of Passing Examination on Formalities*, register relevant matters in the Patent Register and announce them in the Patent Gazette. The date when the declaration of abandonment of patent right takes effect is the issuance date of the *Notification of Passing Examination on Formalities*, and the patent right abandoned by the patentee shall terminate from that date. The patentee shall not be allowed to request for revoking the declaration of abandonment of patent right unless there is qualified reason.

Unless an inauthentic owner of the patent right as the patentee has already abandoned the patent right in bad faith, the authentic owner can not( effective legal documents shall be provided to prove it) request to revoke the declaration of abandonment of the patent right.

Rule 41.5

Where the applicant declares abandonment of patent for utility model under Article 9.1 and Rule 41.4, the Patent Office shall conduct registration and announcement of the declaration of abandonment of the patent right for utility model when the grant of the patent right for invention is announced. Where the abandonment of patent for utility model is declared in invalidation procedure, the Patent Office shall conduct registration and announcement of the declaration in time. The date when the declaration of abandonment of patent right for utility model takes effect is the date of the announcement of grant of patent right for invention, and the patent right for utility model which has been abandoned shall terminate from the same day.

# Chapter 10 Evaluation Report of Patent

## 1. Introduction

Art. 61.2
Rule 56.1

According to Article 61.2, where any infringement dispute relates to a patent for utility model or design, the People's Court or the patent administrative authority for patent affairs may ask the patentee or any interested party to furnish an evaluation report of patent made by the State Intellectual Property Office (hereinafter SIPO).

At the request of the patentee or the interested party, SIPO shall conduct search on the relevant utility model patent or design patent, analyzing and evaluating whether the patent is in conformity with the granting conditions provided in the Patent Law and its Implementing Regulations, and make an evaluation report of patent.

An evaluation report of patent is an evidence for the People's Court or the administrative authority for patent affairs to judge and deal with disputes over patent infringement. It is mainly used to determine whether it is necessary to suspend relevant procedures. An evaluation report of patent is not an administrative decision, so the patentee or the interested party can not apply for administrative reconsideration or institute administrative litigation in that regard.

## 2. Formal Examination of Request for Evaluation Report of Patent

Upon receiving the written request for an evaluation report of patent submitted by patentee or interested party, SIPO shall carry out formal examination.

Rules 56.1 & 57

### 2.1 The Object of a Request for Evaluation Report of Patent

The object of the request for an evaluation report of patent shall be the granted utility model patent or design patent, including those terminated or renounced. In the following circumstances, the request for an evaluation report of patent shall be deemed not to have been made:

(1) where the request is made on the utility model or design patent application that has not been granted;

(2) where the request is made on the utility model or design patent which has been declared invalid in whole by the Patent Reexami-

nation Board; or

(3) where SIPO has made an evaluation report of patent on the requested utility model patent or the design patent.

Rule 56.1

### 2.2 Eligibility as a Petitioner for Evaluation Report of Patent

According to Rule 56.1, the patentee or the interested party may request SIPO to make an evaluation report of patent. Wherein, the interested party refers to the person who, according to Article 60, has the right to file a lawsuit before the People's Court or requests the administrative authority for patent affairs to handle the matter. For example, the licensee of exclusive patent license contract and the licensee of common patent license contract who has been authorized right of action by the patentee.

Where the petitioner is not the patentee or the interested party, the request for an evaluation report of patent shall be deemed not to have been made. Where the utility model or design patent is owned by several patentees, the petitioner may be some of the patentees.

Rule 56.2 & .3

### 2.3 Request for Evaluation Report of Patent

When making a request for an evaluation report of patent, the petitioner shall submit a request for an evaluation report of patent and other relevant documents.

(1) The request for an evaluation report of patent shall use the forms prescribed by SIPO. The patent number, the title of the invention-creation, the name of the petitioner and/or the patentee of the utility model or design patent shall be indicated in the request. Each request shall be limited to one utility model or design patent.

(2) The text upon which the evaluation report of patent will be made shall be stated in the request. The text shall be the published text of the utility model or design patent, or the text of utility model or design patent maintained valid in part by effective examination decision on request for invalidation. Where the text referred to by a request for an evaluation report of patent is the text maintained valid in part by effective examination decision on request for invalidation, the petitioner shall indicate the number of relevant examination decision on request for invalidation.

(3) Where the petitioner is the interested party, relevant certification documents shall be submitted together with request for an evaluation report of patent. For example, where the petitioner is the licensee

of exclusive patent license contract, the exclusive patent license contract signed with the patentee or its copy shall be submitted; where the petitioner is the licensee of common patent license contract authorized right of action by the patentee, the common patent license contract signed with the patentee or its copy and the certification of the authorization of right of action by the patentee shall be submitted. Where the above-mentioned patent license contract has been submitted to SIPO for record, the petitioner may not submit it, but shall indicate that in the request.

Where the request for an evaluation report of patent is not in conformity with the above provisions, SIPO shall notify the petitioner to make rectification within a specified time limit.

Rules 93, 94 & 99.3

**2.4 Fees**

If petitioner files the request for an evaluation report of patent, but the request fee has not paid, or not paid in full within one month from the submitting date of the request, the request shall be deemed not to have been made.

**2.5 Formalities Regarding Appointment of Representation**

Relevant matters regarding the request for an evaluation report of patent can be handled by the petitioner or the patent agency appointed by the petitioner. Where the petitioner shall appoint a patent agency according to Article 19.1, but fails to meet this requirement, SIPO shall notify the petitioner to make a rectification within a specified time limit.

Where the petitioner is the patentee and a patent agency has been appointed for the whole term of the patent, while another patent agency is appointed to go through relevant formalities when requesting to make an evaluation report of patent, a power of attorney shall be submitted separately, and it shall indicate that the scope of the authorized power is limited to relevant matters regarding evaluation report of patent; where the formalities regarding appointment of representation are not in conformity with relevant provisions, SIPO shall notify the petitioner to rectify within a specified time limit; if no rectification is made within the time limit or the rectification is not in conformity with the provisions, the appointment shall be deemed not to have been made; if relevant matters are handled by the petitioner himself, it shall be stated that he only handles matters regarding evaluation report of

patent.

Where the petitioner is the interested party and a patent agency is appointed, a power of attorney shall be submitted, and the scope of authorized power shall be indicated; where the formalities regarding appointment of representation are not in conformity with relevant provisions, SIPO shall notify the petitioner to rectify within a specified time limit; if no rectification is made within the time limit or the rectification is not in conformity with the provisions, the appointment shall be deemed not to have been made.

### 2.6 Handling after Formal Examination

Rule 56.3

(1) Where, upon formal examination, the request for an evaluation report of patent is not in conformity with relevant provisions and needs to be rectified, SIPO shall issue *Notification to Make Rectification*, requiring the petitioner to make rectification within 15 days from the date of receipt of the notification; where no rectification is made within the specified time limit or the same defects still exists in the request after two rectifications, the request shall be deemed not to have been made.

(2) Where the request for an evaluation report of patent is deemed not to have been made, SIPO shall issue *Notification that Request Deemed not to Have Been Made* to the petitioner.

(3) Where the request for an evaluation report of patent is in conformity with relevant provisions after formal examination, it shall be transmitted timely to the designated department which is responsible for making an evaluation report patent.

According to Rule 57, before an evaluation report of patent is made, if there are several petitioners requesting to make an evaluation report of patent on the same utility model or design patent separately, SIPO shall accept all the requests, but make only one evaluation report of patent.

## 3. Evaluation of Patent

On receiving the request for an evaluation report of patent, the department which is responsible for making an evaluation report of patent shall, according to the provisions of this Chapter, assign an examiner to conduct search, analyze, and evaluate on the patent and make the report.

### 3.1 Checking the Request for Evaluation Report of Patent

First, the examiner shall check the request for an evaluation report of patent and the relevant documents. If any non-conformance is found, it shall be returned to relevant department to solve, and the reasons shall be explained.

### 3.2 Content of Patent Evaluation

#### 3.2.1 Utility Model Patent

Content involved in an evaluation report of patent for a utility model includes:

(1) whether the utility model falls into the scope of subject matter which is nonpatentable according to Article 5 or Article 25, as to the evaluation standard, Chapter 1 of Part Ⅱ shall apply;

(2) whether the utility model falls into objects prescribed in Article 2.3, as to the evaluation standard, Chapter 2, Section 6 of Part Ⅰ shall apply;

(3) whether the utility model possesses practical applicability prescribed in Article 22.4, as to the evaluation standard, Chapter 5, Section 3 of Part Ⅱ shall apply;

(4) whether the description of the utility model sufficiently disclose the claimed subject matter according to Article 26.3, as to the evaluation standard, Chapter 2, Section 2.1 of Part Ⅱ shall apply;

(5) whether the utility model possesses novelty prescribed in Article 22.2, as to the evaluation standard, Chapter 6, Section 3 of Part Ⅳ shall apply;

(6) whether the utility model possesses inventive step prescribed in Article 22.3, Chapter 6, Section 4 of Part Ⅳ shall be applied concerning the evaluation standard;

(7) whether the utility model is in conformity with Article 26.4, Chapter 2, Section 3.2 of Part Ⅱ shall be applied concerning the evaluation standard;

(8) whether the utility model is in conformity with Rule 20.2, Chapter 2, Section 3.1.2 of Part Ⅱ shall be applied concerning the evaluation standard;

(9) whether the amendment to the utility model patent is in conformity with Article 33, Chapter 2, Section 8 of Part Ⅰ and Chapter 8, Section 5.2 of Part Ⅱ shall be applied concerning the evaluation stand-

ard;

(10) whether the divisional utility model patent is in conformity with Rule 43.1, Chapter 6, Section 3.2 of Part Ⅱ shall be applied concerning the evaluation standard; and

(11) whether the utility model is in conformity with Article 9, Chapter 3, Section 6 of Part Ⅱ shall be applied concerning the evaluation standard.

### 3.2.2 Patent for Design

Content involved in an evaluation report of patent for a design includes:

(1) whether the design patent falls into the scope of subject matter which is nonpatentable according to Article 5 or Article 25, Chapter 3, Section 6.1 and 6.2 of Part Ⅰ shall be applied concerning the evaluation standard;

(2) whether the design patent falls into objects prescribed in Article 2.4, Chapter 3, Section 7 of Part Ⅰ shall be applied concerning the evaluation standard;

(3) whether the design patent is in conformity with Article 23.1, Chapter 5, Section 5 of Part Ⅳ shall be applied concerning the evaluation standard;

(4) whether the design patent is in conformity with Article 23.2, Chapter 5, Section 6 of Part Ⅳ shall be applied concerning the evaluation standard;

(5) whether the drawings or photographs of the design patent are in conformity with Article 27.2, Chapter 3, Section 4 of Part Ⅰ shall be applied concerning the evaluation standard;

(6) whether the amendment to the design patent is in conformity with Article 33, Chapter 3, Section 10 of Part Ⅰ shall be applied concerning the evaluation standard;

(7) whether the divisional design patent is in conformity with Rule 43.1, Chapter 3, Section 9.4.2 of Part Ⅰ shall be applied concerning the evaluation standard; and

(8) whether the design patent is in conformity with Article 9, Chapter 5, Section 8 of Part Ⅳ shall be applied concerning the evaluation standard.

## 3.3 Search

Generally, before making an evaluation report of patent for a utility

model or a design, relevant search shall be conducted.

### 3.3.1 Utility Model Patent

The search shall direct to all claims of the utility model patent, however, if the subject matter of the utility model patent falls into the following circumstances, there is no need to make a search in that regard:

(1) being not in conformity with Article 2.3;

(2) falling into the scope of subject matter which is not patentable according to Article 5 or Article 25;

(3) lacking practical applicability;

(4) the description and claims fails to disclose the subject matter sufficiently clear and complete so as to enable a person skilled in the art to carry it out.

As to the specific requirements for the search, Chapter 7 of Part II shall apply.

### 3.3.2 Patent for Design

Search shall direct to all product designs as shown in the drawings or photos of the design patent and take the brief explanation into account. However, if the claimed designs of product fall into the following circumstances, there is no need to make a search in that regard:

(1) being not in conformity with Article 2.4;

(2) falling into the scope of the subject matter which is not patentable according to Article 5 or Article 25;

(3) the drawings or photographs of the design patent fail to disclose the claimed designs of product clearly.

When conducting the search, the examiner shall search the designs which have been made available to the public before the design patent's filing date in China. In order to determine whether there is a conflicting application, the examiner shall search all the design patents which are filed prior to the filing date of the patent being evaluated and published thereafter. In order to determine whether there is double patenting, the examiner shall search the published design patents which are filed on or before the filing date of the patent being evaluated.

## 4. Evaluation Report of Patent

Rule 57

SIPO shall make the evaluation report of patent within two months from receiving the eligible request for an evaluation report of

patent and the fee for request.

If the patent being evaluated is in conformity with the granting conditions prescribed in the Patent Law and its Implementation Regulations, the examiner shall draw a clear conclusion in the evaluation report of patent.

If the patent being evaluated is not in conformity with the granting conditions prescribed in the Patent Law and its Implementation Regulations, the examiner shall give the evaluation opinions in detail, and draw a clear conclusion of the evaluated patent's nonconformity with the Patent Law and its Implementation Regulations.

The evaluation report of patent shall use the unified standard form made by SIPO, it shall be jointly signed by the examiner and the check person, and sealed by "the Special Stamp for Evaluation Report of Patent of the State Intellectual Property Office of the P. R. C.".

### 4.1 Content of Evaluation Report of Patent

The evaluation report of patent includes forms reflecting the level of relevance of the reference documents and the patent being evaluated, and the description of whether the patent is in conformity with granting conditions prescribed in the Patent Law and its Implementation Regulations.

#### 4.1.1 The Form

Regarding the evaluation report of utility model patent, for requirements concerning how to fill in the items, Chapter 7, Section 12 of Part II shall apply.

Regarding the evaluation report of design patent, the form shall clearly record the fields and databases to be searched, the reference documents obtained by the search, and the level of relevance of the reference document with the design patent being evaluated, etc. In General, the following symbols are used to express the level of relevance of the reference documents with the design patent being evaluated:

X: the document that when taken alone, prejudices the design patent's conformity with Article 23.1 or 23.2;

Y: the document that when combined with other such design documents cited in the report, prejudices the design patent's conformity with Article 23.2;

A: the document defining the general state of the design, i. e. the

document that reflects part of the design features of the design patent or relevant prior design;

P: the intermediate document, that is the document published on dates falling between the filing date of the design patent and the claimed priority date, or the document that causes necessity to verify the priority of design patent;

E: the conflicting application document which is identical or substantially identical to the design patent;

R: the design patent document submitted by any entity or individual to the Patent Office on the filing date of the design patent being evaluated and constitutes identical invention-creation with it.

Among the above categories of documents, symbols X, Y, and A indicate the relevance of a reference document with the design patent in contents; symbols R and E indicate the relevance of a reference document with the design patent both in time and in contents; symbol P indicates the relevance of a reference document with the design patent in time, which shall be followed by a symbol of X, Y, E, or A indicating the relevance of the document in contents, and it is used under the circumstance that the priority of the design patent has not been verified.

#### 4.1.2 The Description

The conclusion of evaluation shall be explained in the description. If the evaluated patent is not in conformity with the granting conditions prescribed in the Patent Law and its Implementing Regulations, the examiner shall provide the evaluation opinion clearly and specifically.

(1) If the utility model patent is not in conformity with the conditions for granting prescribed in the Patent Law and its Implementing Regulations, a specific evaluation and a definite conclusion shall be given, and reference documents shall be cited if necessary. For example, for claims which do not possess novelty and/or inventive step, the examiner shall evaluate each of them; for multiple dependent claims, the examiner shall evaluate each technical solution therein formed by referring to different claims respectively; for a claim which has parallel alternative solutions, the examiner shall evaluate each solution.

(2) If the design patent is not in conformity with the conditions for granting prescribed in the Patent Law and its Implementing Regulations, the evaluation and definite conclusion shall be given for each

design, and reference documents shall be cited if necessary.

### 4.2 The Delivery of Evaluation Report of Patent

After the evaluation report of patent has been made, it shall be sent to the petitioner.

## 5. Consultation and Copying of Evaluation Report of Patent

According to Rule 57, after SIPO has made the evaluation report of patent, any entity or individual may consult or copy the report. Concerning the relevant procedures for consultation and copying, Chapter 4, Section 5.3 of Part V shall apply.

## 6. Correction of Evaluation Report of Patent

Where the department undertaking the evaluation of the patent finds that there is any mistake in the evaluation report of patent, the department may correct the evaluation report of patent on its own initiative. Where the petitioner thinks that in the evaluation report of patent there exists any mistake which needs to be corrected, he may request to correct the evaluation report of patent.

The corrected evaluation report of patent shall be sent to the petitioner timely.

### 6.1 Items Permitted to Be Corrected

Where any of the following mistakes exists in an evaluation report of patent, the following mistake may be corrected:

(1) any mistake of bibliographic data or the word thereof;

(2) any procedure mistake in making the evaluation report of patent;

(3) any obvious mistake in applying the laws or regulations;

(4) any obvious mistake in identifying the facts on which the conclusion relies; or

(5) any other mistake that shall be corrected.

### 6.2 Initiation of the Procedure for Correction

(1) Initiated by the department undertaking the evaluation report of patent on its own initiative

Where the department undertaking the evaluation finds in the evaluation report of patent that there is a mistake needs to be corrected, it may initiate the procedure for correction on its own initiative.

(2) Initiated by the Petitioner on his Request

Where the petitioner thinks that in the evaluation report of patent there is any mistake that needs to be corrected, he may submit a request for correction within two months from the date of receipt of the evaluation report of patent.

In submitting the request for correction, the petitioner shall submit the request in written form of observations, and indicate therein the items intended to be corrected and grounds for correction, but may not amend the patent document during the procedure for correction.

### 6.3 Implementation and Termination of the Correction

After the initiation of the procedure for correction, the department undertaking the evaluation report shall set up a reviewing group which consists of a chief member, a first member and a second member, to review the original evaluation report of patent. A review conclusion shall be given by the reviewing group after deliberation according to the majority of votes. The examiner and the check person conducting the previous evaluation report shall not participate in the reviewing group.

If the reviewing group holds that the request for correction are not well grounded, and there is no mistake in the initial evaluation report of patent so that it needs not to be corrected, it shall explain the reasons as not to correct the evaluation report of patent in *Notification of Reviewing Conclusion Concerning Evaluation Report of Patent* issued to the petitioner.

If the reviewing group finds that the request for correction are well grounded, and the initial evaluation report of patent has a mistake that really needs to be corrected, it shall reissue an amended evaluation report of patent without the mistake, and indicate clearly in the amended evaluation report of patent that this report shall substitute the previous evaluation report of patent and the procedure terminates.

During the procedure for correction, normally the reviewing group does not need to conduct a supplementary search, unless the identification of facts has changed so as to make the previous search incomplete or inaccurate. Usually only one request can be submitted to correct the evaluation report of patent, however, for the mended evaluation report of patent issued by the reviewing group after a supplementary search, the petitioner may once again submit a request for correction.

# Chapter 11 Provisions on Electronic Application

## 1. Introduction

According to Rule 2 of the Implementing Regulations, any formalities prescribed by the Patent Law and these Implementing Regulations shall be complied with in a written form or in any other form prescribed by the Patent Office. The "other form" prescribed by the Patent Office includes electronic form.

Electronic application refers to the patent application which is submitted, through Internet as the transmission media, to the Patent Office in electronic form complied with the provisions.

Provisions concerning patent application and other documents of the Patent Law, its Implementing Regulations, and these Guidelines shall, except those regulating patent application and other documents submitted in paper form, apply to electronic application.

Format of electronic documents shall be otherwise stipulated by the Patent Office.

## 2. Electronic Application User

Electronic application user refers to the applicant or the patent agency that has already signed the User Registration Agreement of Electronic Patent Application System (hereinafter referred to the User Registration Agreement) with the Patent Office, gone through the formalities of user registration, and obtained the user code and password.

### 2.1 Representative of Electronic Application

Where there are two or more applicants without appointing a patent agency, the electronic application user submitting the electronic application shall be the representative.

### 2.2 Electronic Signature

Electronic signature refers to the data attached in electronic documents submitted or sent through the Electronic Patent Application System of the Patent Office, for the use of identifying the identity of the signatory and showing that the signatory has recognized the contents therein.

"Signed or sealed" mentioned in Rule 119. 1 of the Implementing Regulations refers to the act to attach electronic signature in electronic application documents. Electronic signature in electronic application documents has the same legal effect with signature in paper documents.

### 3. Registration of Electronic Application User

Ways for registration of electronic application user include registration in person, registration by post, and online registration.

When going through the formalities of registration of electronic application user, user shall submit the Request for Registration of Electronic Application User, User Registration Agreement signed or sealed in duplicate, and certifying documents of user registration.

### 3. 1 Request for Registration of Electronic Application User

The request for registration of electronic application user shall adopt the standard form made by the Patent Office. Name or title, type, identification number, nationality or the registered place, habitual residence or place of business office, detailed address and postal code of the registration requester shall be indicated in the request.

Where the registration requester is an entity, information of the handling person shall be written in the request.

### 3. 2 Certifying Documents of User Registration

Where the registration applicant is an individual, a copy of identification card or other identity certificate signed or sealed by himself shall be submitted. Where the registration applicant is an entity, a copy of business license or organization certificate with the official seal of the entity affixed and a copy of identity certificate signed or sealed by the handling person shall be submitted. Where the registration applicant is a patent agency, a copy of registration certificate of the patent agency with its official seal affixed and a copy of identity certificate signed or sealed by the handling person shall be submitted.

### 3. 3 Examination of the Request for Registration

Where the registration documents pass the examination, the *Notification of Examination on Registration of Electronic Application* and the user registration agreement sealed by the Patent Office shall be issued to the registration applicant, and the user code shall be given. Where it

is registration in person, the password shall be set by the registration applicant on the spot; where it is registration by post, the password shall be informed to the registration applicant in the *Notification of Examination on Registration of Electronic Application*; where it is online registration, the password shall be preset by the registration applicant when submitting the request for registration.

Where the registration documents fail to pass the examination, for registration in person, the reasons for the failure of registration shall be explained to the registration applicant directly, and the registration materials shall not be accepted; for registration by post or online registration, the *Notification of Examination on Registration of Electronic Application*, in which reasons for the failure of registration shall be described, shall be sent to the registration applicant, and the registration materials shall not be returned.

### 3.4 Changes of Information of Electronic Application User

Where information such as password, detailed address, postal code, telephone number, fax number, Email address, and manner of information cue, etc. changes, the registered user shall log on the electronic application website to make changes online.

Where information such as name or title, type, identification card number, nationality or the registered place, habitual residence or place of business office, etc. changes, the registration user shall submit to the Patent Office the Request for Changing Information of Electronic Application User and relevant certifying documents to go through the formalities for change.

The registered user code shall not be changed.

## 4. Receipt and Acceptance of Electronic Application

The scope of acceptance concerning electronic application includes:

(1) patent applications for invention, utility model and design;

(2) international applications entering the national phase; and

(3) requests for reexamination and invalidation.

### 4.1 Receipt of Electronic Application

The applicant shall submit electronic application documents in accordance with the prescribed file format, data standard, operation specification, and transmission mode. If the requirements are met, an elec-

tronic application return receipt of the documents received shall be sent; if the requirements are not met, the electronic documents shall be refused.

Where any entity or individual believes that a patent application shall be handled as secret patent application, it should not be submitted through Electronic Patent Application System.

### 4.2 Acceptance of Electronic Application

Where the content of electronic application obviously does not fall under the subject matters of patent application, it shall be not accepted.

Requirements for acceptance of electronic application shall comply with the provisions of Chapter 3, Section 2.1 of Part V of these Guidelines, and the procedure of acceptance is as follows:

(1) Determining the submission date and the filing date

The date on which the Electronic Patent Application System of the Patent Office receives the electronic documents is the submission date.

The date on which the Electronic Patent Application System of the Patent Office receives the patent application documents which are in conformity with the Patent Law and its Implementing Regulations is the filing date.

(2) Assignment of the application number

The Electronic Patent Application System of the Patent Office shall assign the application number automatically according to the type and filing date of the patent application and record the application number in the request and database.

(3) Issuing notification

Where the electronic application complies with the requirements of acceptance after examination, the examiner shall issue the *Notification of Acceptance and Notification to Pay Filing Fees*; where the request for reduction or postponement of the payment has been submitted, the examiner shall issue the *Notification of Acceptance* and the *Notification of Decision on Reduction of Fees*.

## 5. Special Provisions on Examination of Electronic Application

### 5.1 Power of Attorney

Any applicant who appoints a patent agency for applying for a

patent, or for having other patent matters to attend to in electronic form, shall submit a power of attorney in electronic form and the original paper power of attorney. Any applicant who appoints a patent agency for handling formalities of reduction or postponement of the payment shall declare it in the power of attorney in electronic form.

Where the general power of attorney has been deposited with the Patent Office, if the serial number of that general power of attorney has been indicated in the request when filling the application or has been indicated in the statement when going through the formality for a change of bibliographic data, the patent agency shall be exempted from submitting the general power of attorney in electronic form and the photocopy thereof.

### 5.2 Dissolution of Appointment and Resignation of Appointment

Where a patent agency has been appointed by the applicant of electronic application, at least one applicant shall be electronic application user when the formalities of dissolution or resignation of appointment are gone through. Where none of the applicants is the electronic application user, the formalities of dissolution or resignation of appointment shall not be gone through. The examiner shall issue the *Notification that Request Deemed Not to Have Been Made* and notify the party concerned to go through the formalities of Registration of Electronic Application User.

Where the formalities of dissolution are in conformity with the requirements, the applicant who has registered as electronic application user to go through the formalities shall be the representative of the patent application.

Where the formalities of resignation are in conformity with the requirements, the applicant who has registered as electronic application user and has been indicated in the request shall be the representative of the patent application. Where no representative has been designated, the first named applicant who has registered as electronic application user shall be the representative of the patent application.

### 5.3 Changes due to Patent Agency Revoked

Where the patent agency appointed by the applicant is revoked by SIPO and the applicant appoints another patent agency, the new patent agency shall be the electronic application user.

Where the patent agency appointed by the applicant is revoked

and the applicant does not appoint another patent agency, if the applicant is an individual or entity in mainland China and has registered as the electronic application user, the first named applicant shall be the representative. Where none of the applicants is the electronic application user, the examiner shall notify the applicant in paper form to go through the formalities of registration of electronic application user. According to Article 19.1 of the Patent Law, where the applicant is required to appoint a patent agency, the examiner shall notify the applicant to appoint a new patent agency which has registered as the electronic application user.

### 5.4 Changes due to Transfer of Right to Apply for a Patent (or Patent Right)

Where the request for a change of the name of applicant (or patentee) is made due to the transfer of right to apply for a patent (or patent right), and the applicant (or patentee) after the change does not appoint a patent agency, the applicant (or patentee) after the change shall be an electronic application user. Where the applicant (or patentee) after the change appoints a patent agency, the patent agency appointed shall be an electronic application user.

The formalities of making changes in bibliographic data shall be gone through in electronic form. Where the request for a change in bibliographic data is made in paper form, the examiner shall issue the *Notification that Request Deemed Not to Have Been Made* to the party concerned.

### 5.5 Documents Required to be Submitted in Original Paper Form

Where applicant submits an electronic application which has been accepted, all formalities relating to patent application shall be gone through in electronic form. The documents which shall be submitted in original paper form according to provisions of the Patent Law, its Implementing Regulations, and the guidelines, such as certifying documents for reduction or postponement of the payment, power of attorney, certifying documents for change in bibliographic data, evidence in reexamination and invalidation procedures, etc., shall be submitted in original paper form within the time limit prescribed in the Patent Law, its Implementing Regulations, and the Guidelines.

Where certifying documents for reduction or postponement of the payment are submitted when filing the patent application, the applicant

shall submit the scanned copy of the paper certifying documents for reduction or postponement of the payment at the same time.

### 5.6 Transformation between Paper Application and Electronic Application

The applicant or patent agency may request to transform paper application to electronic application, except for those applications relating to national security or vital interests which shall be kept secret.

The applicant or patent agency submitting the request shall be the electronic application user, and the request shall be submitted in electronic form. Where the request passes the examination, the subsequent formalities shall be gone through in electronic form. Where the request is submitted in paper form, the examiner shall issue the *Notification that Request Deemed Not to Have Been Made* in paper form.

## 6. Delivery by Electronic Means

The Patent Office shall send all kinds of notifications and decisions to the electronic application user in electronic form through the Electronic Patent Application System. The electronic application user shall receive the electronic notifications and decisions sent by the Patent Office in time. If the electronic application user fails to do so in time, no announcement delivery shall be made.

Where the electronic application user does not receive electronic notifications and decisions within 15 days from the date of issuance, the Patent Office may send the copy of the notifications and decisions in paper form.

# Others

# Index

In this index, the place of a term is given in such a way as the following example shows. For example, Ⅰ. Ⅰ-6.2.1.2 indicates that the term is in Part Ⅰ, Chapter 1, Section 6.2.1.2.

# Explanatory Notes on the Amendment

Since entering into force on July 1, 2006, the Guidelines for Examination (the 2006 version) have played a favorable role in guiding, standardizing, and unifying the practice of patent application and examination. The Decision of the Standing Committee of the Eleventh National People' s Congress on amending the Patent Law of the People' s Republic of China was adopted at its 6th meeting on December 27, 2008, and the Decision of the State Council on amending the Implementing Regulations of the Patent Law of the People' s Republic of China was adopted at its 95th executive meeting on December 30, 2009, (hereinafter the third amendment to the Patent Law and its Implementing Regulations). In order to adapt to the third amendment to the Patent Law and its Implementing Regulations, the Guidelines for Patent Examination was amended by the State Intellectual Property Office, mainly based on the principle of adaptive amendment, concurrently taking account of streamlining the procedure, increasing the efficiency of examination and approval, standardizing the practice of examination and approval.

**I. Amendment Procedure**

The amendment to the Guidelines for Patent Examination was initiated in November 2008, mainly comprising the following stages:

The first stage (November 4, 2008 to December 5, 2008): early preparations.

The leading group and the working groups for the amendment to the Guidelines for Examination were set up. The leading group was responsible for guiding and approving the amendments to the Guidelines for Examination, and the working groups were responsible for doing ground research, drafting and editing the amendments. The initiation meeting for the amendment to the Guidelines for Examination was convened on December 4 and December 5, to determine the guiding thoughts, basic principles and working plan for the amendment.

The second stage (December 6, 2008 to March 24, 2009): investigating, and submitting proposals for amendments.

The working groups comprehensively reviewed the contents involved in the third amendment to the Patent Law and its Implementing Regulations; broadly solicited comments and suggestions on the amendments to the Guidelines for Examination within and outside the Office; thoroughly investigated relevant amendments to the Patent law and its Implementing Regulations for the legislative principles; analyzed the transition of the existing examination standards, and compared relevant domestic and foreign legal provisions; conduc-

ted research on the procedure of filing, examination and substantive examination standards involving relevant amendments, and conceived solutions in that regard; proposed specific amending solutions to the relevant amendments taking account of amendment suggestions from the Office or the outside; and drafted suggesting amendments.

The third stage (March 25, 2009 to May 18, 2009): the review by the leading group, drafting and editing by the working groups.

The leading group discussed and reviewed the suggesting amendments, made guiding comments on the relevant procedures of filing and examination in the new legal framework, and gave amendment suggestions on some specific examination standards. According to the review opinions of the leading group, the drafters conducted in-depth study regarding the relevant problems, further improved the suggesting amendments, and finished the draft amendment to the Guidelines for Examination. The editors read and checked the draft amendment thoroughly. During the period of time, many seminars and coordination meetings were held between the working groups and the Legal Affairs Department, between the drafters and examination departments to guarantee the integrity and consistence of relevant amendments. The working groups made several submissions relating to the problems found in the course of editing to the leading group for discussion, and made several modifications to the draft amendment to the Guidelines according to the review opinions of the leading group.

The fourth stage (May 19, 2009 to June 5, 2009): soliciting comments on the draft amendment within or outside the Office.

The working groups solicited comments and suggestions on the final version of amendment produced in the third stage from the examination departments and examiners of the Office; meanwhile, symposia and seminars were convened to explain and discuss the amendment, soliciting comments from relevant departments outside the Office, applicants and patent agents. All together, over 900 pieces of comment and suggestion on the amendment were received.

The fifth stage (June 6, 2009 to July 9, 2009): amending and improving.

The working groups analyzed and researched the comments and suggestions collected in the fourth stage, in combination with the specific amendments; according to the principles for amending, the working groups accepted some of the suggestions, revised and improved the draft amendment. Editors re-edited the improved draft amendment, and submitted the important amendment therein to the leading group for review.

The sixth stage (July 10, 2009 to August 10, 2009): soliciting comments for the second time.

Amendment to the Guidelines for Examination produced in the fifth stage was published on the government website of Legislative Affairs Office of the State Council P. R. China to solicit comments from the public. During the period of time, the working groups received comments and suggestions not only from applicants and patent agents in China, but

also from foreign institutions, such as United States Patent and Trademark Office, European Patent Office, etc.

The seventh stage (August 11, 2009 to December 31, 2009): further amending and improving.

Based on the work of soliciting comments from the public in the sixth stage, the amendment to the Guidelines for Patent Examination was further improved according to the amendment suggestions and the draft amendment to the Implementing Regulations. During the period of time, in accordance with the revision of the draft amendment to the Implementing Regulations in the course of amending, editors and drafters worked together, revising the relevant procedure of filing and examination and substantive examination standards for several times, and the leading group reviewed the revision arising therefrom.

The eighth stage (January 2010): approval and promulgation.

The Ordinance No. 55 was signed by the Commissioner of the State Intellectual Property Office on January 21, 2010 to promulgate the Guidelines for Patent Examination, and the whole text of it was published on the government website of the State Intellectual Property Office (www. sipo. gov. cn).

The ninth stage (February 2010): The Guidelines for Patent Examination (the 2010 version) was printed and distributed.

**II. Major contents of amendment**

The Guidelines for Patent Examination was mainly amended to be adapted to the third amendment to the Patent Law and its Implementing Regulations, and the adaptive amendment mainly involved the following aspects:

1. According to the requirements for genetic resources protection and the disclosure of the source of genetic resources prescribed in the Patent Law and its Implementing Regulations, specific requirements for the patent application developed relying on genetic resources, and examination standards on the disclosure of genetic resources in preliminary examination and substantive examination were added in.

2. With regard to the revision of Article 9 and Rule 41, handling of identical inventions-creations in preliminary examination, substantive examination, and invalidation procedure were amended accordingly.

3. According to Article 20, Rules 8 and 9, where an application for patent is filed abroad regarding an invention or a utility model developed in China, a confidential examination shall be conducted on it. As a result, the confidential examination procedure for the filing of an application abroad was added in.

4. With regard to the revision of Novelty prescribed in Article 22, the examination standard on novelty and relevant provisions concerning evidence in the invalidation procedure were amended accordingly.

5. According to the revision of granting conditions for design patent in the Patent Law

and its Implementing Regulations, the specific examination standard in the preliminary examination regarding relevant granting conditions for design patent, and the specific examination standard in the invalidation procedure regarding the examination in accordance with Article 23 were added in.

6. According to Article 61, Rules 56 and 57, the procedure for receiving and handling of the request for evaluation report of patent and the making of the report were set up, and specific evaluation standard on utility model patent and design patent were introduced.

The amendments made for further streamlining the procedure, increasing efficiency of the patent examination and approval, and standardizing the examination and approval practice mainly involve the following contents:

1. to make applicants feel more convenient, the procedures were simplified as far as possible, and those unfavorable to the applicants and the practice were amended. For example, in the examination of application relating to biological material, the provision that the examiner should issue a *Notification to Make Rectification* regarding the date of deposit indicated in the certificate was added;

2. the contents relating to the application and examination practice, which tend to arouse confusion or result in the diversion in understanding and practice were amended. For example, examination in accordance with Article 33 and Rule 51 was revised;

3. the contents proved to be feasible and have favorable effect in the examination practice were incorporated into the Guidelines for Examination. For example, the provision relating to the special power of attorney in the invalidation procedure was added;

4. some forward-looking provisions with regard to solving the inconsistency in standard, which may arise in the future examination practice, were introduced to help improving the quality of examination. For example, it was clarified that *ex officio* examination was permitted in the collegiate examination procedure on request for invalidation; and

5. taking the harmonization with the international practice into consideration, some relevant provisions in the normative documents issued by the State Intellectual Property Office were incorporated into the Guidelines for Examination. For example, the provisions relating to the preliminary and substantive examination of international applications entering the national phase on the items incorporated into the application by reference were added in.

# Annexes

# PATENT LAW

# OF THE PEOPLE'S REPUBLIC OF CHINA[1]

(Adopted at the 4th Meeting of the Standing Committee of the Sixth National People's Congress on March 12, 1984

Amended the first time in accordance with the Decision of the Standing Committee of the Seventh National People's Congress on Amending the Patent Law of the People's Republic of China adopted at its $27^{th}$ Meeting on September 4, 1992

Amended the second time in accordance with the Decision of the Standing Committee of the Ninth National People's Congress on Amending the Patent Law of the People's Republic of China adopted at its $17^{th}$ Meeting on August 25, 2000

Amended the third time in accordance with the Decision of the Standing Committee of the Eleventh National People's Congress on Amending the Patent Law of the People's Republic of China adopted at its $6^{th}$ Meeting on December 27, 2008)

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[1] Translated by the State Intellectual Property Office of the People's Republic of China. In case of discrepancy, the original version in Chinese shall prevail.

# TABLE OF CONTENTS[1]



[1] This table of contents was established for the convenience of the reader by the State Intellectual Property Office of the People's Republic of China. The text of the Patent Law adopted by the Standing Committee of the National People's Congress does not contain such a table.

# Chapter I
# General Provisions

**Article 1.** This Law is enacted to protect the legitimate rights of the patentee, to encourage inventions-creations, to advance the exploitation of inventions-creations, to enhance innovation capability, and to promote the progress of science and technology and the development of economy and society.

**Article 2.** In this Law, "inventions-creations" mean inventions, utility models and designs.

"Invention" means any new technical solution relating to a product, a process or improvement thereof.

"Utility model" means any new technical solution relating to the shape, the structure, or their combination, of a product, which is fit for practical use.

"Design" means any new design of the shape, the pattern, or their combination, or the combination of the color with shape or pattern, of a product, which creates an aesthetic feeling and is fit for industrial application.

**Article 3.** The patent administration department under the State Council is responsible for the patent work throughout the country. It receives and examines patent applications, and grants patent right for inventions-creations in accordance with the law.

The administrative authority for patent affairs under the people's governments of provinces, autonomous regions and municipalities directly under the central government are responsible for the administrative work concerning patents in their respective administrative areas.

**Article 4.** Where an invention-creation for which a patent is applied for relates to the security or other vital interests of the State and is required to be kept secret, the application shall be treated in accordance with the relevant prescriptions of the State.

**Article 5.** No patent right shall be granted for any invention-creation that is contrary to the laws or social morality or that is detrimental to public interest.

No patent right shall be granted for any invention-creation where acquisition or use of the genetic resources, on which the development of the invention-creation relies, is not consistent with the provisions of the laws or administrative regulations.

**Article 6.** An invention-creation, made by a person in execution of the tasks of the entity to which he belongs, or made by him mainly by using the material and technical means of the entity is a service invention-creation. For a service intention-creation, the right to apply for a patent belongs to the entity. After the application is approved, the entity shall be the patentee.

For a non-service invention-creation, the right to apply for a patent belongs to the inventor or creator. After the application is approved, the inventor or creator shall be the patentee.

In respect of an invention-creation made by a person using the material and technical means of an entity to which he belongs, where the entity and the inventor or creator have entered into a contract in which the right to apply for and own a patent is provided for, such provisions shall apply.

**Article 7.** No entity or individual shall prevent the inventor or creator from filing an application for a patent for a non-service invention-creation.

**Article 8.** For an invention-creation jointly made by two or more entities or individuals, or made by an entity or individual in execution of a commission given to it or him by another entity or individual, the right to apply for a patent belongs, unless otherwise agreed upon, to the entity or individual that made, or to the entities or individuals that jointly made, the invention-creation. After the application is approved, the entity or individual that applied for it shall be the patentee.

**Article 9.** For any identical invention-creation, only one patent right shall be granted. Where an applicant files on the same day applications for both patent for utility model and patent for invention relating to the identical invention-creation, and the applicant declares to abandon the patent for utility model which has been granted and does not terminate, the patent for invention may be granted.

Where two or more applicants file applications for patent for the identical invention-creation, the patent right shall be granted to the applicant whose application was filed first.

**Article 10.** The right of patent application and the patent right may be assigned.

Any assignment, by a Chinese entity or individual, of the right of patent application, or of the patent right, to a foreigner, a foreign enterprise or any other foreign organization shall proceed by going through the formalities as provided by the relevant laws and administrative regulations.

Where the right of patent application or the patent right is assigned, the parties shall conclude a written contract and register it with the patent administration department under the State Council. The patent administration department under the State Council shall an-

nounce the registration. The assignment shall take effect as of the date of registration.

**Article 11.** After the grant of the patent right for an invention or utility model, except where otherwise provided for in this Law, no entity or individual may, without the authorization of the patentee, exploit the patent, that is, make, use, offer to sell, sell or import the patented product, or use the patented process, and use, offer to sell, sell or import the product directly obtained by the patented process, for production or business purposes.

After the grant of the patent for a design, no entity or individual may, without the authorization of the patentee, exploit the patent, that is, make, offer to sell, sell or import the product incorporating its or his patented design, for production or business purposes.

**Article 12.** Any entity or individua1 exploiting the patent of another shall conclude with the patentee a license contract for exploitation and pay the patentee a fee for the exploitation of the patent. The licensee has no right to authorize any entity or individual, other than that referred to in the contract, to exploit the patent.

**Article 13.** After the publication of the application for a patent for invention, the applicant may require the entity or individual exploiting the invention to pay an appropriate fee.

**Article 14.** Where any patent for invention, belonging to any state-owned enterprise or institution, is of great significance to the interest of the State or to the public interest, the competent departments concerned under the State Council and the people's governments of provinces, autonomous regions or municipalities directly under the central government may, after approval by the State Council, decide that the patented invention be spread and applied within the approved limits, and allow designated entities to exploit that invention. The exploiting entity shall, according to the regulations of the State, pay a fee for exploitation to the patentee.

**Article 15.** Where the co-owners of a patent application or a patent have concluded an agreement on the exercising of the right, the agreement shall apply. In the absence of such agreement, any co-owner may independently exploit the patent or license another party to exploit the patent through non-exclusive license; any fee for the exploitation obtained from licensing others to exploit the patent shall be distributed among the co-owners.

Except for the circumstances as provided in the preceding paragraph, a jointly-owned patent application or patent shall be exercised with the consent of all co-owners.

**Article 16.** The entity that is granted a patent right shall award to the inventor or creator of a service invention-creation a reward and, upon exploitation of the patented inven-

tion-creation, shall pay the inventor or creator a reasonable remuneration based on the extent of spreading and application and the economic benefits yielded.

**Article 17.** The inventor or creator has the right to be named as such in the patent document.

The patentee has the right to affix a patent indication on the patented product or on the package of that product.

**Article 18.** Where any foreigner, foreign enterprise or other foreign organization having no habitual residence or business office in China files an application for a patent in China, the application shall be treated under this Law in accordance with any agreement concluded between the country to which the applicant belongs and China, or in accordance with any international treaty to which both countries are party, or on the basis of the principle of reciprocity.

**Article 19.** Where any foreigner, foreign enterprise or other foreign organization having no habitual residence or business office in China applies for a patent, or has other patent matters to attend to, in China, it or he shall appoint a legally incorporated patent agency to act as his or its agent.

Where any Chinese entity or individual applies for a patent or has other patent matters to attend to in the country, it or he may appoint a legally incorporated patent agency to act as its or his agent.

The patent agency shall comply with the provisions of laws and administrative regulations, and handle patent applications and other patent matters according to the instructions of its clients. In respect of the contents of its clients' inventions-creations, except for those that have been published or announced, the agency shall bear the responsibility of keeping them confidential. The administrative regulations governing the patent agency shall be formulated by the State Council.

**Article 20.** Where any entity or individual intends to file an application for patent abroad for any invention or utility model developed in China, it or he shall request in advance the patent administration department under the State Council for confidentiality examination. The procedures and duration etc. of the confidentiality examination shall be implemented in accordance with the regulations of the State Council.

Any Chinese entity or individual may file an international application for patent in accordance with any international treaty concerned to which China is party. The applicant filing an international application for patent shall comply with the provisions of the preceding paragraph.

The patent administration department under the State Council shall handle any interna-

tional application for patent in accordance with the international treaty concerned to which China is party, this Law and the relevant regulations of the State Council.

For an invention or utility model, if a patent application has been filed in a foreign country in violation of the provisions of the first paragraph of this Article, it shall not be granted patent right while filing application for patent in China.

**Article 21.** The patent administration department under the State Council and its Patent Reexamination Board shall handle any patent application and patent-related request according to law and in conformity with the requirements of being objective, fair, correct and timely.

The patent administration department under the State Council shall release patent information in a complete, correct, and timely manner, and publish patent gazette on a regular basis.

Until the publication or announcement of the application for a patent, staff members of the patent administration department under the State Council and other persons involved have the duty to keep its contents confidential.

## Chapter II
## Requirements for Grant of Patent Right

**Article 22.** Any invention or utility model for which patent right may be granted must possess novelty, inventiveness and practical applicability.

Novelty means that, the invention or utility model does not form part of the prior art; nor has any entity or individual filed previously before the date of filing with the patent administration department under the State Council an application relating to the identical invention or utility model disclosed in patent application documents published or patent documents announced after the said date of filing.

Inventiveness means that, as compared with the prior art, the invention has prominent substantive features and represents a notable progress, and that the utility model has substantive features and represents progress.

Practical applicability means that, the invention or utility model can be made or used and can produce effective results.

The prior art referred to in this Law means any technology known to the public before the date of filing in China or abroad.

**Article 23.** Any design for which patent right may be granted shall not be a prior design, nor has any entity or individual filed before the date of filing with the patent adminis-

tration department under the State Council an application relating to the identical design disclosed in patent documents announced after the date of filing.

Any design for which patent right may be granted shall significantly differ from prior design or combination of prior design features.

Any design for which patent right may be granted must not be in conflict with the legitimate right obtained before the date of filing by any other person.

The prior design referred to in this Law means any design known to the public before the date of filing in China or abroad.

**Article 24.** An invention-creation for which a patent is applied for does not lose its novelty where, within six months before the date of filing, one of the following events occurred:

(1) where it was first exhibited at an international exhibition sponsored or recognized by the Chinese Government;

(2) where it was first made public at a prescribed academic or technological meeting;

(3) where it was disclosed by any person without the consent of the applicant.

**Article 25.** For any of the following, no patent right shall be granted:

(1) scientific discoveries;

(2) rules and methods for mental activities;

(3) methods for the diagnosis or for the treatment of diseases;

(4) animal and plant varieties;

(5) substances obtained by means of nuclear transformation;

(6) designs of two-dimensional printing goods, made of the pattern, the colour or the combination of the two, which serve mainly as indicators.

For processes used in producing products referred to in items (4) of the preceding paragraph, patent right may be granted in accordance with the provisions of this Law.

# Chapter III
# Application for Patent

**Article 26.** Where an application for a patent for invention or utility model is filed, a request, a description and its abstract, and claims shall be submitted.

The request shall state the title of the invention or utility model, the name of the inventor, the name and the address of the applicant and other related matters.

The description shall set forth the invention or utility model in a manner sufficiently clear and complete so as to enable a person skilled in the relevant field of technology to

carry it out; where necessary, drawings are required. The abstract shall state briefly the main technical points of the invention or utility model.

The claims shall be supported by the description and shall define the extent of the patent protection sought for in a clear and concise manner.

Where an invention-creation is developed relying on the genetic resources, the applicant shall indicate, in the application documents, the direct and original source of such genetic resources; where the applicant fails to indicate the original source, he or it shall state the reasons thereof.

**Article 27.** Where an application for a patent for design is filed, a request, drawings or photographs of the design and a brief explanation of the design shall be submitted.

The relevant drawings or photographs submitted by the applicant shall clearly indicate the design of the product for which patent protection is sought.

**Article 28.** The date on which the patent administration department under the State Council receives the application shall be the date of filing. If the application is sent by mail, the date of mailing indicated by the postmark shall be the date of filing.

**Article 29.** Where, within twelve months from the date on which any applicant first filed in a foreign country an application for a patent for invention or utility model, or within six months from the date on which any applicant first filed in a foreign country an application for a patent for design, he or it files in China an application for a patent for the same subject matter, he or it may, in accordance with any agreement concluded between the said foreign country and China, or in accordance with any international treaty to which both countries are party, or on the basis of the principle of mutual recognition of the right of priority, enjoy a right of priority.

Where, within twelve months from the date on which any applicant first filed in China an application for a patent for invention or utility model, he or it files with the patent administration department under the State Council an application for a patent for the same subject matter, he or it may enjoy a right of priority.

**Article 30.** Any applicant who claims the right of priority shall make a written declaration when the application is filed, and submit, within three months, a copy of the patent application document which was first filed; if the applicant fails to make the written declaration or to meet the time limit for submitting the copy of the patent application document, the claim to the right of priority shall be deemed not to have been made.

**Article 31.** An application for a patent for invention or utility model shall be limited to one invention or utility model. Two or more inventions or utility models belonging to a

single general inventive concept may be filed as one application.

An application for a patent for design shall be limited to one design. Two or more similar designs for the same product or two or more designs which are incorporated in products belonging to the same class and sold or used in sets may be filed as one application.

**Article 32.** An applicant may withdraw his or its application for a patent at any time before the patent right is granted.

**Article 33.** An applicant may amend his or its application for a patent, but the amendment to the application for a patent for invention or utility model may not go beyond the scope of disclosure contained in the initial description and claims, and the amendment to the application for a patent for design may not go beyond the scope of the disclosure as shown in the initial drawings or photographs.

## Chapter IV
## Examination and Approval of Application for Patent

**Article 34.** Where, after receiving an application for a patent for invention, the patent administration department under the State Council, upon preliminary examination, finds the application to be in conformity with the requirements of this Law, it shall publish the application promptly after the expiration of eighteen months from the date of filing. Upon the request of the applicant, the patent administration department under the State Council publishes the application earlier.

**Article 35.** Upon the request of the applicant for a patent for invention, made at any time within three years from the date of filing, the patent administration department under the State Council will proceed to examine the application as to its substance. If, without any justified reason, the applicant fails to meet the time limit for requesting examination as to substance, the application shall be deemed to have been withdrawn.

The patent administration department under the State Council may, on its own initiative, proceed to examine any application for a patent for invention as to its substance when it deems it necessary.

**Article 36.** When the applicant for a patent for invention requests examination as to substance, he or it shall furnish pre-filing date reference materials concerning the invention.

For an application for a patent for invention that has been already filed in a foreign country, the patent administration department under the State Council may ask the applicant

to furnish within a specified time limit documents concerning any search made for the purpose of examining that application, or concerning the results of any examination made, in that country. If, at the expiration of the specified time limit, without any justified reason, the said documents are not furnished, the application shall be deemed to have been withdrawn.

**Article 37.** Where the patent administration department under the State Council, after it has made the examination as to substance of the application for a patent for invention, finds that the application is not in conformity with the provisions of this Law, it shall notify the applicant and request him or it to submit, within a specified time limit, his or its observations or to amend the application. If, without any justified reason, the time limit for making response is not met, the application shall be deemed to have been withdrawn.

**Article 38.** Where, after the applicant has made the observations or amendments, the patent administration department under the State Council finds that the application for a patent for invention is still not in conformity with the provisions of this Law, the application shall be rejected.

**Article 39.** Where it is found after examination as to substance that there is no cause for rejection of the application for a patent for invention, the patent administration department under the State Council shall make a decision to grant the patent right for invention, issue the certificate of patent for invention, and register and announce it. The patent right for invention shall take effect as of the date of the announcement.

**Article 40.** Where it is found after preliminary examination that there is no cause for rejection of the application for a patent for utility model or design, the patent administration department under the State Council shall make a decision to grant the patent right for utility model or the patent right for design, issue the relevant patent certificate, and register and announce it. The patent right for utility model or design shall take effect as of the date of the announcement.

**Article 41.** The patent administration department under the State Council shall set up a Patent Reexamination Board. Where an applicant for patent is not satisfied with the decision of the said department rejecting the application, the applicant may, within three months from the date of receipt of the notification, request the Patent Reexamination Board to make a reexamination. The Patent Reexamination Board shall, after reexamination, make a decision and notify the applicant for patent.

Where the applicant for patent is not satisfied with the decision of the Patent Reexamination Board, it or he may, within three months from the date of receipt of the notification, institute legal proceedings in the people's court.

# Chapter V
# Duration, Cessation and Invalidation of Patent Right

**Article 42.** The duration of patent right for inventions shall be twenty years, the duration of patent right for utility models and patent right for designs shall be ten years, counted from the date of filing.

**Article 43.** The patentee shall pay an annual fee beginning with the year in which the patent right was granted.

**Article 44.** In any of the following cases, the patent right shall cease before the expiration of its duration:

(1) where an annual fee is not paid as prescribed;

(2) where the patentee abandons his or its patent right by a written declaration.

Any cessation of the patent right shall be registered and announced by the Patent administration department under the State Council.

**Article 45.** Where, starting from the date of the announcement of the grant of the patent right by the patent administration department under the State Council, any entity or individual considers that the grant of the said patent right is not in conformity with the relevant provisions of this Law, it or he may request the Patent Reexamination Board to declare the patent right invalid.

**Article 46.** The Patent Reexamination Board shall examine the request for invalidation of the patent right promptly, make a decision on it and notify the person who made the request and the patentee. The decision declaring the patent right invalid shall be registered and announced by the patent administration department under the State Council.

Where the patentee or the person who made the request for invalidation is not satisfied with the decision of the Patent Reexamination Board declaring the patent right invalid or upholding the patent right, such party may, within three months from receipt of the notification of the decision, institute legal proceedings in the people's court. The people's court shall notify the person that is the opponent party of that party in the invalidation procedure to appear as a third party in the legal proceedings.

**Article 47.** Any patent right which has been declared invalid shall be deemed to be non-existent from the beginning.

The decision declaring the patent right invalid shall have no retroactive effect on any judgment or mediation decision of patent infringement which has been pronounced and enforced by the people's court, on any decision concerning the handling of a dispute over patent infringement which has been complied with or compulsorily executed, or on any contract of patent license or of assignment of patent right which has been performed prior to the declaration of the patent right invalid; however, the damage caused to other persons in bad faith on the part of the patentee shall be compensated.

If, pursuant to the provisions of the preceding paragraph, the monetary damage for patent infringement, the fees for exploitation of the patent or fees for the assignment of the patent right is not returned, but such non-return is obviously contrary to the principle of equity, all or part of the preceding payments shall be returned.

## Chapter VI
## Compulsory License for Exploitation of Patent

**Article 48.** Under any of the following circumstances, the patent administration department under the State Council may, upon the request of an entity or individual which is qualified to exploit the invention or utility model, grant a compulsory license to exploit the patent for invention or utility model:

(1) where the patentee, after the expiration of three years from the date of the grant of the patent and the expiration of four years from the date of filing, does not exploit or does not sufficiently exploit the patent without any justified reason;

(2) where the exercising of the patent right by the patentee is legally determined as an act of monopoly, for the purposes of eliminating or reducing the adverse effects of the act on competition.

**Article 49.** Where a national emergency or any extraordinary state of affairs occurs, or where the public interest so requires, the patent administration department under the State Council may grant a compulsory license to exploit the patent for invention or utility model.

**Article 50.** For the purposes of public health, the patent administration department under the State Council may grant a compulsory license to manufacture a pharmaceutical product which has been granted patent right and export it to countries or regions specified in the relevant international treaties to which China is party.

**Article 51.** Where the invention or utility model for which the patent right has been granted involves important technical advance of considerable economic significance in rela-

tion to another invention or utility model for which a patent right has been granted earlier and the exploitation of the later invention or utility model depends on the exploitation of the earlier invention or utility model, the patent administration department under the State Council may, upon the request of the later patentee, grant a compulsory license to exploit the earlier invention or utility model.

Where, according to the preceding paragraph, a compulsory license is granted, the patent administration department under the State Council may, upon the request of the earlier patentee, also grant a compulsory license to exploit the later invention or utility model.

**Article 52.** Where the invention-creation involved in the compulsory license relates to the semi-conductor technology, the exploitation thereof shall be limited only for the purpose of public interest or under the condition as provided in Article 48 (2) of this Law.

**Article 53.** Except for compulsory licenses granted in accordance with Article 48 (2) or Article 50 of this Law, the exploitation of any compulsory license shall be executed predominately for the supply of the domestic market.

**Article 54.** Any entity or individual requesting, in accordance with the provisions of Article 48(1) or Article 51 of this Law, a compulsory license for exploitation shall furnish proof to show that it or he has made requests for authorization from the patentee to exploit its or his patent on reasonable terms and conditions, and such efforts have not been successful within a reasonable period of time.

**Article 55.** The decision made by the patent administration department under the State Council granting a compulsory license for exploitation shall be notified promptly to the patentee concerned, and shall be registered and announced.

In the decision granting the compulsory license for exploitation, the scope and duration of the exploitation shall be specified on the basis of the reasons justifying the grant. If and when the circumstances which led to such compulsory license cease to exist and are unlikely to recur, the patent administration department under the State Council may, after review upon the request of the patentee, terminate the compulsory license.

**Article 56.** Any entity or individual that is granted a compulsory license for exploitation shall not have an exclusive right to exploit and shall not have the right to authorize exploitation by any others.

**Article 57.** The entity or individual that is granted a compulsory license for exploitation shall pay to the patentee a reasonable exploitation fee, or deal with the issue of exploitation fee according to relevant provisions of the international treaties to which China is

party. Where the exploitation fee is paid, the amount shall be negotiated by both parties. Where the parties fail to reach an agreement, the patent administration department under the State Council shall adjudicate.

**Article 58.** Where the patentee is not satisfied with the decision of the patent administration department under the State Council granting a compulsory license for exploitation, or where the patentee or the entity or individual that is granted the compulsory license for exploitation is not satisfied with the ruling made by the patent administration department under the State Council regarding the fee payable for exploitation, it or he may, within three months from the date of receipt of the notification, institute legal proceedings in the people's court.

## Chapter VII
## Protection of Patent Right

**Article 59.** The extent of protection of the patent right for invention or utility model shall be determined by the terms of the claims. The description and the appended drawings may be used to interpret the content of the claims.

The extent of protection of the patent right for design shall be determined by the design of the product as shown in the drawings or photographs. The brief explanation may be used to interpret the design of the product as shown in the drawings or photographs.

**Article 60.** Where a dispute arises as a result of the exploitation of a patent without the authorization of the patentee, that is, the infringement of the patent right of the patentee, it shall be settled through consultation by the parties. Where the parties are not willing to consult with each other or where the consultation fails, the patentee or any interested party may institute legal proceedings in the people's court, or request the administrative authority for patent affairs to handle the matter. When the administrative authority for patent affairs handling the matter considers that the infringement is established, it may order the infringer to stop the infringing act immediately. If the infringer is not satisfied with the order, he may, within 15 days from the date of receipt of the notification of the order, institutes legal proceedings in the people's court in accordance with the Administrative Procedure Law of the People's Republic of China. If, within the said time limit, such proceedings are not instituted and the order is not complied with, the administrative authority for patent affairs may approach the people's court for compulsory execution. The said authority handling the matter may, upon the request of the parties, mediate in the amount of compensation for the damage caused by the infringement of the patent right. If the mediation fails, the parties

may institute legal proceedings in the people's court in accordance with the Civil Procedure Law of the People's Republic of China.

**Article 61.** Where any infringement dispute relates to a patent for invention for a process for the manufacture of a new product, any entity or individual manufacturing the identical product shall furnish proof to show that the process used in the manufacture of its or his product is different from the patented process.

Where any infringement dispute relates to a patent for utility model or design, the people's court or the administrative authority for patent affairs may ask the patentee or any interested party to furnish an evaluation report of patent made by the patent administration department under the State Council after having conducted search, analysis and evaluation of the relevant utility model or design, and use it as evidence for hearing or handling the patent infringement dispute.

**Article 62.** In a patent infringement dispute, where the alleged infringer has evidence to prove that the technology or design exploited by it or him forms part of prior art or is prior design, such exploitation does not constitute infringement of patent right.

**Article 63.** Where any person passes off a patent, he shall, in addition to bearing his civil liability according to law, be ordered by the administrative authority for patent affairs to correct his act, and the order shall be announced. His illegal earnings shall be confiscated and, in addition, he may be imposed a fine of not more than four times his illegal earnings and, if there is no illegal earnings, a fine of not more than RMB 200, 000 Yuan. Where the infringement constitutes a crime, he shall be prosecuted for his criminal liability.

**Article 64.** When investigating and prosecuting the suspected act of passing off a patent, the administrative authority for patent affairs may, based on the evidence obtained, query the parties concerned, and investigate the relevant circumstances of the suspected illegal act; carry out an on-the-spot inspection of the site where the party' s suspected illegal acts took place; review and reproduce the contracts, invoices, account books and other relevant materials related to the suspected illegal act; examine the products relevant to the suspected illegal act and may seal up or withhold the products proved to be passing off the patented product.

When the administrative authority for patent affairs performs its functions and duties specified in the preceding paragraph in accordance with the law, the interested party shall assist and cooperate and shall not refuse or interfere the performance.

**Article 65.** The amount of compensation for the damage caused by the infringement of the patent right shall be assessed on the basis of the actual losses suffered by the right

holder because of the infringement; where it is difficult to determine the actual losses, the amount may be assessed on the basis of the profits the infringer has earned because of the infringement. Where it is difficult to determine the losses the right holder has suffered or the profits the infringer has earned, the amount may be assessed by reference to the appropriate multiple of the amount of the exploitation fee of that patent under a contractual license. The amount of compensation for the damage shall also include the reasonable expenses of the right holder incurred for stopping the infringing act.

Where it is difficult to determine the losses suffered by the right holder, the profits the infringer has earned and the exploitation fee of that patent under a contractual license, the people's court may award the damages of not less than RMB 10,000 Yuan and not more than RMB 1,000,000 Yuan in light of such factors, as the type of the patent right, the nature and the circumstances of the infringing act.

**Article 66.** Where any patentee or interested party has evidence to prove that another person is infringing or will soon infringe its or his patent right and that if such infringing act is not checked or prevented from occurring in time, it is likely to cause irreparable harm to it or him, it or he may, before any legal proceedings are instituted, petition the people's court to adopt measures to stop the relevant acts.

When a petition is filed, the petitioner shall provide a security; if it or he fails to provide the security, the application shall be rejected.

The people's court shall make a ruling within 48 hours after receiving the petition. Where there are special circumstances that require a delayed ruling, the court may make a ruling within another 48 hours. If the ruling is made to stop the relevant act, the ruling shall be enforced immediately. If any interested party is not satisfied with the ruling, it or he may apply for reconsideration once; the enforcement of the ruling shall not be suspended during the reconsideration.

Where the petitioner fails to institute legal proceedings within 15 days after the people's court issued the ruling to stop the relevant act, the people's court shall lift the measures.

Where the petition is made in error, the petitioner shall compensate the respondent for the losses caused by stopping the relevant acts.

**Article 67.** In order to stop patent infringement, under the circumstances where the evidence might be destroyed or where it would be difficult to obtain in the future, the patentee or the interested party may petition the people's court for evidence preservation before instituting legal proceedings.

When adopting preservation measures, the people's court may order the petitioner to provide a security for the petition; if the petitioner fails to do so, the petition shall be rejected.

The people's court shall make a ruling within 48 hours after receiving the petition; if the court rules to adopt preservation measures, the ruling shall be enforced immediately.

Where the petitioner fails to institute legal proceedings within 15 days after the people's court adopted the preservation measures, the people's court shall lift the measures.

**Article 68.** Prescription for instituting legal proceedings concerning the infringement of patent right is two years counted from the date on which the patentee or any interested party obtains or should have obtained knowledge of the infringing act.

Where no appropriate fee for exploitation of the invention, subject of an application for patent for invention, is paid during the period from the publication of the application to the grant of patent right, prescription for instituting legal proceedings by the patentee to demand the said fee is two years counted from the date on which the patentee obtains or should have obtained knowledge of the exploitation of his invention by another person. However, where the patentee has already obtained or should have obtained knowledge before the date of the grant of the patent right, the prescription shall be counted from the date of the grant.

**Article 69.** None of the following shall be deemed as infringement of the patent right:

(1) where, after the sale of a patented product or a product obtained directly by a patented process by the patentee or any entity or individual authorized by the patentee, any other person uses, offers to sell, sell, or imports that product;

(2) where, before the date of filing of the application for patent, any person who has already made the identical product, used the identical process, or made necessary preparations for its making or using, continues to make or use it within the original scope only;

(3) where any foreign means of transport which temporarily passes through the territory, territorial waters or territorial airspace of China uses the patent concerned, in accordance with any agreement concluded between the country to which the foreign means of transport belongs and China, or in accordance with any international treaty to which both countries are party, or on the basis of the principle of reciprocity, for its own needs, in its devices and installations;

(4) where any person uses the patent concerned solely for the purposes of scientific research and experimentation; or

(5) where for the purposes of providing information needed for the regulatory examination and approval, any person makes, uses or imports a patented medicine or a patented medical apparatus, and where any person makes, imports the patented medicine or the patented medical apparatus exclusively for such person.

**Article 70.** Any person, who, for production and business purpose, uses, offers to sell or sells a patent infringement product, without knowing that it was made and sold without

the authorization of the patentee, shall not be liable to compensate for the damage of the patentee if he can prove that he obtains the product from a legitimate channel.

**Article 71.** Where any person, in violation of the provisions of Article 20 of this Law, files in a foreign country an application for a patent that divulges an important secret of the State, he shall be subject to disciplinary sanction by the entity to which he belongs or by the competent authority concerned at the higher level. Where a crime is established, the person concerned shall be prosecuted for his criminal liability according to the law.

**Article 72.** Where any person usurps the right of an inventor or creator to apply for a patent for a non-service invention-creation, or usurps any other right or interest of an inventor or creator, prescribed by this Law, he shall be subject to disciplinary sanction by the entity to which he belongs or by the competent authority at the higher level.

**Article 73.** The administrative authority for patent affairs may not take part in recommending any patented product for sale to the public or any such commercial activities.

Where the administrative authority for patent affairs violates the provisions of the preceding paragraph, it shall be ordered by the authority at the next higher level or the supervisory authority to correct its mistakes and eliminate the bad effects. The illegal earnings, if any, shall be confiscated. Where the circumstances are serious, the persons who are directly in charge and other persons who are directly responsible shall be given disciplinary sanction in accordance with law.

**Article 74.** Where any State functionary working for patent administration or any other State functionary concerned neglects his duty, abuses his power, or engages in malpractice for personal gain, which constitutes a crime, shall be prosecuted for his criminal liability in accordance with law. If the case is not serious enough to constitute a crime, he shall be given disciplinary sanction in accordance with law.

## Chapter VIII
## Supplementary Provisions

**Article 75.** Any application for a patent filed with, and any other proceedings before, the patent administrative department under the State Council shall be subject to the payment of a fee as prescribed.

**Article 76.** This Law shall enter into force on April 1, 1985.

# Transitional Measures on Implementing the Amended Patent Law

(Promulgated by Order No. 53 of the State Intellectual Property Office on September 27, 2009)

**Rule 1.** These Rules are formulated, in accordance with Article 84 of the Legislation Law, to ensure the implementation of the Decision of the Standing Committee of the Eleventh National People's Congress on Amending the Patent Law of the People's Republic of China promulgated on December 27, 2008.

**Rule 2.** The provisions of the Patent Law before its amendment apply to patent applications of which the filing date is before October 1, 2009 (this day is not included, hereinafter the same), and the patent rights granted on the basis of the said applications; the provisions of the amended Patent Law apply to patent applications of which the filing date is after October 1, 2009 (this day is included, hereinafter the same), and the patent rights granted on the basis of the said applications, subject to the following special provisions of these Rules which also apply to applications of which the filing date is before October 1, 2009 and the patent rights granted on the basis of the said applications.

The filing date as referred to in the preceding paragraph shall be understood according to the relevant provisions of the Implementing Regulations of the Patent Law.

**Rule 3.** For any request for compulsory license for exploitation of patent filed after October 1, 2009, provisions of Chapter Ⅵ of the amended Patent Law shall apply.

**Rule 4.** For any alleged infringement of patent right occurring after October 1, 2009, handled by the administrative authority for patent affairs, provisions of Article 11, Article 62, Article 69 and Article 70 of the amended Patent Law shall apply.

**Rule 5.** For any investigation and prosecution carried out by the administrative authority for patent affairs on alleged acts of passing off a patent occurring after October 1, 2009, provisions of Article 63 and Article 64 of the amended Patent Law shall apply.

**Rule 6.** For any affixation of patent indication carried out by the patentee after October 1, 2009, provision of Article 17 of the amended Patent Law shall apply.

**Rule 7.** Where any foreigner, foreign enterprise or other foreign organization having no habitual residence or business office in China appoints or changes a patent agency after October 1, 2009, provision of Article 19 of the amended Patent Law shall apply.

**Rule 8.** These Rules shall enter into force as of October 1, 2009.

# IMPLEMENTING REGULATIONS OF THE PATENT LAW OF THE PEOPLE'S REPUBLIC OF CHINA[1]

(Promulgated by Decree No. 306 of the State Council of the People's Republic of China on June 15, 2001, amended the first time on December 28, 2002 according to the Decision of the State Council on Amending the Implementing Regulations of the Patent Law of the People's Republic of China, and amended the second time on January 9, 2010 according to the Decision of the State Council on Amending the Implementing Regulations of the Patent Law of the People's Republic of China)

[1] Translated by the State Intellectual Property office of the People's Republic of China. In case of discrepancy, the original version in Chinese shall prevail.

# Chapter I
# General Provisions

**Rule 1.** These Implementing Regulations are formulated in accordance with the Patent Law of the People's Republic of China (hereinafter referred to as the Patent Law).

**Rule 2.** Any formalities prescribed by the Patent Law and these Implementing Regulations shall be complied with in a written form or in any other form prescribed by the patent administration department under the State Council.

**Rule 3.** Any document submitted in accordance with the provisions of the Patent Law and these Implementing Regulations shall be in Chinese; the standard scientific and technical terms shall be used if there is a prescribed one set forth by the State; where no generally accepted translation in Chinese can be found for a foreign name or scientific or technical term, the one in the original language shall be also indicated.

Where any certificate or certifying document submitted in accordance with the provisions of the Patent Law and these Implementing Regulations is in a foreign language, the patent administration department under the State Council may, when it deems necessary, request a Chinese translation of the certificate or the certifying document be submitted within a specified time limit; where the translation is not submitted within the specified time limit, the certificate or certifying document shall be deemed not to have been submitted.

**Rule 4.** Where any document is sent by mail to the patent administration department under the State Council, the date of mailing indicated by the postmark on the envelope shall be deemed to be the date of filing; where the date of mailing indicated by the postmark on the envelope is illegible, the date on which the patent administration department under the State Council receives the document shall be the date of filing, except where the date of mailing is proved by the party concerned.

Any document of the patent administration department under the State Council may be served by mail, by personal delivery or by other forms. Where any party concerned appoints a patent agency, the document shall be sent to the patent agency; where no patent agency is appointed, the document shall be sent to the contacting person named in the request.

Where any document is sent by mail by the patent administration department under the State Council, the 16th day from the date of mailing shall be presumed to be the date on which the party concerned receives the document.

Where any document is delivered personally in accordance with the provisions of the

patent administration department under the State Council, the date of delivery is the date on which the party concerned receives the document.

Where the address of any document is not clear and it cannot be sent by mail, the document may be served by making an announcement. At the expiration of one month from the date of the announcement, the document shall be deemed to have been served.

**Rule 5.** The first day of any time limit prescribed in the Patent Law and these Implementing Regulations shall not be counted in the time limit. Where the time limit is counted by year or by month, it shall expire on the corresponding day of the last month; if there is no corresponding day in that month, the time limit shall expire on the last day of that month; if a time limit expires on an official holiday, it shall expire on the first working day following that official holiday.

**Rule 6.** Where a time limit prescribed in the Patent Law or these Implementing Regulations or specified by the patent administration department under the State Council is not observed by a party concerned because of *force majeure*, resulting in loss of his or its rights, he or it may, within two months from the date on which the impediment is removed, at the latest within two years immediately following the expiration of that time limit request the patent administration department under the State Council to restore his or its rights.

Except for circumstances prescribed in preceding paragraph, where a time limit prescribed in the Patent Law or these Implementing Regulations or specified by the patent administration department under the State Council is not observed by a party concerned because of any other justified reason, resulting in loss of his or its rights, he or it may, within two months from the date of receipt of a notification from the patent administration department under the State Council, request the patent administration department under the State Council to restore his or its rights.

Where any party concerned requests to restore his or its right according to paragraph one or paragraph two of this Rule, he or it shall submit a request for restoration of his or its right, stating the reasons, attaching, if necessary, the relevant certifying documents, and go through the relevant formalities which should have been complied with before the loss of his or its right. Where the party concerned requests for restoration of his or its right according to paragraph two of this Rule, he or it shall pay the fee for request for restoration of right.

Where the party concerned makes a request for an extension of a time limit specified by the patent administration department under the State Council, he or it shall, before the time limit expires, state the reasons to the patent administration department under the State Council and go through the relevant formalities.

The provisions of paragraphs one and two of this Rule shall not be applicable to the time limit referred to in Articles 24, 29, 42 and 68 of the Patent Law.

**Rule 7.** Where an application for a patent relates to the interests of national defense and is required to be kept secret, the application for patent shall be filed with and examined by the patent department of national defense. Where an application for patent received by the patent administration department under the State Council relates to the interests of national defense and is required to be kept secret, the application shall be promptly forwarded to the patent department of national defence to carry out the examination. Where it is found after examination by the patent department of national defence there is no cause for rejection of the application, the patent administration department under the State Council shall make a decision to grant the patent right concerning national defense.

Where the patent administration department under the State Council finds that an application for patent for invention or patent for utility model filed with it relates to national security or other vital interests other than interests concerning national defense and is required to be kept secret, it shall promptly make a decision on handling it as an application for secret patent and notify the applicant accordingly. The special procedures for the examination and reexamination of application for secret patent as well as the invalidation of secret patent shall be provided for by the patent administration department under the State Council.

**Rule 8.** The invention or utility model developed in China as mentioned in Article 20 of the Patent Law refers to an invention or utility model of which the substantive contents of the technical solution were made within the territory of China.

Where any entity or individual intends to file an application for patent abroad for the invention or utility model developed in China, it or he shall request, by one of the following manner, the patent administration department under the State Council to conduct confidentiality examination:

(1) where any entity or individual intends to file an application for patent directly in a foreign country or an international patent application with a relevant foreign organization, it or he shall file a request for confidentiality examination in advance with the patent administration department under the State Council and describe the related technical solution in detail;

(2) where after having filed an application for patent with the patent administration department under the State Council, the applicant intends to file an application for patent in a foreign country or an international patent application with a relevant foreign organization, it or he shall file the request for confidentiality examination with the patent administration department under the State Council before filing of the application for patent in a foreign country or the international patent application with the relevant foreign organization.

Where the applicant files an international patent application with the patent administration department under the State Council, it or he shall be deemed to have simultaneously filed the request for confidentiality examination.

**Rule 9.** Where the patent administration department under the State Council receives a request filed under Rule 8 of these Implementing Regulations and finds, upon examination, that the invention or utility model may relate to the security or vital interest of the State and is required to be kept secret, it shall promptly issue a notification of confidentiality examination to the applicant. If the applicant fails to receive the notification of confidentiality examination within four months from the date of filing its or his request, it or he may file, in respect of the invention or utility model, an application for patent in a foreign country or an international patent application with the relevant foreign organization.

Where the patent administration department under the State Council carries out a confidentiality examination in accordance with the notification prescribed in the preceding paragraph, it shall promptly make a decision on whether the invention or utility mode is required to be kept secret and notify the applicant accordingly. If the applicant fails to receive such a decision within six months from the date of filing its or his request, it or he may file, in respect of the invention or utility model, an application for patent in a foreign country or an international patent application with the relevant foreign organization.

**Rule 10.** Any invention-creation that is contrary to the laws referred to in Article 5 of the Patent Law shall not include the invention-creation merely because the exploitation of which is prohibited by the laws.

**Rule 11.** The date of filing referred to in the Patent Law, except for those referred to in Articles 28 and 42, means the priority date where priority is claimed.

The date of filing referred to in these Implementing Regulations, except as otherwise prescribed, means the date of filing prescribed in Article 28 of the Patent Law.

**Rule 12.** "A service invention-creation made by a person in execution of the tasks of the entity to which he belongs" referred to in Article 6 of the Patent Law means any invention-creation made:

(1) in the course of performing his own duty;

(2) in execution of any task, other than his own duty, which was entrusted to him by the entity to which he belongs;

(3) within one year from his retirement, resignation or from termination of his employment or personnel relationship with the entity to which he previously belonged, where the invention-creation relates to his own duty or the other task entrusted to him by the entity to which he previously belonged.

"The entity to which he belongs" referred to in Article 6 of the Patent Law includes the entity in which the person concerned is a temporary staff member. "Material and technical means of the entity" referred to in Article 6 of the Patent Law mean the entity's money,

equipment, spare parts, raw materials or technical materials which are not disclosed to the public, etc.

**Rule 13.** "Inventor" or "creator" referred to in the Patent Law means any person who makes creative contributions to the substantive features of an invention-creation. Any person who, during the course of accomplishing the invention-creation, is responsible only for organizational work, or who only offers facilities for making use of material and technical means, or who only takes part in other auxiliary functions, shall not be considered as inventor or creator.

**Rule 14.** Except for the assignment of the patent right in accordance with Article 10 of the Patent Law, where the patent right is transferred because of any other reason, the person or persons concerned shall, accompanied by relevant certified documents or legal papers, request the patent administration department under the State Council to register the change in the owner of the patent right.

Any license contract for exploitation of a patent which has been concluded by the patentee with an entity or individual shall, within three months from the date of entry into force of the contract, be submitted to the patent administration department under the State Council for the record.

Where any patent right is pledged, both the pledger and the pledgee shall jointly register the contract of pledge with the patent administration department under the State Council.

## Chapter II
## Application for Patent

**Rule 15.** Anyone who applies for a patent in written form shall file with the patent administration department under the State Council application documents in two copies.

Anyone who applies for a patent in other forms as provided by the patent administration department under the State Council shall comply with the relevant provisions.

Any applicant who appoints a patent agency for applying for a patent, or for having other patent matters to attend to before the patent administration department under the State Council, shall submit at the same time a power of attorney indicating the scope of the power entrusted.

Where there are two or more applicants and no patent agency is appointed, unless otherwise stated in the request, the applicant named first in the request shall be the representative.

**Rule 16.** The request of application for patent for invention, utility model or design, shall state the following:

(1) the title of the invention, utility model or design;

(2) where the applicant is a Chinese entity or individual, its or his title or name, address, postal code, the code of the organization or the citizen identification card number; where the applicant is a foreigner, a foreign enterprise or other foreign organization, his or its name or title, the nationality or the country or region in which the applicant is registered;

(3) the name of the inventor or creator;

(4) where the applicant has appointed a patent agency, the name of the appointed agency, the agency's organizational code and the name, the professional certificate number and the telephone number of the patent agent assigned by the agency;

(5) where the right of priority is claimed, the filing date on which the applicant filed the application the first time (hereinafter referred to as the earlier application), the filing number of the application and the title of the authority with which the application was first filed;

(6) the signature or seal of the applicant or the patent agency;

(7) a list of the documents constituting the application;

(8) a list of the documents appending the application; and

(9) any other related matters which needs to be indicated.

**Rule 17.** The description of an application for a patent for invention or a patent for utility model shall state the title of the invention or utility model, which shall be the same as it appears in the request. The description shall include the following:

(1) technical field: specifying the technical field to which the technical solution for which protection is sought pertains;

(2) background art: indicating the background art which can be regarded as useful for the understanding, searching and examination of the invention or utility model, and when possible, citing the documents reflecting such art;

(3) contents of the invention: disclosing the technical problem the invention or utility model aims to settle and the technical solution adopted to resolve the problem; and stating, with reference to the prior art, the advantageous effects of the invention or utility model;

(4) description of figures: briefly describing each figure in the drawings, if any;

(5) mode of carrying out the invention or utility model: describing in detail the optimally selected mode contemplated by the applicant for carrying out the invention or utility model; where appropriate, this shall be done in terms of examples, and with reference to the drawings, if any;

The manner and order referred to in the preceding paragraph shall be followed by the applicant for a patent for invention or a patent for utility model, and each of the parts shall

be preceded by a heading, unless, because of the nature of the invention or utility model, a different manner or order would result in a better understanding and a more economical presentation.

The description of the invention or utility model shall use standard terms and be in clear wording, and shall not contain such references to the claims as: "as described in claim …", nor shall it contain commercial advertising.

Where an application for a patent for invention contains disclosure of one or more nucleotide and/or amino acid sequences, the description shall contain a sequence listing in compliance with the standard prescribed by the patent administration department under the State Council. The sequence listing shall be submitted as a separate part of the description, and a copy of the said sequence listing in machine-readable form shall also be submitted in accordance with the provisions of the patent administration department under the State Council.

The description of an application for patent for utility model shall include the drawings showing the shape, structure or their combination of the product for which protection is sought.

**Rule 18.** The figures of drawings of the invention or utility model shall be numbered and arranged in numerical order consecutively as "Figure 1, Figure 2, …".

Reference signs not mentioned in the text of the description of the invention or utility model shall not appear in the drawings. Reference signs not mentioned in the drawings shall not appear in the text of the description. Reference signs for the same composite part shall be used consistently throughout the application document.

The drawings shall not contain any other explanatory notes, except words which are indispensable.

**Rule 19.** The claims shall specify the technical features of the invention or utility model.

If there are several claims, they shall be numbered consecutively in Arabic numerals.

The scientific and technical terms used in the claims shall be consistent with that used in the description. The claims may contain chemical or mathematical formulae but no drawings. They shall not, except where absolutely necessary, contain such references to the description or drawings as: "as described in part… of the description", or "as illustrated in Figure… of the drawings".

The technical features mentioned in the claims may, in order to facilitate quicker understanding of the claim, make reference to the corresponding reference signs in the drawings. Such reference signs shall follow the corresponding technical features and be placed in parentheses. The reference signs shall not be construed as limiting the claims.

**Rule 20.** The claims shall have an independent claim, and may also contain dependent claims.

The independent claim shall outline the technical solution of an invention or utility model and state the essential technical features necessary for the solution of its technical problem.

The dependent claim shall, by additional technical features, further define the claim which it refers to.

**Rule 21.** An independent claim of an invention or utility model shall contain a preamble portion and a characterizing portion, and be presented in the following form:

(1) a preamble portion: indicating the title of the claimed subject matter of the technical solution of the invention or utility model, and those technical features which are necessary for the definition of the claimed subject matter but which, in combination, are part of the most related prior art;

(2) a characterizing portion: stating, in such words as "characterized in that... "or in similar expressions, the technical features of the invention or utility model, which distinguish it from the most related prior art. Those features, in combination with the features stated in the preamble portion, serve to define the extent of protection of the invention or utility model.

Where the manner specified in the preceding paragraphs is not appropriate to be followed because of the nature of the invention or utility model, an independent claim may be presented in a different manner.

An invention or utility model shall have only one independent claim, which shall precede all the dependent claims relating to the same invention or utility model.

**Rule 22.** Any dependent claim of an invention or utility model shall contain a reference portion and a characterizing portion, and be presented in the following manner:

(1) a reference portion: indicating the serial number(s) of the claim(s) referred to, and the title of the subject matter;

(2) a characterizing portion: stating the additional technical features of the invention or utility model.

Any dependent claim shall only refer to the preceding claim or claims. Any multiple dependent claims, which refers to two or more claims, shall refer to the preceding claims in the alternative only, and shall not serve as a basis for any other multiple dependent claims.

**Rule 23.** The abstract shall consist of a summary of the disclosure as contained in the application for patent for invention or utility model. The summary shall indicate the title of the invention or utility model, and the technical field to which the invention or utility model pertains, and shall be drafted in a way which allows the clear understanding of the technical

problem, the gist of the technical solution to that problem, and the principal use or uses of the invention or utility model.

The abstract may contain the chemical formula which best characterizes the invention. In an application for a patent which contains drawings, the applicant shall provide a figure which best characterizes the technical features of the invention or utility model. The scale and the distinctness of the figure shall be as such that a reproduction with a linear reduction in size to 4cm × 6cm would still enable all details to be clearly distinguished. The whole text of the abstract shall contain not more than 300 words. There shall be no commercial advertising in the abstract.

**Rule 24.** Where an invention for which a patent is applied for concerns a new biological material which is not available to the public and which cannot be described in the application in such a manner as to enable the invention to be carried out by a person skilled in the art, the applicant shall, in addition to the other requirements provided for in the Patent Law and these Implementing Regulations, go through the following formalities:

(1) depositing a sample of the biological material with a depositary institution designated by the patent administration department under the State Council before, or at the latest, on the date of filing (or the priority date where priority is claimed), and submit at the time of filing or at the latest, within four months from the date of filing, a receipt of deposit and the viability proof from the depository institution; where they are not submitted within the specified time limit, the sample of the biological material shall be deemed not to have been deposited;

(2) giving in the application document relevant information of the characteristics of the biological material;

(3) indicating, where the application relates to the deposit of a sample of the biological material, in the request and the description the scientific name (with its Latin name) and the title and address of the depositary institution, the date on which the sample of the biological material was deposited and the accession number of the deposit; where, at the time of filing, they are not indicated, they shall be supplied within four months from the date of filing; where after the expiration of the time limit they are not supplied, the sample of the biological material shall be deemed not to have been deposited.

**Rule 25.** Where the applicant for a patent for invention has deposited a sample of the biological material in accordance with the provisions of Rule 24 of these Implementing Regulations, and after the application for patent for invention is published, any entity or individual that intends to make use of the biological material to which the application relates, for the purpose of experiment, shall make a request to the patent administration department under the State Council, containing the following items:

(1) the title or name and address of the requesting person;

(2) an undertaking not to make the biological material available to any other person;

(3) an undertaking to use the biological material for experimental purpose only before the grant of the patent right.

**Rule 26.** The genetic resources refered to in the Patent Law mean the material obtained from such as human body, animal, plant, or microorganism which contains functional units of heredity and is of actual or potential value. The invention-creation is developed relying on the genetic resources refered to in the Patent Law means that the invention-creation is developed relying on the use of the heredity function of the genetic resources.

Where an application for patent is filed for an invention-creation the development of which relies on the use of genetic resources, the applicant shall state that fact in the request, and fill in the forms provided by the patent administration department under the State Council.

**Rule 27.** Where an application for a patent for design seeking concurrent protection of colors is filed, drawings or photographs in color shall be submitted.

The applicant shall, in respect of the subject matter of the product incorporating the design which is in need of protection, submit the relevant drawings or photographs.

**Rule 28.** The brief explanation of application for patent for design shall indicate the title and the use of the product incorporating the design, the essential feature of the design, and designate a drawing or photograph capable of best showing the essential feature of the design. Where a view of the product incorporating the design is omitted or where concurrent protection for color is claimed, it shall be indicated in the brief explanation.

Where an application for patent for design is filed for two or more similar designs incorporated in the same product, one of these designs shall be indicated as the main design in the brief explanation.

The brief explanation shall not contain any commercial advertising and shall not be used to indicate the function of the product.

**Rule 29.** Where the patent administration department under the State Council deems necessary, it may require the applicant for a patent for design to submit a sample or model of the product incorporating the design. The volume of the sample or model submitted shall not exceed 30cm × 30cm × 30cm, and its weight shall not surpass 15 kilograms. Articles that are easy to get rotten or broken or articles that are dangerous shall not be submitted as sample or model.

**Rule 30.** The international exhibition recognized by the Chinese Government refered to in Article 24, subparagraph (1) of the Patent Law means the international exhibition that

is registered with or recognized by the International Exhibitions Bureau as stipulated by the International Exhibitions Convention.

The academic or technological meeting referred to in Article 24, subparagraph (2) of the Patent Law means any academic or technological meeting organized by a competent department concerned of the State Council or by a national academic or technological association.

Where any invention-creation for which a patent is applied falls under the provisions of Article 24, subparagraph (1) or (2) of the Patent Law, the applicant shall, when filing the application, make a declaration and, within a time limit of two months from the date of filing, submit certifying documents issued by the entity which organized the international exhibition or academic or technological meeting, stating the fact that the invention-creation was exhibited or published and with the date of its exhibition or publication.

Where any invention-creation for which a patent is applied falls under the provisions of Article 24, subparagraph (3) of the Patent Law, the patent administration department under the State Council may, when it deems necessary, require the applicant to submit the relevant certifying documents within the specified time limit.

Where the applicant fails to make a declaration and submit certifying documents as required in paragraph three of this Rule, or fails to submit certifying documents within the specified time limit as required in paragraph four of this Rule, the provisions of Article 24 of the Patent Law shall not apply to the application.

**Rule 31.** Where an applicant claims the right of foreign priority in accordance with the provisions of Article 30 of the Patent Law, the copy of the earlier application documents submitted by the applicant shall be certified by the authority with which the earlier application was filed. Where, in accordance with the agreement between the patent administration department under the State Council and the said authority, the patent administration department under the State Council obtains a copy of the earlier application documents through electronic transmission or in any other manner, the copy of the earlier application documents certified by the authority shall be deemed to have been submitted by the applicant. Where the right of domestic priority is claimed, if the date of filing and the filing number of the earlier application are indicated in the request by the applicant, the copy of the earlier application documents shall be deemed to have been submitted.

Where such one or two items as the date of filing, the filing number of the earlier application or the title of the authority with which the earlier application was filed are missing or incorrect in the request when claiming for right of priority, the patent administration department under the State Council shall notify the applicant to make rectification within the specified time limit. Where the applicant fails to make the rectification within the time limit, the right of priority shall be deemed not to have been claimed.

Where the name or title of the applicant who claims the right of priority is not the

same as the one recorded in the copy of the earlier application, the applicant shall submit document certifying the assignment of right of priority. If no such document is submitted, the right of priority shall be deemed not to have been claimed.

Where any applicant claims a right of foreign priority for patent application for design, and no brief explanation of the design was contained in the earlier application, he or it will not be adversely affected as for enjoying the right of priority if the brief explanation submitted by the applicant in accordance with the provisions of Rule 28 of these Regulations does not go beyond the scope as shown in the drawings or photographs of the earlier application.

**Rule 32.** An applicant may claim one or more priorities for an application for a patent; where multiple priorities are claimed, the priority period for the application shall be calculated from the earliest priority date.

Where an applicant claims the right of domestic priority, if the earlier application is one for a patent for invention, he or it may file an application for a patent for invention or utility model for the same subject matter; if the earlier application is one for a patent for utility model, he or it may file an application for a patent for utility model or invention for the same subject matter. However, when the later application is filed, if the subject matter of the earlier application falls under any of the following, it may not be taken as the basis for claiming domestic priority:

(1) where the applicant has claimed foreign or domestic priority;

(2) where it has been granted a patent right;

(3) where it is the subject matter of a divisional application filed as prescribed.

Where the domestic priority is claimed, the earlier application shall be deemed to be withdrawn from the date on which the later application is filed.

**Rule 33.** Where an application for a patent is filed or the right of foreign priority is claimed by an applicant having no habitual residence or business office in China, the patent administration department under the State Council may, when it deems necessary, require the applicant to submit the following documents:

(1) if the applicant is an individual, a certificate concerning his nationality;

(2) if the applicant is an enterprise or other organization, a document certifying the country or region in which it is registered;

(3) a document certifying that the country, to which the foreigner, foreign enterprise or other foreign organization belongs, recognizes that Chinese entities and individuals are, under the same conditions as those applied to its nationals, entitled to the patent right, the right of priority and other related rights in that country.

**Rule 34.** Two or more inventions or utility models belonging to a single general in-

ventive concept which may be filed as one application in accordance with the provisions of Article 31, paragraph one of the Patent Law shall be technically inter-related and contain one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of those inventions or utility models, considered as a whole, makes over the prior art.

**Rule 35.** Where two or more similar designs of the same product are filed in one application in accordance with the provisions of Article 31, paragraph two of the Patent Law, the other designs of the product shall be similar to the main design indicated in the brief explanation. The number of similar designs contained in an application for patent for design shall not exceed 10.

The two or more designs belonging to the same class and sold or used in sets as referred to in Article 31, paragraph two of the Patent Law mean that, each product incorporating the design belongs to the same class in the classification of products and is customarily sold or used at the same time, and the designs incorporated in each product have the same concept of design.

Where two or more designs are filed as one application, they shall be numbered consecutively and the numbers shall precede the titles of the drawings or photographs of the product incorporating the design.

**Rule 36.** When withdrawing an application for a patent, the applicant shall submit to the patent administration department under the State Council a declaration to that effect stating the title of the invention-creation, the filing number and the date of filing.

Where a declaration to withdraw an application for a patent is submitted after the preparations for the publication of the application document has been completed by the patent administration department under the State Council, the application document shall be published as scheduled. However, the declaration withdrawing the application for patent shall be published in the next issue of the Patent Gazette.

# Chapter Ⅲ
# Examination and Approval of Application for Patent

**Rule 37.** Where any of the following events occurs, a person who makes examination or hears a case in the procedures of preliminary examination, examination as to substance, reexamination or invalidation shall, on his own initiative or upon the request of the parties concerned or any other interested person, be excluded from exercising his function:

(1) where he is a near relative of the party concerned or the agent of the party con-

cerned;

(2) where he has an interest in the application for patent or the patent right;

(3) where he has any other kinds of relations with the party concerned or with the agent of the party concerned that may influence impartial examination and hearing;

(4) where a member of the Patent Reexamination Board who has taken part in the examination of the same application.

**Rule 38.** Upon the receipt of an application for a patent for invention or utility model consisting of a request, a description (drawings must be included in an application for utility model) and one or more claims, or an application for a patent for design consisting of a request, one or more drawings or photographs showing the design and a brief explanation, the patent administration department under the State Council shall accord the date of filing, issue a filing number, and notify the applicant.

**Rule 39.** In any of the following circumstances, the patent administration department under the State Council shall refuse to accept the application and notify the applicant accordingly:

(1) where the application for a patent for invention or utility model does not contain a request, a description (the description of utility model does not contain drawings) or claims, or the application for a patent for design does not contain a request, drawings or photographs, or a brief explanation;

(2) where the application is not written in Chinese;

(3) where the application is not in conformity with the provisions of Rule 121, paragraph one of these Implementing Regulations;

(4) where the request does not contain the name or title, or address of the applicant;

(5) where the application is obviously not in conformity with the provisions of Article 18, or of Article 19, paragraph one of the Patent Law;

(6) where the kind of protection (patent for invention, utility model or design) of the application for a patent is not clear and definite or cannot be ascertained.

**Rule 40.** Where the description states that it contains explanatory notes to the drawings but the drawings or part of them are missing, the applicant shall, within the time limit specified by the patent administration department under the State Council, either furnish the drawings or make a declaration for the deletion of the explanatory notes to the drawings. If the drawings are submitted later, the date of their delivery at, or mailing to, the patent administration department under the State Council shall be the date of filing of the application; if the explanatory notes to the drawings are to be deleted, the initial date of filing shall be retained.

**Rule 41.** Two or more applicants who respectively file, on the same day (means the date of filing or the priority date where priority is claimed), applications for patent for the identical invention-creation, shall, after receipt of a notification from the patent administration department under the State Council, hold consultations among themselves to decide the person or persons who shall be entitled to file the application.

Where an applicant files on the same day (means the date of filing) applications for both a patent for utility model and a patent for invention for the identical invention-creation, he or it shall state respectively upon filing the application that another patent application for the identical invention-creation has been filed by him or it. If the applicant fails to do so, the issue shall be handled according to the provisions of Article 9, paragraph one of the Patent Law, only one patent right shall be granted for any identical invention-creation.

Where the patent administration department under the State Council makes an announcement of the grant of patent for utility model, the statement of the applicant in accordance with the provision of paragraph two of this Rule that he has simultaneously filed an application for a patent for invention shall be announced.

Where it is found after examination that there is no cause for rejection of the application for patent for invention, the patent administration department under the State Council shall notify the applicant to declare, within the specified time limit, the abandonment of his or its patent for utility model. If the applicant so declares, the patent administration department under the State Council shall make the decision to grant a patent for invention, and announce at the same time both the grant of the patent for invention and the declaration of the applicant to abandon his or its patent for utility model. If the applicant refuses to abandon his or its patent for utility model, the patent administration department under the State Council shall reject the application for patent for invention. If the applicant fails to respond within the time limit, the application for patent for invention shall be deemed to have been withdrawn.

The patent right for utility model ceases from the date of the announcement of grant of the patent for invention.

**Rule 42.** Where an application for a patent contains two or more inventions, utility models or designs, the applicant may, before the expiration of the time limit provided for in Rule 54, paragraph one of these Implementing Regulations, submit to the patent administration department under the State Council a divisional application. However, where an application for patent has been rejected, withdrawn or is deemed to have been withdrawn, no divisional application may be filed.

If the patent administration department under the State Council finds that an application for a patent is not in conformity with the provisions of Article 31 of the Patent Law or of Rule 34 or 35 of these Implementing Regulations, it shall invite the applicant to amend the application within a specified time limit; if the applicant fails to make any response af-

ter the expiration of the specified time limit, the application shall be deemed to have been withdrawn.

The divisional application may not change the kind of protection of the initial application.

**Rule 43.** A divisional application filed in accordance with the provisions of Rule 42 of these Implementing Regulations shall be entitled to the filing date and, if priority is claimed, the priority date of the initial application, provided that the divisional application does not go beyond the scope of disclosure contained in the initial application.

The divisional application shall go through all the formalities in accordance with the provisions of the Patent Law and these Implementing Regulations.

The filing number and the date of filing of the initial application shall be indicated in the request of the divisional application. When the divisional application is filed, it shall be accompanied by a copy of the initial application; if priority is claimed for the initial application, a copy of the priority document of the initial application shall also be submitted.

**Rule 44.** "Preliminary examination" referred to in Articles 34 and 40 of the Patent Law means the check of an application for a patent to see whether or not it contains the documents as provided for in Article 26 or 27 of the Patent Law and other necessary documents, and whether or not those documents are in the prescribed form; such check shall also include the following:

(1) whether or not any application for a patent for invention obviously falls under Article 5 or 25 of the Patent Law, or is not in conformity with the provisions of Article 18, Article 19, paragraph one or Article 20, paragraph one of the Patent Law or Rule 16 or Rule 26, paragraph two of these Implementing Regulations, or is obviously not in conformity with the provisions of Article 2, paragraph two, Article 26, paragraph five, Article 31, paragraph one, or Article 33 of the Patent Law, or of Rules 17 to 21 of these Implementing Regulations;

(2) whether or not any application for a patent for utility model obviously falls under Article 5 or 25 of the Patent Law, or is not in conformity with the provisions of Article 18, Article 19, paragraph one or Article 20, paragraph one of the Patent Law or Rules 16 to 19 or Rules 21 to 23 of these Implementing Regulations, or is obviously not in conformity with the provisions of Article 2, paragraph three, Article 22, paragraph two or four, Article 26, paragraph three or four, or of Article 31, paragraph one, or of Article 33 of the Patent Law, or of Rule 20 or Rule 43, paragraph one of these Implementing Regulations, or is not entitled to a patent right in accordance with the provisions of Article 9 of the Patent Law;

(3) whether or not any application for a patent for design obviously falls under Article 5 or Article 25, paragraph one (6) of the Patent Law, or is not in conformity with the provisions of Article 18, Article 19, paragraph one of the Patent Law, or of Rule 16, Rule 27 or

Rule 28 of these Implementing Regulations, or is obviously not in conformity with the provisions of Article 2, paragraph four, Article 23, paragraph one, Article 27, paragraph two, Article 31, paragraph two, or of Article 33 of the Patent Law, or of Rule 43, paragraph one of these Implementing Regulations, or is not entitled to a patent right in accordance with the provisions of Article 9 of the Patent Law;

(4) whether or not any application document is in conformity with the provisions of Rule 2 or Rule 3, paragraph one of these Implementing Regulations.

The patent administration department under the State Council shall notify the applicant of its opinions after checking his or its application and invite him or it to state his or its observations or to rectify his or its application within the specified time limit. If the applicant fails to make any response within the specified time limit, the application shall be deemed to have been withdrawn. Where, after the applicant has made his or its observations or the corrections, the patent administration department under the State Council still finds that the application is not in conformity with the provisions of the Articles and the Rules cited in the preceding subparagraphs, the application shall be rejected.

**Rule 45.** Apart from the application for patent, any document relating to the patent application which is submitted to the patent administration department under the State Council, shall, in any of the following circumstances, be deemed not to have been submitted:

(1) where the document is not presented in the prescribed form or the indications therein are not in conformity with the prescriptions;

(2) where no certifying document is submitted as prescribed.

The patent administration department under the State Council shall notify the applicant of its opinion after checking that the document is deemed not to have been submitted.

**Rule 46.** Where the applicant requests an earlier publication of his or its application for a patent for invention, a statement shall be made to the patent administration department under the State Council. The patent administration department under the State Council shall, after preliminary examination of the application, publish it immediately, unless it is to be rejected.

**Rule 47.** The applicant shall, when indicating the product incorporating the design and the class to which that product belongs, refer to the classification of products for designs published by the patent administration department under the State Council. Where no indication, or an incorrect indication, of the class to which the product incorporating the design belongs is made, the patent administration department under the State Council shall supply the indication or correct it.

**Rule 48.** Any person may, from the date of publication of an application for a patent for invention till the date of announcing the grant of the patent right, submit to the patent administration department under the State Council his observations, with reasons therefor, on the application which is not in conformity with the provisions of the Patent Law.

**Rule 49.** Where the applicant for a patent for invention cannot furnish, for justified reasons, the documents concerning any search or results of any examination specified in Article 36 of the Patent Law, he or it shall make a statement to the patent administration department under the State Council and submit them when the said documents are available.

**Rule 50.** The patent administration department under the State Council shall, when proceeding on its own initiative to examine an application for a patent in accordance with the provisions of Article 35, paragraph two of the Patent Law, notify the applicant accordingly.

**Rule 51.** At the time when a request for examination as to substance is made, and when, within the time limit of three months after the receipt of the notification of the patent administration department under the State Council on the entry into examination as to substance of the application, the applicant for a patent for invention may amend the application for a patent for invention on his or its own initiative.

Within two months from the date of filing, the applicant for a patent for utility model or design may amend the application for a patent for utility model or design on its or his own initiative.

Where the applicant amends the application after receiving the notification of opinions of the examination as to substance of the patent administration department under the State Council, he or it shall make the amendment directed to the defects pointed out by the notification.

The patent administration department under the State Council may, on its own initiative, correct the obvious clerical mistakes and symbol mistakes in the documents of application for a patent. Where the patent administration department under the State Council corrects mistakes on its own initiative, it shall notify the applicant.

**Rule 52.** When an amendment to the description or the claims in an application for a patent for invention or utility model is made, a replacement sheet in prescribed form shall be submitted, unless the amendment concerns only the alteration, insertion or deletion of a few words. Where an amendment to the drawings or photographs of an application for a patent for design is made, a replacement sheet shall be submitted as prescribed.

**Rule 53.** In accordance with the provisions of Article 38 of the Patent Law, the cir-

cumstances where an application for a patent for invention shall be rejected by the patent administration department under the State Council after examination as to substance are as follows:

(1) where the application falls under Article 5 or 25 of the Patent Law, or the applicant is not entitled to a patent right in accordance with the provisions of Article 9 of the Patent Law;

(2) where the application does not comply with the provisions of Article 2, paragraph two, Article 20, paragraph one, Article 22, Article 26, paragraph three, four or five, or Article 31, paragraph one of the Patent Law, or of Rule 20, paragraph two of these Implementing Regulations;

(3) where the amendment to the application does not comply with the provisions of Article 33 of the Patent Law, or the divisional application does not comply with the provisions of Rule 43, paragraph one of these Implementing Regulations.

**Rule 54.** After the patent administration department under the State Council issues the notification to grant the patent right, the applicant shall go through the formalities of registration within two months from the date of receipt of the notification. If the applicant completes the formalities of registration within the said time limit, the patent administration department under the State Council shall grant the patent right, issue the patent certificate and announce it.

If the applicant does not go through the formalities of registration within the time limit, he or it shall be deemed to have abandoned his or its right to obtain the patent right.

**Rule 55.** Where it is found after examination that there is no cause for rejection of the application for a secret patent, the patent administration department under the State Council shall make a decision to grant a secret patent, issue the certificate of the secret patent, and register the matters relating to the secret patent.

**Rule 56.** After the announcement of the decision to grant a patent for utility model or a patent for design, the patentee or the interested party prescribed in Article 60 of the Patent Law may request the patent administration department under the State Council to make an evaluation report of patent.

Where such person requests for an evaluation report of patent, he shall submit a request for the evaluation report of patent, indicating the patent number. Each request shall be limited for one patent.

Where the request for the evaluation report of patent does not comply with the requirements as prescribed, the patent administration department under the State Council shall notify the requesting party to rectify the request within a specified time limit. If the requesting party fails to do so within the time limit, the request shall be deemed not to have been sub-

mitted.

**Rule 57.** The patent administration department under the State Council shall make the evaluation report of patent within two months from receiving of the request for the evaluation report of patent. Where two or more persons request for the evaluation report of patent in respect of a same patent for utility model or patent for design, the patent administration department under the State Council shall make one evaluation report only. Any entity or individual may view or copy the evaluation report of patent.

**Rule 58.** The patent administration department under the State Council shall correct promptly the mistakes in the patent announcements and patent pamphlets issued by it once they are discovered, and the corrections shall be announced.

# Chapter IV
# Reexamination of Patent Application and Invalidation of Patent Right

**Rule 59.** The Patent Reexamination Board shall consist of technical and legal experts appointed by the patent administration department under the State Council. The person responsible for the patent administration department under the State Council shall be the Director of the Board.

**Rule 60.** Where the applicant requests the Patent Reexamination Board to make a reexamination in accordance with the provisions of Article 41 of the Patent Law, it or he shall file a request for reexamination, state the reasons and, when necessary, attach the relevant supporting documents.

Where the request for reexamination does not comply with the provisions of Article 19, paragraph one or Article 41, Paragraph one of the Patent Law, the Patent Reexamination Board shall refuse to accept it, notify the applicant in written form and state the reasons thereof.

Where the request for reexamination does not comply with the prescribed form, the person making the request shall rectify it within the time limit specified by the Patent Reexamination Board. If the requesting person fails to do so, the request for reexamination shall be deemed not to have been filed.

**Rule 61.** The person making the request may amend its or his patent application at the time when it or he requests reexamination or makes responses to the notification of re-

examination of the Patent Reexamination Board. However, the amendments shall be limited only to remove the defects pointed out in the decision of rejection of the application or in the notification of reexamination.

The amendments to the application for patent shall be in two copies.

**Rule 62.** The Patent Reexamination Board shall remit the request for reexamination which the Board has received to the examination department of the patent administration department under the State Council which has made the examination of the application concerned to make an examination. Where that examination department agrees to revoke its former decision upon the request of the person requesting reexamination, the Patent Reexamination Board shall make a decision accordingly and notify the requesting person.

**Rule 63.** Where, after reexamination, the Patent Reexamination Board finds that the request does not comply with relevant provisions of the Patent Law and these Implementing Regulations, it shall invite the person requesting reexamination to submit its or his observations within a specified time limit. If the time limit for making response is not met, the request for reexamination shall be deemed to have been withdrawn. Where, after the requesting person has made its or his observations or amendments, the Patent Reexamination Board still finds that the request does not comply with relevant provisions of the Patent Law and these Implementing Regulations, it shall make a decision of reexamination to maintain the earlier decision rejecting the application.

Where, after reexamination, the Patent Reexamination Board finds that the decision rejecting the application does not comply with relevant provisions of the Patent Law and these Implementing Regulations, or that the amended application has removed the defects as pointed out by the decision rejecting the application, it shall make a decision to revoke the decision rejecting the application, and ask the examination department which has made the examination to continue the examination procedure.

**Rule 64.** At any time before the Patent Reexamination Board makes its decision on the request for reexamination, the requesting person may withdraw its or his request for reexamination.

Where the requesting person withdraws its or his request for reexamination before the Patent Reexamination Board makes its decision, the procedure of reexamination is terminated.

**Rule 65.** Anyone requesting invalidation or part invalidation of a patent right in accordance with the provisions of Article 45 of the Patent Law shall submit a request and the necessary evidence in two copies. The request for invalidation shall state in detail the grounds for filing the request, making reference to all the evidence as submitted, and indi-

cate the piece of evidence on which each ground is based.

The grounds on which the request for invalidation is based, referred to in the preceding paragraph, mean that the invention-creation for which the patent right is granted does not comply with the provisions of Article 2, Article 20, paragraph one, Article 22, Article 23, Article 26, paragraph three or four, Article 27, paragraph two, or Article 33 of the Patent Law, or of Rule 20, paragraph two or Rule 43, paragraph one of these Implementing Regulations; or the invention-creation falls under the provisions of Article 5 or 25 of the Patent Law; or the applicant is not entitled to be granted the patent right in accordance with the provisions of Article 9 of the Patent Law.

**Rule 66.** Where the request for invalidation does not comply with the provisions of Article 19, paragraph one of the Patent Law, or of Rule 65 of these Implementing Regulations, the Patent Reexamination Board shall refuse to accept it.

Where, after a decision on any request for invalidation of the patent right is made, invalidation based on the same reasons and evidence is requested once again, the Patent Reexamination Board shall refuse to accept it.

Where a request for invalidation of a patent for design is filed on the ground that the patent for design does not comply with the provision of Article 23, paragraph three of the Patent Law, but no evidence is submitted to prove such conflict of rights, the Patent Reexamination Board shall refuse to accept it.

Where the request for invalidation of the patent right does not comply with the prescribed form, the person making the request shall rectify it within the time limit specified by the Patent Reexamination Board. If the rectification fails to be made within the time limit, the request for invalidation shall be deemed not to have been made.

**Rule 67.** After a request for invalidation is accepted by the Patent Reexamination Board, the person making the request may add reasons or supplement evidence within one month from the date when the request for invalidation is filed. Additional reasons or evidence which are submitted after the specified time limit may be disregarded by the Patent Reexamination Board.

**Rule 68.** The Patent Reexamination Board shall send a copy of the request for invalidation of the patent right and copies of the relevant documents to the patentee and invite it or him to present its or his observations within a specified time limit.

The patentee and the person making the request for invalidation shall, within the specified time limit, make responses to the notification concerning transmitted documents or the notification concerning the examination of the request for invalidation sent by the Patent Reexamination Board. Where no response is made within the specified time limit, the examination of the Patent Reexamination Board will not be affected.

**Rule 69.** In the course of the examination of the request for invalidation, the patentee for the patent for invention or utility model concerned may amend its or his claims, but may not broaden the scope of patent protection.

The patentee for the patent for invention or utility model concerned may not amend its or his description or drawings. The patentee for the patent for design concerned may not amend its or his drawings, photographs or the brief explanation of the design.

**Rule 70.** The Patent Reexamination Board may, at the request of the parties concerned or in accordance with the needs of the case, decide to hold an oral procedure in respect of a request for invalidation.

Where the Patent Reexamination Board decides to hold an oral procedure in respect of a request for invalidation, it shall send notifications to the parties concerned, indicating the date and place of the oral procedure to be held. The parties concerned shall make response to the notification within the time limit specified in the notification.

Where the person requesting invalidation fails to make response to the notification of the oral procedure sent by the Patent Reexamination Board within the specified time limit, and fails to take part in the oral procedure, the request for invalidation shall be deemed to have been withdrawn. Where the patentee fails to take part in the oral procedure, the Patent Reexamination Board may proceed to examine by default.

**Rule 71.** In the course of the examination of a request for invalidation, the time limit specified by the Patent Reexamination Board shall not be extended.

**Rule 72.** The person requesting invalidation may withdraw his request before the Patent Reexamination Board makes a decision on it.

Where the person requesting invalidation withdraws his request or where his request for invalidation is deemed to have been withdrawn before the Patent Reexamination Board makes a decision on it, the examination of the request for invalidation is terminated. Where, based on the examination work it has done, the Patent Reexamination Board finds that it is able to make a decision of invalidation or invalidation in part of the patent right, the examination procedure shall not be terminated.

## Chapter V
## Compulsory License for Exploitation of Patent

**Rule 73.** The insufficient exploitation of its or his patent mentioned in Article 48, subparagraph (1) of the Patent Law means the manner or scale of the exploitation of patent

by the patentee and/or the licensee authorized by it or him cannot satisfy the demands of the domestic market for the patented product or patented process.

The pharmaceutical product to which patent right has been granted as mentioned in Article 50 of the Patent Law means any patented product, or product directly obtained by a patented process, of pharmaceutical sector needed to address public health problems, including the patented active ingredients necessary for the manufacture of the product and the diagnostic kits needed for its use.

**Rule 74.** Any entity or individual requesting a compulsory license shall submit to the patent administration department under the State Council a request for compulsory license, state the reasons thereof, and attach relevant certifying documents.

The patent administration department under the State Council shall send a copy of the request for compulsory license to the patentee, who shall make his or its observations within the time limit specified by the patent administration department under the State Council. Where no response is made within the time limit, the patent administration department under the State Council will not be affected in making its decision.

Before making a decision to reject a request for compulsory license or to grant a compulsory license, the patent administration department under the State Council shall, notify the requesting person and the patentee the decision that is to be made on the request and the reasons thereof.

The decision of the patent administration department under the State Council on granting a compulsory license in accordance with Article 50 of the Patent Law, shall be also in conformity with the provisions of the relevant international treaties on granting compulsory license for the purposes of addressing public health issue, to which China is party, except for provisions on which China has made reservation.

**Rule 75.** Where any entity or individual requests, in accordance with the provisions of Article 57 of the Patent Law, the patent administration department under the State Council to adjudicate the fees for exploitation, it or he shall submit a request for adjudication and furnish documents showing that the parties concerned have not been able to conclude an agreement in respect of the amount of the exploitation fee. The patent administration department under the State Council shall make an adjudication within three months from the date of receipt of the request and notify the parties concerned accordingly.

# Chapter VI
# Reward and Remuneration for Inventors or Creators of Service Inventions-Creations

**Rule 76.** The entity to which a patent right is granted may, on the manner and amount of the reward and remuneration as prescribed in Article 16 of the Patent Law, enter into a contract with the inventor or creator, or provide it in its rules and regulations formulated in accordance with the laws.

The reward and remuneration awarded to the inventor or creator by any enterprise or institution shall be handled in accordance with the relevant provisions of the State on financial and accounting systems.

**Rule 77.** Where the entity to which a patent right is granted has not entered into a contract with the inventor or creator on the manner and amount of the reward as prescribed in Article 16 of the Patent Law, nor has the entity provided it in its rules and regulations formulated in accordance with the laws, it shall, within three months from the date of the announcement of the grant of the patent right, award to the inventor or creator of a service invention-creation a sum of money as prize. The sum of money prize for a patent for invention shall not be less than RMB 3,000 Yuan; the sum of money prize for a patent for utility model or design shall not be less than RMB 1,000 Yuan.

Where an invention-creation is made on the basis of an inventor's or creator's proposal adopted by the entity to which he belongs, the entity to which a patent right is granted shall award to him a money prize on favorable terms.

**Rule 78.** Where the entity to which a patent right is granted has not entered into a contract with the inventor or creator on the manner and amount of the remuneration as prescribed in Article 16 of the Patent law, nor has the entity provided it in its rules and regulations in accordance with the laws, it shall, after exploiting the patent for invention-creation within the duration of the patent right, draw each year from the profits from exploitation of the invention or utility model a percentage of not less than 2%, or from the profits from exploitation of the design a percentage of not less than 0.2%, and award it to the inventor or creator as remuneration. The entity may, as an alternative, by making reference to the said percentage, award a lump sum of money to the inventor or creator as remuneration once and for all. Where any entity to which a patent right is granted authorizes any other entity or individual to exploit its patent, it shall draw from the exploitation fee it receives a percentage of not less than 10% and award it to the inventor or creator as remuneration.

# Chapter VII
# Protection of Patent Right

**Rule 79.** The administrative authority for patent affairs referred to in the Patent Law and these Implementing Regulations means the department responsible for the administrative work concerning patent affairs set up by the people's government of any province, autonomous region, or municipality directly under the Central Government, or by the people's government of any city which consists of districts, has a large amount of patent administration work to attend to and has the ability to deal with the matter.

**Rule 80.** The patent administration department under the State Council shall provide professional guidance to the administrative authorities for patent affairs in handling patent infringement disputes, investigating and prosecuting acts of passing off a patent and mediating patent disputes.

**Rule 81.** Where any party concerned requests handling of a patent infringement dispute or mediation of a patent dispute, it shall fall under the jurisdiction of the administrative authority for patent affairs where the alleged infringer has his location or where the act of infringement has taken place.

Where two or more administrative authorities for patent affairs all have jurisdiction over a patent dispute, any party concerned may file his or its request with one of them to handle or mediate the matter. Where requests are filed with two or more administrative authorities for patent affairs with proper jurisdiction, the administrative authority for patent affairs that first accepts the request shall have jurisdiction.

Where administrative authorities for patent affairs have a dispute over their jurisdiction, the administrative authority for patent affairs of their common higher level people's government shall designate the administrative authority for patent affairs to exercise the jurisdiction; if there is no such administrative authority for patent affairs of their common higher level people's government, the patent administration department under the State Council shall designate the administrative authority for patent affairs to exercise the jurisdiction.

**Rule 82.** Where, in the course of handling a patent infringement dispute, the alleged infringer requests invalidation of the patent right and his request is accepted by the Patent Reexamination Board, he may request the administrative authority for patent affairs concerned to suspend the handling of the matter.

If the administrative authority for patent affairs considers that the reasons set forth by the alleged infringer for the suspension are obviously untenable, it may not suspend the handling of the matter.

**Rule 83.** Where any patentee affixes a patent indication on the patented product or on the package of that product in accordance with the provisions of Article 17 of the Patent Law, he or it shall make the affixation in the manner as prescribed by the patent administration department under the State Council.

Where any patent indication is not in conformity with the provision of the preceding paragraph, the administrative authority for patent affairs shall order to correct it.

**Rule 84.** Any of the following is an act of passing off a patent as prescribed in Article 63 of the Patent Law:

(1) affixing patent indication on a product or on the package of a product which has not been granted a patent, continuing to affix patent indication on a product or on the package of a product, after the related patent right has been declared invalid or is terminated, or affixing the patent number of another person on a product or on the package of a product without authorization ;

(2) sale of the product as prescribed in subparagraph (1);

(3) indicating a technology or design to which no patent right has been granted as patented technology or patented design, indicating a patent application as patent or using the patent number of another person without authorization, in such materials as specification of product etc. , which could mislead the public to regard the related technology or design as patented technology or patented design;

(4) counterfeiting or transforming any patent certificate, patent document or patent application document;

(5) any other act which might cause confusion on the part of the public, misleading them to regard a technology or design to which no patent right has been granted as patented technology or patented design.

Affixing patent indication legally on a patented product, or on a product directly obtained by a patented process, or on the package of such products before the termination of the patent right, offering for sale or sale of such products after the termination of the patent right is not an act of passing off a patent.

Where any person sells a product passing off a patent without knowing it , and can prove that it or he obtains the product from a legitimate channel, it or he shall be ordered to stop selling the product by the administrative authority for patent affairs, but be exempted from being imposed a fine.

**Rule 85.** In addition to the provisions of Article 60 of the Patent Law, the administra-

tive authority for patent affairs may also mediate in the following patent disputes at the request of the parties concerned:

(1) any dispute over the ownership of the right to apply for patent and the patent right;

(2) any dispute over the qualification of the inventor or creator;

(3) any dispute over the award and remuneration of the inventor or creator of a service invention-creation;

(4) any dispute over the appropriate fee to be paid for the exploitation of an invention after the publication of the application for patent but before the grant of patent right;

(5) any other patent dispute.

In respect of the dispute referred to in subparagraph (4), where the party concerned requests the administrative authority for patent affairs to mediate, the request shall be made after the grant of the patent right.

**Rule 86.** Any party involving in a dispute over the ownership of the right of patent application or patent right, who has already applied for mediation with the administrative authority for patent affairs or instituted legal proceedings before the people's court, may request the patent administration department under the State Council to suspend the relevant procedures.

Any party requesting the suspension of the relevant procedures in accordance with the preceding paragraph, shall submit a request to the patent administration department under the State Council, accompanied by a copy of the document acknowledging that the administrative authority for patent affairs or the people's court has accepted the case, in which the filing number or the patent number concerned has been indicated.

After entering into force of the mediation made by the administrative authority for patent affairs or the judgment rendered by the people's court, the parties concerned shall request the patent administration department under the State Council to resume the suspended procedure. If, within one year from the date when the request for suspension is filed, no decision is made on the dispute relating to the ownership of the right to apply for a patent or the patent right, and it is necessary to continue the suspension, the party who made the request shall, within the said time limit, request to extend the suspension. If, at the expiration of the said time limit, no such request for extension is filed, the patent administration department under the State Council shall resume the procedure on its own initiative.

**Rule 87.** Where, in hearing civil cases, the people's court has ordered the adoption of preservation measures on the right of patent application or patent right, the patent administration department under the State Council shall suspend the relevant procedure concerning the patent application or patent under preservation on the date of receiving the judgment order and the notification on assisting the execution of the order indicated with the filing

number or the patent number. At the expiration of the time limit for preservation, if there is no order of the people's court to continue the preservation, the patent administration department under the State Council shall resume the relevant procedure on its own initiative.

**Rule 88.** The suspension of relevant procedures carried out by the patent administration department under the State Council in accordance with Rule 86 and Rule 87 of these Implementing Regulations , refers to the suspension of such procedures as preliminary examination, examination as to substance, reexamination of a patent application, granting of patent right and the announcement of invalidation of patent; the suspension of the procedures on handling the abandonment of patent right, changing or transferring patent right or right of patent application, pledge of patent right and the cessation of patent right before the expiration of its duration.

## Chapter VIII
## Patent Registration and Patent Gazette

**Rule 89.** The patent administration department under the State Council shall keep a Patent Register in which the registration of the following matters relating to patent application or patent right shall be made:

(1) any grant of the patent right;

(2) any transfer of the right of patent application or the patent right;

(3) any pledge and preservation of the patent right and their discharge;

(4) any patent license contract for exploitation submitted for the record;

(5) any invalidation of the patent right;

(6) any cessation of the patent right;

(7) any restoration of the patent right;

(8) any compulsory license for exploitation of the patent;

(9) any change in the name or title, nationality and address of the patentee.

**Rule 90.** The patent administration department under the State Council shall publish the Patent Gazette at regular intervals, publishing or announcing the following:

(1) the bibliographic data and the abstract of the description of an application for a patent for invention;

(2) any request for examination as to substance of an application for a patent for invention and any decision made by the patent administration department under the State Council to proceed on its own initiative to examine as to substance an application for a patent for invention;

(3) any rejection, withdrawal, deemed withdrawal, deemed abandonment, restoration and transfer of an application for a patent for invention after its publication;

(4) any grant of patent right and the bibliographic data of the patent right;

(5) the abstract of the description of a patentfor invention or a patent for utility model, one drawing or photograph of a patent for design;

(6) any declassification of national defense patent or secret patent;

(7) any invalidation of the patent right;

(8) any cessation or restoration of the patent right;

(9) any transfer of the patent right;

(10) any patent license contract for exploitation submitted for record;

(11) any pledge or preservation of the patent right and their discharge;

(12) any grant of compulsory license for exploitation of the patent;

(13) any change in the name or title and address of the patentee;

(14) any service of documents by way of making an announcement;

(15) any correction made by the patent administration department under the State Council; and

(16) any other related matters.

**Rule 91.** The patent administration department under the State Council shall make the patent gazettes, the pamphlets of the application for patent for invention and the pamphlets of patent for invention, patent for utility model and patent for design available to the public for consultation with free of charge.

**Rule 92.** The patent administration department under the State Council is responsible for exchanging, in accordance with the principle of reciprocity, patent documents with the patent authorities of other countries or regions or with the patent authorities of regional patent organizations.

# Chapter IX
# Fees

**Rule 93.** When any person files an application for a patent with, or has other formalities to go through at, the patent administration department under the State Council, he or it shall pay the following fees:

(1) filing fee, additional fee for filing an application, printing fee for publishing the application, and fee for claiming priority;

(2) fee for examination as to substance for an application for patent for invention, and

reexamination fee;

(3) registration fee for the grant of patent right, printing fee for the announcement of grant of patent right, and annual fee;

(4) fee for requesting restoration of right, and fee for requesting extension of time limit;

(5) fee for making a change in the bibliographic data, fee for requesting for evaluation report of patent, and fee for requesting for announcement of invalidation of patent.

The amount of the fees referred to in the preceding paragraphs shall be prescribed by the price administration department and the finance administration department under the State Council in conjunction with the patent administration department under the State Council.

**Rule 94.** The fees provided for in the Patent Law and in these Implementing Regulations may be paid directly to the patent administration department under the State Council or paid by way of bank or postal remittance, or by way of any other means as prescribed by the patent administration department under the State Council.

Where any fee is paid by way of bank or postal remittance, the applicant or the patentee shall indicate on the money order at least the correct filing number or the patent number and the name of the fee paid. If the requirements as prescribed in this paragraph are not complied with, the payment of the fee shall be deemed not to have been made.

Where any fee is paid directly to the patent administration department under the State Council, the date on which the fee is paid shall be the date of payment; where any fee is paid by way of postal remittance, the date of remittance indicated by the postmark shall be the date of payment; where any fee is paid by way of bank transfer, the date on which the transfer of the fee is done shall be the date of payment.

Where any patent fee is paid in excess of the amount as prescribed, paid repeatedly or wrongly, the party making the payment may, within three years from the date of payment, request a refund from the patent administration department under the State Council, and the patent administration department under the State Council shall return it.

**Rule 95.** The applicant shall pay the filing fee, the printing fee for the publication of the application and the necessary additional fee for filing an application within two months from the filing date or fifteen days from the date of receipt of the notification of acceptance of the application from the patent administration department under the State Council. If the fees are not paid or not paid in full within the time limit, the application shall be deemed to be withdrawn.

Where the applicant claims priority, he or it shall pay the fee for claiming priority at the same time with the payment of the filing fee. If the fee is not paid or not paid in full within the time limit, the claim for priority shall be deemed not to have been made.

**Rule 96.** Where the party concerned makes a request for an examination as to substance or a reexamination, the relevant fee shall be paid within the time limit as prescribed respectively for such requests by the Patent Law and these Implementing Regulations. If the fee is not paid or not paid in full within the time limit, the request is deemed not to have been made.

**Rule 97.** When the applicant goes through the formalities of registration of the grant of patent right, it or he shall pay a registration fee for the grant of patent right, printing fee for the announcement of grant of patent right and the annual fee of the year in which the patent right is granted. If such fees are not paid or not paid in full within the time limit, the registration of the grant of patent right shall be deemed not to have been made.

**Rule 98.** The annual fee of the patent right after the year in which the patent is granted shall be paid before the expiration of the preceding year. If the patentee fails to pay or pay in full the fee, the patent administration department under the State Council shall notify the patentee to pay the fee or to make up the insufficiency within six months from the expiration of the time limit within which the annual fee is due to be paid, and at the same time pay a surcharge. The amount of the surcharge shall be, for each month of late payment, 5% of the whole amount of the annual fee of the year within which the annual fee is due to be paid. Where the fee and the surcharge are not paid within the time limit, the patent right shall lapse from the expiration of the time limit within which the annual fee should be paid.

**Rule 99.** The fee for requesting restoration of right shall be paid within the relevant time limit prescribed in these Implementing Regulations. If the fee is not paid or not paid in full within the time limit, the request shall be deemed not to have been made.

The fee for request of extension of a time limit shall be paid before the expiration of the relevant time limit. If the fee is not paid or not paid in full within the time limit, the request shall be deemed not to have been made.

The fee for a change in the bibliographic data, fee for requesting for evaluation report of patent and fee for request of invalidation of patent right shall be paid within one month from the date on which such request is filed. If the fee is not paid or not paid in full within the time limit, the request shall be deemed not to have been made.

**Rule 100.** Where any applicant or patentee has difficulties in paying the various fees prescribed in these Implementing Regulations, it or he may, in accordance with the prescriptions, submit a request to the patent administration department under the State Council for a reduction or postponement of the payment. Measures for the reduction and postponement of the payment shall be prescribed by the finance administration department under the State

Council in conjunction with the price administration department under the State Council and the patent administration department under the State Council.

## Chapter X
## Special Provisions Concerning International Application

**Rule 101.** The patent administration department under the State Council receives international patent applications filed under the Patent Cooperation Treaty in accordance with the provisions of Article 20 of the Patent Law.

For any international application filed under the Patent Cooperation Treaty designating China (hereinafter referred to as the international application), the requirements and procedures for entering the phase of process conducted by the patent administration department under the State Council (hereinafter referred to as entering the Chinese national phase), the provisions prescribed in this chapter shall apply. Where no provisions are made in this chapter, the relevant provisions in the Patent Law and in any other chapters of these Implementing Regulations shall apply.

**Rule 102.** Any international application which has been accorded an international filling date in accordance with the Patent Cooperation Treaty and which has designated China shall be deemed as an application for patent filed with the patent administration department under the State Council, and the said international filing date shall be deemed as the filing date referred to in Article 28 of the Patent Law.

**Rule 103.** Any applicant for an international application entering the Chinese national phase shall, within 30 months from the priority date as referred to in Article 2 of the Patent Cooperation Treaty (referred to as "the priority date" in this chapter), go through the formalities for entering the Chinese national phase before the patent administration department under the State Council. If the applicant fails to go through the said formalities within the prescribed time limit, he or it may, after paying a surcharge for the late entry, go through the formalities for entering the Chinese national phase within the 32 months from the priority date.

**Rule 104.** When the applicant goes through the formalities for entering the Chinese national phase in accordance with the provisions of Rule 103 of these Implementing Regulations, it or he shall fulfill the following requirements:

(1) submitting in Chinese a written statement for entering the Chinese national phase, indicating the international application number and the type of patent right sought;

(2) paying the filing fee and the printing fee for the publication of the application as provided in Rule 93, paragraph one of these Implementing Regulations, and where necessary, the surcharge for the late entry as provided in Rule 103 of these Implementing Regulations;

(3) submitting the Chinese translation of the description and the claims of the initial international application where an international application is filed in a foreign language;

(4) indicating in the written statement for entering the Chinese national phase the title of the invention-creation, the name or title of the applicant, the address of the applicant and the name of the inventor, all of which should be in conformity with those recorded with the International Bureau under the World Intellectual Property Organization (hereafter referred to as the International Bureau). Where the inventor is not indicated in the international application, the name of the inventor shall be indicated in the said statement;

(5) where the international application is filed in a foreign language, submitting the Chinese translation of the abstract; submitting a copy of the drawings and a copy of the drawing of the abstract where there are drawings and the drawing of the abstract; the text matter in the drawings, if any, shall be replaced by the corresponding text matter in Chinese; where the international application is filed in Chinese, submitting a copy of the abstract and the drawing of the abstract as appeared in the documents of international publication;

(6) where the applicant has gone through the formalities of changing the applicant before the International Bureau in the international phase, certifying documents shall be furnished to prove the right of the applicant after the change to the international application;

(7) payment of the additional fee for application when necessary, as provided in Rule 93, subparagraph (1) of these Implementing regulations.

Where the requirements set forth in subparagraphs (1) to (3), paragraph one of this Rule are met, the patent administration department under the State Council shall issue the filing number, indicate clearly the date of entry of the international application into the Chinese national phase (hereafter referred to as the date of entry), and notify the applicant that its or his international application has entered into the Chinese national phase.

Where, after entering the Chinese national phase, it is found that an international application does not meet the requirements as set forth in subparagraphs (4) to (7), paragraph one of this Rule, the patent administration department under the State Council shall notify the applicant to make rectification within the specified time limit. If the applicant fails to do so, the application shall be deemed to have been withdrawn.

**Rule 105.** Where an international application has any of the following circumstances, the effect of the application in China shall cease:

(1) where in the international phase, the international application has been withdrawn or was deemed to have been withdrawn, or the designation of China of the international ap-

plication has been withdrawn;

(2) where the applicant fails to go through the formalities for entry into the Chinese national phase within 32 months from the priority date in accordance with the provision of Rule 103 of these Implementing Regulations;

(3) while going through the formalities for entry into the Chinese national phase, the applicant fails to fulfill the requirements of Rule 104, subparagraphs (1) to (3) of these Implementing Regulations at the expiration of the time limit of 32 months from the date of priority.

Where the effect of an international application cease in China in accordance with the provision of the preceding paragraph, subparagraph (1), the provisions of Rule 6 of these Implementing Regulations shall not apply. Where the effect of an international application cease in China in accordance with the provision of the preceding paragraph, subparagraph (2) or (3), the provisions of Rule 6, paragraph two of these Implementing Regulations shall not apply.

**Rule 106.** Where an international application was amended in the international phase and the applicant requests that the examination be based on the amended application, the Chinese translation of the amendments shall be furnished within two months from the date of entry. Where the Chinese translation is not furnished within the said time limit, the amendments made in the international phase shall not be taken into consideration by the patent administration department under the State Council.

**Rule 107.** Where any invention-creation to which the international application relates has one of the events referred to in Article 24, subparagraph (1) or (2) of the Patent Law and where statements have been made in this respect when the international application was filed, the applicant shall indicate it in the written statement concerning entry into the Chinese national phase, and furnish the relevant certifying documents prescribed in Rule 30, paragraph three of these Implementing Regulations within two months from the date of entry. If the applicant fails to indicate it or furnish the relevant certifying documents within the time limit, the provisions of Article 24 of the Patent Law shall not apply to its or his application.

**Rule 108.** Where the applicant has made indications concerning deposited biological materials in accordance with the provisions of the Patent Cooperation Treaty, the requirements provided for in Rule 24, subparagraph (3) of these Implementing Regulations shall be deemed to have been fulfilled. In the statement concerning entry into the Chinese national phase, the applicant shall indicate the documents recording the particulars of the deposit of the biological materials, and the exact location of the record in the documents.

Where particulars concerning the deposit of the biological materials are contained in

the description of the international application as initially filed, but there is no such indication in the statement concerning the entry into the Chinese national phase, the applicant shall make corrections within four months from the date of entry. If the correction is not made at the expiration of the time limit, the biological materials shall be deemed not to have been deposited.

Where, within four months from the date of entry, the applicant has submitted the certificates of the deposit and the viability of the biological materials to the patent administration department under the State Council, the deposit of biological materials shall be deemed to have been furnished within the time limit as provided for in Rule 24, subparagraph (1) of these Implementing Regulations.

**Rule 109.** Where an invention-creation has been developed relying on the use of genetic resources for which the international application is filed, the applicant shall indicate the fact in the written statement for entering the Chinese national phase, and fill in the forms provided by the patent administration department under the State Council.

**Rule 110.** Where the applicant claims one or multiple priorities in the international phase and such claims remain valid at the time when the application enters the Chinese national phase, the applicant shall be deemed to have submitted the written declaration in accordance with the provisions of Article 30 of the Patent Law.

The applicant shall pay a fee for the claim of priority within two months from the date of entry. If the fee is not paid or not paid in full within the time limit, the priority shall be deemed not to have been claimed.

Where the applicant has submitted a copy of the earlier application in the international phase in accordance with the provisions of the Patent Cooperation Treaty, he or it shall be exempted from submitting a copy of the earlier application to the patent administration department under the State Council at the time of going through the formalities for entering the Chinese national phase. Where the applicant has not submitted a copy of the earlier application in the international phase, and if the patent administration department under the State Council deems necessary, it may notify the applicant to submit a copy of the earlier application within the specified time limit. If no copy is submitted at the expiration of the time limit, his or its claim for priority shall be deemed not to have been made.

**Rule 111.** Where, before the expiration of 30 months from the priority date, the applicant files a request with the patent administration department under the State Council for early processing and examination of his or its international application, he or it shall, in addition to going through the formalities for entering the Chinese national phase, submit a request in accordance with the provisions in Article 23, paragraph two of the Patent Cooperation Treaty. Where the international application has not been transmitted by the Internation-

al Bureau to the patent administration department under the State Council, the applicant shall submit a certified copy of the international application.

**Rule 112.** With regard to an international application for a patent for utility model, the applicant may amend the patent application documents on its or his own initiative within two months from the date of entry.

With regard to an international application for a patent for invention, the provisions of Rule 51, paragraph one of these Implementing Regulations shall apply.

**Rule 113.** Where the applicant finds that there are mistakes in the Chinese translation of the description, the claims or the text matter in the drawings as filed, he or it may correct the translation in accordance with the international application as filed within the following time limits:

(1) before the completion of technical preparations for publication of an application for a patent for invention or announcement of patent right for utility model by the patent administration department under the State Council;

(2) within three months from the date of receipt of the notification sent by the patent administration department under the State Council, stating that the application for a patent for invention has entered into the substantive examination phase.

Where the applicant intends to correct the mistakes in the translation, he or it shall file a written request and pay the prescribed fee for the correction of the translation.

Where the applicant makes correction of the translation in accordance with the notification of the patent administration department under the State Council, he or it shall, within the specified time limit, go through the formalities prescribed in paragraph two of this Rule. If the prescribed formalities are not gone through at the expiration of the time limit, the international application shall be deemed to be withdrawn.

**Rule 114.** With regard to any international application for a patent for invention, if the patent administration department under the State Council, after preliminary examination, considers it in compliance with relevant provisions of the Patent Law and these Implementing Regulations, it shall publish it in the Patent Gazette; where the international application is filed in a language other than Chinese, the Chinese translation of the international application shall be published.

Where the international publication of an international application for a patent for invention by the International Bureau is in Chinese, the provisions of Article 13 of the Patent Law shall apply from the date of the international publication. If the international publication by the International Bureau is in a language other than Chinese, the provisions of Article 13 of the Patent Law shall apply from the date of the publication of the Chinese translation by the patent administration department under the State Council.

With regard to an international application, the publication referred to in Articles 21 and 22 of the Patent Law means the publication referred to in paragraph one of this Rule.

**Rule 115.** Where two or more inventions or utility models are contained in an international application, the applicant may, from the date of entry, submit a divisional application in accordance with the provisions in Rule 42, paragraph one of these Implementing Regulations.

Where, in the international phase, some parts of the international application have not been the subject of international search or international preliminary examination because the International Searching Authority or the International Preliminary Examination Authority considers that the international application does not comply with the requirement of unity of invention prescribed in the Patent Cooperation Treaty, and the applicant fails to pay the additional fee, whereas at the time of going through the formalities for entering the Chinese national phase, the applicant requests that the said parts be the basis of examination, the patent administration department under the State Council, finding that the decision concerning unity of invention made by the International Searching Authority or the International Preliminary Examination Authority is justified, shall notify the applicant to pay the restoration fee for unity of invention within the specified time limit. Where the fee is not paid or not paid in full at the expiration of the prescribed time limit, those parts of the international application which have not been searched or have not been the subject of international preliminary examination shall be deemed to be withdrawn.

**Rule 116.** Where an international application in the international phase has been refused to be accorded an international filling date or has been declared to be deemed withdrawn by an international authority concerned, the applicant may, within two months from the date on which he or it receives the notification, request the International Bureau to send the copy of any document in the file of the international application to the patent administration department under the State Council, and shall go through the formalities prescribed in Rule 103 of these Implementing Regulations within the said time limit before the patent administration department under the State Council. After receiving the documents sent by the International Bureau, the patent administration department under the State Council shall review the decision made by the international authority concerned to find whether it is correct.

**Rule 117.** With regard to a patent right granted on the basis of an international application, if the extent of protection determined in accordance with the provisions of Article 59 of the Patent Law exceeds the scope of the international application in its original language because of incorrect translation, the extent of protection granted on the international application shall be determined according to what is limited in the original language of the applica-

tion; if the extent of protection granted on the international application is narrower than the scope of the application in its original language, the extent of protection shall be determined according to the patent when it is granted.

# Chapter XI
# Supplementary Provisions

**Rule 118.** Any person may, after approval by the patent administration department under the State Council, consult or copy the files of the published or announced patent applications and the Patent Register. Any person may request the patent administration department under the State Council to issue a copy of extracts from the Patent Register.

The files of the patent applications which have been withdrawn or deemed to be withdrawn or which have been rejected, shall not be preserved after expiration of two years from the date on which the applications cease to be valid.

Where the patent right has been abandoned, wholly invalidated or ceased, the files shall not be preserved after expiration of three years from the date on which the patent right ceases to be valid.

**Rule 119.** Any patent application which is filed with, or any formality which is gone through before, the patent administration department under the State Council shall be signed or sealed by the applicant, the patentee, any other interested person or his or its representative. Where any patent agency is appointed, it shall be sealed by such agency.

Where a change in the name of the inventor, or in the title or name, nationality and address of the applicant or the patentee, or in the title and address of the patent agency and the name of patent agent is requested, a request for a change in the bibliographic data shall be made to the patent administration department under the State Council, together with the relevant certifying documents.

**Rule 120.** The document relating to a patent application or patent right which is mailed to the patent administration department under the State Council shall be mailed by registered letter, not by parcel.

Except for any patent application filed for the first time, any document which is submitted to and any formality which is gone through before the patent administration department under the State Council, the filing number or the patent number, the title of the invention-creation and the title or name of the applicant or the patentee shall be indicated.

Only documents relating to the same application shall be included in one letter.

**Rule 121.** Various kinds of application documents shall be typed or printed. All the characters shall be in black ink, neat and clear. They shall be free from any alterations. The drawings shall be made in black ink with the aid of drafting instruments. The lines shall be uniformly thick and well defined, and free from alterations.

The request, description, claims, drawings and abstract shall be numbered separately in Arabic numerals and arranged in numerical order.

The written language of the application shall run from left to right. Only one side of each sheet shall be used.

**Rule 122.** The patent administration department under the State Council shall formulate Guidelines for Examination in accordance with the Patent Law and these Implementing Regulations.

**Rule 123.** These Implementing Regulations shall enter into force on July 1, 2001. The Implementing Regulations of the Patent Law of the People's Republic of China approved by the State Council on December 12, 1992 and promulgated by the Patent Office of the People's Republic of China on December 21, 1992 shall be repealed at the same time.

# Transitional Measures on Implementing the Amended Implementing Regulations of the Patent Law

(Promulgated by Order No. 54 of the State Intellectual Property Office on January 21, 2010)

**Rule 1.** These Rules are formulated, in accordance with Article 84 of the Legislation Law, to ensure the implementation of the Decision of the State Council on Amending the Implementing Regulations of the Patent Law of the People's Republic of China promulgated on January 9, 2010.

**Rule 2.** The provisions of the Implementing Regulations of the Patent Law before its amendment apply to the patent applications of which the filing date is before February 1, 2010 (this day is not included), and the patent rights granted on the basis of the said applications; the provisions of the amended Implementing Regulations of the Patent Law apply to patent applications of which the filing date is after February 1, 2010 (this day is included, hereinafter the same), and the patent rights granted on the basis of the said applications, subject to the following special provisions of these Rules which also apply to the applications of which the filing date is before February 1, 2010 and the patent rights granted on the basis of the said applications.

**Rule 3.** For the examination of any request for invalidation of a patent for design filed after February 1, 2010, based on the ground that the grant of the patent for design does not comply with the provisions of Article 23, paragraph three of the patent law , provisions of Rule 66, paragraph three of the amended Implementing Regulations of the Patent Law shall apply.

**Rule 4.** For the examination of any request for invalidation of a patent right filed after February 1, 2010, provisions of Rule 72, paragraph two of the amended Implementing Regulations of the Patent Law shall apply.

**Rule 5.** Where any applicant for PCT international application goes through the formalities for entering the Chinese national phase after February 1, 2010, provisions of Chapter 10 of the amended Implementing Regulations of the Patent Law shall apply.

**Rule 6.** For any request for suspension of the relevant patent procedures filed after February 1, 2010 before the State Intellectual Property Office, provisions of Rule 93 and Rule 99 of the amended Implementing Regulations of the Patent Law shall apply, no fee is required for the request.

For any request filed after February 1, 2010 for a refund of the patent fee which is paid in excess of the amount as prescribed, paid repeatedly or wrongly, provisions of Rule 94, paragraph four of the amended Implementing Regulations of the Patent Law shall apply.

Where the filing fee, printing fee for the publication of the application, and the necessary additional fee for filing an application for patent are paid after February 1, 2001, provisions of Rule 95 of the amended Implementing Regulations of the Patent Law shall apply.

Where the applicant goes through the formalities for registration of grant of patent right after February 1, 2010, provisions of Rule 93 and Rule 97 of the amended Implementing Regulations of the Patent Law shall apply, no maintenance fee for application is required.

**Rule 7.** These Rules shall enter into force as of February 1, 2010.